Supreme Court, U.S.
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No.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1998

WEST PUBLISHING CO. and
WEST PUBLISHING CORPORATION,

Petitioners,

v.

MATTHEW BENDER & COMPANY, INC.
and HYPERLAW, INC.,

Respondents.

ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Does the 1976 Copyright Act protect an original arrangement of factual or public domain material from a competitor who uses digital computer technology to replicate that arrangement?

2. Does the 1976 Copyright Act protect comprehensive information about a compilation's original arrangement from electronic copying that permits a copy of the entire original arrangement to be replicated and displayed?

3. Does the 1976 Copyright Act protect a work from comprehensive and damaging commercial use even though the copyright owner has conceded that a particular, limited use of a work, is "fair"?

PARTIES TO THE PROCEEDING

The parties before this Court are those set forth in the caption. Pursuant to Rule 29.6, we advise the Court that West Publishing Company and West Publishing Corporation are wholly owned indirect subsidiaries of The Thomson Corporation, whose shares are publicly traded in Canada and the United Kingdom but not in the United States. West Publishing Company, West Publishing Corporation, and The Thomson Corporation do not have any subsidiaries that are publicly traded.

TABLE OF CONTENTS

	Page
Questions Presented	i
Parties to the Proceeding	ii
Table of Cited Authorities	v
Opinions Below	1
Statement of Jurisdiction	1
Constitutional and Statutory Provisions Involved	2
Statement of the Case	4
A. The CD-ROM Products	6
B. The District Court's Decision	7
C. The Court Of Appeals' Decision	8
Reasons for Granting the Writ	9
I. The Petition Should Be Granted In Order To Resolve The Split In Authority Between The Courts Of Appeals	10
II. The Petition Should Be Granted To Ensure Effective Copyright Protection For Compilations In An Age Of Digital Technology	15

Contents

Page

A. The Supreme Court's Guidance Is Needed To Clarify That The Statutory Definition Of "Fixed" Applies To All Pre-Programmed Arrangements On A CD-ROM 18

B. The Supreme Court's Guidance Is Needed To Clarify That The Statute's Definition Of "Copies" Applies To Copies Accessed By CD-ROM Users With The Aid Of A Computer 23

C. The Second Circuit's Ruling That "Mere Page Numbers" Can Never Be Protected Conflicts With This Court's Decision In *Callaghan* And Opens The Door To Unlimited Infringement Through Electronic Copying Of Arrangements 26

Conclusion 30

TABLE OF CITED AUTHORITIES

Page

Cases:

Callaghan v. Myers, 128 U.S. 617 (1888) .. 9-10, 26-27, 30

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Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 111 S. Ct. 1282 (1991) 12-15, 27

Oasis Publishing Company, Inc. v. West Publishing Company, 924 F. Supp. 918 (D. Minn. 1996) ..8-9, 11-12

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West Pub. Co. v. Mead Data Central, Inc., 616 F. Supp. 1571 (D. Minn. 1985), *aff'd*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987) ..11-15, 26-27

WGN Continental Broadcasting Co. v. United Video, Inc., 693 F.2d 622 (7th Cir. 1982) 16

Statutes:

17 U.S.C. § 101 ..... 2, 9, 16-19, 25

17 U.S.C. § 102 ..... 2, 25

17 U.S.C. § 103 3

17 U.S.C. § 106 3

Cited Authorities

	Page
17 U.S.C. § 106(1)	18
17 U.S.C. § 106(3)	18
17 U.S.C. § 117	16
17 U.S.C. § 501	4, 18
28 U.S.C. § 1254(1)	1
28 U.S.C. § 1291	1
28 U.S.C. § 1331	1
28 U.S.C. § 1338(a)	1
28 U.S.C. § 2201	1
United States Constitution:	
Article I, section 8, clause 8	2
Rule:	
Supreme Court Rule 13	1
Legislative History:	
H.R. REP. NO. 94-1476, *reprinted in* 1976 U.S.C.C.A.N. 5659	19

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Page

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Stephen C. Carlson, *The Law and Economics of Star Pagination*, 2 GEO. MASON U. L. REV. 421 (1995) 13

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Harriette K. Dorsen, *Compilations and Factual Narrative Works After Feist Publication v. Rural Telephone Service*, 317 PLI/Pat 401 (1991) 13

1 Paul Goldstein, COPYRIGHT (1998) 12, 15

Carl J. Khalil, *Are Page Numbers Really Copyrightable? The Effect of Feist on the West Publishing v. Lexis Case*, 76 J. PAT. & TRADEMARK OFF. SOC'Y 807 (1994) 13

Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105 (1990) 9

Cited Authorities

Page

Peter B. Maggs, *The Impact of the Internet on Legal Bibliography*, 46 AM. J. COMP. L. 665 (1998) .. 13

Anant S. Narayanan, *Standards of Protection for Databases in the European Community and the United States: Feist and the Myth of Creative Originality*, 27 GEO. WASH. J. INT'L L. & ECON. 457 (1994) 15

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Michell D. Orton, *House Bill 1822: New Anti-Westopoly Rule Proposed in Congress*, 7 DEPAUL-LCA J. ART & ENT. L. 308 (1997) 13

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Pamela Samuelson & Robert J. Glushko, *Intellectual Property Rights for Digital Library and Hypertext Publishing Systems*, 6 HARV. J. L. & TECH. 237 (1993) 13, 21

Russ VerSteeg, *Rethinking Originality*, 34 WM. & MARY L. REV. 801 (1993) 13

James H. Wyman, Comment, *Freeing the Law: Case Reporter Copyright and the Universal Citation System*, 24 FLA. ST. U. L. REV. 217 (1996) 13

APPENDIX

Page

Appendix A — Opinion Of The United States Court Of Appeals For The Second Circuit Dated November 3, 1998 And Filed November 4, 1998 ..... 1a

Appendix B — Amended Order Of The United States District Court For The Southern District Of New York Dated December 4, 1996 ..... 46a

Appendix C — Transcript Of Proceedings Of The United States District Court For The Southern District Of New York Dated November 22, 1996 ..... 48a

Appendix D — Opinion Of The United States Court Of Appeals For The Second Circuit Denying Petition For Rehearing Dated And Filed December 18, 1998 ..... 84a

Appendix E — Judgment Of The United States Court Of Appeals For The Second Circuit Dated November 3, 1998 And Filed November 4, 1998 ..... 86a

West Publishing Company and West Publishing Corporation (collectively, "West") respectfully request that a writ of certiorari be issued to review the opinion and decision of the United States Court of Appeals for the Second Circuit entered in this case.

OPINIONS BELOW

The bench ruling of the United States District Court for the Southern District of New York Court (Pet. App. 48a-83a) is reported at 41 U.S.P.Q.2d 1321, 1996 WL 774803 (S.D.N.Y. Nov. 22 and Nov. 26, 1996). The opinion of the United States Court of Appeals for the Second Circuit (Pet. App. 1a-45a) is reported at 158 F.3d 693. West's petition for rehearing with a suggestion for rehearing in banc was denied on December 18, 1998 (Pet. App. 84a-85a).

STATEMENT OF JURISDICTION

This is a declaratory judgment action by Matthew Bender & Company, Inc. ("Bender") and HyperLaw, Inc. ("HyperLaw") seeking a declaration that they will not infringe West's copyrights in its compilations of judicial opinions by electronically inserting West's "star pagination" into their own CD-ROM compilations. The district court had jurisdiction under 28 U.S.C. §§ 1331, 1338(a), and 2201. The Court of Appeals had jurisdiction to hear the appeal under 28 U.S.C. § 1291. A timely petition for rehearing with a suggestion for rehearing in banc was denied on December 18, 1998, and this petition for a writ of certiorari was filed within 90 days of that date. This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1), and Supreme Court Rule 13.

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article I, section 8, clause 8 of the United States Constitution provides that:

> The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

Section 101 of the Copyright Act, 17 U.S.C. § 101, provides that:

> "Copies" are material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.
>
> . . .
>
> A "compilation" is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes a work of authorship.

Section 102(a) of the Copyright Act, 17 U.S.C. § 102, provides that:

> Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. . . .

Section 103(a) of the Copyright Act, 17 U.S.C. § 103, provides that:

> The subject matter of copyright as specified by section 102 includes compilations and derivative works . . . .

Section 103(b) of the Copyright Act, 17 U.S.C. § 103, provides that:

> The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. . . .

Section 106(1) of the Copyright Act, 17 U.S.C. § 106, provides that:

> [T]he owner of copyright under this title has the exclusive rights to do and to authorize any of the following:
>
> (1) to reproduce the copyrighted work in copies or phonorecords;
>
> . . .
>
> (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
>
> . . .

Section 501(a) of the Copyright Act, 17 U.S.C. § 501, provides that:

> Anyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 120 . . . is an infringer of the copyright. . . .

STATEMENT OF THE CASE

As we stand on the brink of a new millennium, this case presents the Supreme Court with an opportunity to offer guidance on one of the most important copyright issues of the information era. The Second Circuit's ruling has provided would-be infringers of copyrighted compilations with complete insulation against liability, so long as they make their copy available digitally — a result that Congress surely did not intend. Especially in light of the dramatic split of authority between the Second and Eighth Circuits, this case raises fundamental questions about the application of the 1976 Copyright Act to electronic media. This Court's intervention is needed to prevent the subversion of Congress' decisions to craft a forward-looking statute that could be applied to future technologies and to provide compilations with meaningful copyright protection.

Compilations are particularly important to the American economy at this time. Computers and other new telecommunications technologies have inundated us with an endless sea of news, data, facts, and information. As these new technologies progress, it becomes ever more important for the information industries not simply to provide people with still more information, but to find new ways to select, arrange, organize, and compile the ever-expanding universe of data. This explains why many of the most successful Internet companies (*e.g.*, search directories such as Yahoo! and service providers such as American Online) are not those that provide more information, but those that apply original strategies to allow users

to make sense of existing information. The activities of individuals and businesses that create original compilations and arrangements are critical to the further development of useful and efficient communications and information systems.

In this case, a copyrighted arrangement — West's original arrangement of case reports in numerous copyrighted compilations — has been denied protection from electronic copying.[1] There is no dispute that West's ordering of reported cases in its Reporter volumes represents an original and copyrightable arrangement of public domain judicial opinions. The Court of Appeals described the detailed methodology for West's arrangement at 158 F.3d 697 n.3, Pet. App. 4a-5a n.3.

Bender and HyperLaw have electronically inserted "star pagination" (so called because it consists of an asterisk followed by a numeral denoting West's pagination and arrangement of decisions) into their CD-ROM products, thereby making an exact copy of West's original arrangement readily perceivable to the user. Yet the district court and the Second Circuit found that the use of star pagination does not amount to copying of West's arrangement because Bender and HyperLaw did not *physically* store their cases on their CD-ROMs in the same order that West placed them on printed pages.

The lower court decisions in this case have failed to appreciate that — because of the nature of CD-ROM technology — the expression of West's original case arrangement is copied, and West's copyright is infringed, when the series names, volume numbers, and page numbers are systematically copied and

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1. In a separate petition, West seeks review of the Second Circuit's decision, in a companion case, denying copyright protection to West's editorial additions and revisions in adapting judicial opinions into its volumes of compiled case reports.

electronically inputted. As Judge Sweet stated in his Second Circuit dissent:

> Some of the most seminal developments in copyright law have been driven by technological change. . . . Here again it is necessary to reconcile technology with pre-electronic principles of law. Clearly, plaintiffs' CD-ROM disks are not "copies" in the traditional sense. Yet, plaintiffs provide the ability for a user to push a button or two and obtain West's exact selection and arrangement. *This technological capacity presents a new question.* The majority's answer threatens to eviscerate copyright protection for compilations.

158 F.3d at 710, Pet. App. 42a (emphasis added).

A. The CD-ROM Products

Bender's product (the "Bender Product") is composed of eight CD-ROM disks, one containing treatises and forms on New York law, and the other seven containing case law. Four of the case law disks contain a number of years of New York state judicial opinions. The other three case law disks contain a number of years of cases from New York's federal district courts and the New York decisions by the United States Court of Appeals for the Second Circuit. HyperLaw's product ("the HyperLaw Product") consists of CD-ROM disks containing opinions of the United States Supreme Court and the United States Courts of Appeals. 158 F.3d at 697, 698; Pet. App. 6a, 8a. These Products use star pagination to permit full display of the original selection and arrangement of judicial opinions within each of West's copyrighted reporter volumes. Thus, using the Bender and HyperLaw Products, West's entire copyrighted selection and arrangement can be viewed — and printed out —

by using one or two simple commands. *Id.* at 697-698, Pet. App. 7a-8a.[2]

B. The District Court's Decision

At a hearing on November 22, 1996, the district court heard argument and ruled from the bench, granting summary judgment to both Bender and HyperLaw on their claims for a declaratory judgment as to star pagination. For purposes of the summary judgment motions, the district court assumed that West's original case arrangement is protected by copyright and acknowledged that a photocopy of a West volume would "violate West's copyright" by copying its original selection and arrangement. 41 U.S.P.Q.2d at 1321, Pet App. 50a. The court also assumed that Bender's and HyperLaw's CD-ROM Products can display West's original selection and arrangement with a minimum of user effort. *Id.* at 1328, Pet. App. 77a.

Nonetheless, the district court ruled that these Products do not infringe West's copyrights because:

> [W]here and on what particular pages the text of a court opinion appears does not embody any original creation of the compiler, and therefore, in my view, is not entitled to protection.

Id. at 1330, Pet App. 79a.

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2. The district court made no actual finding of fact as to the extent of plaintiffs' star pagination but apparently assumed, for purposes of the summary judgment motion, that both the Bender and Hyperlaw Products comprehensively star paginate *all* of the cases selected and arranged in an unlimited number of West volumes. In addition, the district court did not distinguish between the Bender and Hyperlaw Products and apparently assumed that the Hyperlaw Product (i) star paginates all cases contained in copyrighted West volumes; and (ii) has the same capacity as the Bender Product to display the entire selection and arrangement of a West volume. These assumptions were made explicit and carried forward by the Court of Appeals. 158 F.3d at 698 n.7, Pet. App. 9a n.7.

C. The Court Of Appeals' Decision

The Second Circuit affirmed the district court's ruling, holding that West's pagination can never be protected because it represents uncopyrightable facts, rather than the expression of West's arrangement. 158 F.3d at 707-08, Pet. App. 34a-35a. Moreover, the Second Circuit found that, even if electronic star-pagination makes West's arrangement readily perceivable to a user of Bender's and HyperLaw's CD-ROMs, West's case ordering has not been "copied" because the cases are not *physically stored* on the CD-ROMs in that order. *Id.* at 703-04, Pet. App. 23a-26a.

Judge Sweet dissented from the decision, agreeing with the Eighth Circuit that (i) comprehensive pagination data, when linked to the text of a copyrighted compilation, expresses the compiler's original arrangement; and (ii) an arrangement is "copied" by the inputting of electronic cross-pagination into a database containing the compilation's text. 158 F.3d at 711, Pet. App. 44a. Applying the statutory definition of "copies" to CD-ROM technology, Judge Sweet concluded that Bender's and HyperLaw's programming, which makes the perception of West's arrangement "easy," constitutes infringement of West's reproduction right. *Id.* at 710, Pet. App. 42a-43a.[3]

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3. The Second Circuit also found that Bender and HyperLaw's copying does not infringe West's copyright because West has conceded that the fair use doctrine is applicable to the use of parallel citations to the first page of each case (as opposed to full star pagination, which goes well beyond first-page citation). 158 F.3d at 700-01, Pet. App. 16a-18a. As Judge Sweet observed in his dissent, this finding ignores the fact that, unlike parallel citation, "complete electronic cross-pagination fulfills the same market demand as West's volumes." Judge Sweet cited and agreed with Chief Judge Magnuson's view in *Oasis Publishing Co., Inc. v. West Publishing Co.*, 924 F. Supp. 918, 926 (Cont'd)

REASONS FOR GRANTING THE WRIT

As noted by the dissent, the Second Circuit's decision "threatens to eviscerate copyright protection for compilations" by failing to reconcile CD-ROM technology with the 1976 Copyright Act. 158 F.3d at 710, Pet. App. 42a. Although CD-ROMs did not exist in 1976, Congress anticipated the threat to copyright from CD-ROM technology when it revised the definition of "copies" to include "material objects" in which a copy resides, even if that copy is capable of perception only with the aid of a "machine or device" "now known or later developed." 17 U.S.C. § 101. The user of a CD-ROM, with the aid of a computer, can view pre-programmed arrangements of the texts in the disk's database.

Yet the Second Circuit's ruling would permit unlimited copying of copyrighted original arrangements by CD-ROM. This ruling relies on a dangerously narrow interpretation of the statutory definitions of "fixed" and "copies" and on a fundamental misunderstanding of CD-ROM technology. It also relies on the finding that arrangement data, even when copied *en masse* and programmed into a text database, will always remain unprotectible "facts." This finding, which is inconsistent with *Callaghan v. Myers*, 128 U.S. 617 (1888), and directly conflicts with the view of the Eighth Circuit, ignores the reality

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(Cont'd)

(D. Minn. 1996): " 'Having gotten the inch under the conceded fair use of parallel citation to the first page of each case,' plaintiffs are not 'thereby entitled to take the entire mile in star citation to every page. . . .' " 158 F.3d at 710, Pet. App. 41a-42a. *See also* Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1123 (1990). Moreover, the Second Circuit's majority opinion acknowledged that the electronic copying of parallel citations alone, without star pagination, results in a less readily accessible copy of West's arrangement than the one that can be accessed with complete electronic cross-pagination. 158 F.3d at 701 n.15; Pet. App. 17a n.15.

of today's information industries. In the age of electronic publishing, selection and arrangement will almost always be expressed by the comprehensive insertion of arrangement data — which permits a user to view the entire arrangement with the aid of a computer.[4] Star-pagination is just one example of this basic method for copying (or creating) arrangements digitally.

Thus, this Court's intervention is needed to reaffirm *Callaghan*, resolve the split between the circuits, address crucial questions of statutory interpretation, and prevent judicial nullification of Congress' decision to give meaningful protection to compilations not just in 1976, but for many decades thereafter. Clarification of these issues is of vital practical importance to America's information industries, which cannot thrive if compilations and arrangements are underprotected and if there is no way to anticipate how courts will apply the statute to electronic media.

I.

THE PETITION SHOULD BE GRANTED IN ORDER TO RESOLVE THE SPLIT IN AUTHORITY BETWEEN THE COURTS OF APPEALS

This case presents the Court with a paradigmatic split in authority between circuits: the Courts of Appeals for the Second Circuit and the Eighth Circuit have decided the same important issue in completely opposite ways. Given the fact that most publishers are engaged in nationwide business activity, especially with the advent of the Internet, this circuit division has created

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4. Indeed, since CD-ROMs do not contain traditional visual copies of pages in sequence, the *only* method by which CD-ROM publishers can copy selection and arrangement is to program — or "tag" — each page or segment of the text with markings to indicate the precise order in which a compilation's components appear.

a serious dilemma for publishers of compilations — who cannot predict how (or where) their own works will be protected, nor how (or where) they may use the compilation of another publisher. In addition, legal scholars have widely regarded the star-pagination question — which reflects fundamental uncertainties about the scope of the Copyright Act — as an extremely important issue requiring the guidance of the Supreme Court. *See* note 5, *infra*.

Star pagination has been previously addressed three times, twice by the United States District Court for the District of Minnesota and once by the Eighth Circuit. In every instance, the court determined that star pagination constituted an infringement of the copyrighted arrangements of the West Reporter volumes. *West Pub. Co. v. Mead Data Central, Inc.*, 616 F. Supp. 1571 (D. Minn. 1985), *aff'd*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987); *Oasis Pub. Co. v. West Pub. Co.*, *supra*.

All of these courts have held that West's Reporter name, volume data, and pagination — when linked to the texts of judicial opinions compiled by West — express West's original volume-by-volume, case-by-case selection and arrangement of the opinions. As the district court explained in *West v. Mead*:

> It is beyond cavil that one cannot copyright the Arabic numbering system. 17 U.S.C. § 102. But as is seen above, this is not just a series of numbers each rising by one over its predecessor, it is the basis of West's arrangement – the key to the self-index by which West's arrangement is accessed.

616 F. Supp. at 1579. The Eighth Circuit's reasoning in affirming the district court's decision is to the same effect:

> MDC contends that these page numbers communicate nothing about West's arrangement. This might be true if MDC proposed to use the numbers in some way unconnected to their position in West's reporters, for example by simply printing a list of the numbers. However, MDC understandably has no interest in making such a use of the numbers; instead, it plans to replicate on LEXIS every page break in West's volumes and to note the corresponding page number. Communication to LEXIS users of the location in West's reporters of specific portions of text is precisely what the LEXIS Star Pagination Feature is designed to do. . . .
>
> [T]he copyright we recognize here is in West's arrangement, not in its numbering system; MDC's use of West's page numbers is problematic because it infringes West's copyrighted arrangement, not because the numbers themselves are copyrighted.

West v. Mead, 799 F.2d at 1227-28. *See also Oasis*, 924 F. Supp. at 925.

Since the Supreme Court's repudiation of the "sweat of the brow" doctrine in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 111 S. Ct. 1282 (1991), legal scholars have developed a cottage industry devoted to divining the effect of *Feist* on *West v. Mead*.[5] Indeed, in recent litigation involving

5. *See, e.g.*, 1 Paul Goldstein, COPYRIGHT, §§ 2.14.2.1, 2.14.3.3 (1998); 1 Melville B. Nimmer & David Nimmer, NIMMER ON COPYRIGHT, § 3.03 (1998); 1 William F. Patry, COPYRIGHT LAW AND PRACTICE 193-200 (1994); Howard B. Abrams, *Originality and Creativity in Copyright Law*, 55 SPG LAW & CONTEMP. PROBS. 3 (1992); Keith Aoki, *Authors, Inventors and Trademark Owners: Private Intellectual Property and the Public Domain*, 18 COLUM.-VLA J. L. & ARTS 1 (1993); (Cont'd)

West's copyrights, it has become *de rigueur* for those seeking court approval for wholesale copying of West's selection and arrangement to assert that in *Feist* the Supreme Court "overruled" the analysis in *West v. Mead* — ostensibly because the Eighth Circuit mentioned "effort" as well as creativity (and relied on a telephone directory case) in determining that West's selection and arrangement is protectible.

In fact, *West v. Mead* did not accord copyright protection under the "sweat of the brow" doctrine. The Eighth Circuit's opinion makes it clear that intellectual creativity — and not "industrious collection" — was the basis of the decision:

> To be the original work of an author, a work must be the product of some "creative intellectual or aesthetic labor."
>
> . . . [I]n each case the arrangement must be evaluated in light of the originality and intellectual-creation standards. . . .

West v. Mead, 799 F.2d at 1223-26 (citations omitted).

(Cont'd)
Stephen C. Carlson, *The Law and Economics of Star Pagination*, 2 GEO. MASON U. L. REV. 421 (1995); Harriette K. Dorsen, *Compilations and Factual Narrative Works After Feist Publication v. Rural Telephone Service*, 317 PLI/Pat 401 (1991); Carl J. Khalil, *Are Page Numbers Really Copyrightable? The Effect of Feist on the West Publishing v. Lexis Case*, 76 J. PAT. & TRADEMARK OFF. SOC'Y 807 (1994); Peter B. Maggs, *The Impact of the Internet on Legal Bibliography*, 46 AM. J. COMP. L. 665 (1998); Michell D. Orton, *House Bill 1822: New Anti-Westopoly Rule Proposed in Congress*, 7 DEPAUL-LCA J. ART & ENT. L. 308 (1997); Pamela Samuelson & Robert J. Glushko, *Intellectual Property Rights for Digital Library and Hypertext Publishing Systems*, 6 HARV. J. L. & TECH. 237 (1993); Russ VerSteeg, *Rethinking Originality*, 34 WM. & MARY L. REV. 801 (1993); James H. Wyman, Comment, *Freeing the Law: Case Reporter Copyright and the Universal Citation System*, 24 FLA. ST. U. L. REV. 217 (1996).

What is highly relevant in *West v. Mead* — and nowhere addressed, directly or indirectly, in *Feist* — is the Eighth Circuit's persuasive reasoning that (i) star pagination, when linked to the text of a compilation, is protectible because it expresses the compiler's selection and arrangement; and (ii) a compilation's selection and arrangement is copied when star pagination is inserted into an electronic database containing the compilation's text. 799 F.2d at 1227-28. As noted above, the Second Circuit explicitly disagreed with the Eighth Circuit on both of these points. Indeed, the Second Circuit acknowledged the split it was creating: "We differ with the Eighth Circuit's opinion in" *West v. Mead*. 158 F.3d at 707, Pet. App. 34a.

Feist, of course, says nothing about whether a star-paginated electronic database infringes a protectible print arrangement — although it clearly stands for the protectibility of selection and arrangement as a discrete, original element of a copyrightable compilation. In short, the Eighth Circuit's analysis of the issues relevant to this case has not been weakened by *Feist*. If anything, that analysis has been dramatically validated by the technological developments since *West v. Mead* — *e.g.*, the virtually unlimited capacity of CD-ROMs to copy (cheaply) and display (easily) creative compilations. In *Feist*, this Court said,

> a subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, *so long as the competing work does not feature the same selection and arrangement.*

Feist, 499 U.S. at 349, 111 S. Ct. at 1289 (emphasis added). Bender's and HyperLaw's CD-ROMs plainly "feature" West's arrangement by making it readily accessible through the insertion of electronic star pagination.

The Supreme Court's guidance is required in this case in order to bring resolution to the vast array of divergent legal

opinions on this matter. With respect to originality, the confusion about the impact of *Feist* on *West v. Mead* is merely one component of the more general confusion, throughout the federal courts, concerning the application of *Feist* to compilations that contain more originality than white page telephone directories.[6] Review by this Court is needed to clarify the parameters of the originality requirement, and the scope accorded copyrightable compilations, and to dispel the misapprehension that *Feist* "overruled" *West v. Mead* in this regard.

Even more importantly, this Court's guidance is needed to resolve the split between the circuits on whether an infringer can escape liability, in the increasingly digital world, by replicating protected selections and arrangements through the comprehensive electronic copying and encoding of page numbers, paragraph numbers, or other compilation markers.

II.

THE PETITION SHOULD BE GRANTED TO ENSURE EFFECTIVE COPYRIGHT PROTECTION FOR COMPILATIONS IN AN AGE OF DIGITAL TECHNOLOGY

The Second Circuit's treatment of this case raises questions of paramount importance for copyright law and for all those

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6. *See, e.g.*, 1 Goldstein, *supra*, § 2.2.1 at 2:9-10 ("Although the Court's intentions probably fell short of the broad language it employed, Feist's repeated references to creativity as part of the originality standard, and to the standard's constitutional foundation, have unavoidably introduced a wild card into the question of copyright protection for all forms of data collections . . ."); Anant S. Narayanan, *Standards of Protection for Databases in the European Community and the United States: Feist and the Myth of Creative Originality*, 27 GEO. WASH. J. INT'L L. & ECON. 457, 469 (1994) ("[T]he Feist decision will continue to cast its shadow over works that are on the borderline of copyrightability unless the rule is clarified or excised. As a consequence, it is important for the Court to revisit Feist. . . .")

with an interest in the creation and use of compilations. The issue is certain to come before the federal courts with increasing frequency as electronic technology continues to transform today's publishing and information industries. The Second Circuit's decision effectively eviscerates the copyright in compilations of information, thus crippling the incentives to continue to use new technologies for organizing and accessing data in the preparation of copyrighted arrangements and compilations.

This is not a case in which the judiciary is being asked to expand copyright protection in light of technological innovations. On the contrary, the relevant aspect of the Copyright Act — the definition of "copies" in Section 101 — is "broad and forward looking."[7] Therefore, the opinions below reflect a dangerous misreading of the statute as well as a failure to recognize the now-and-future realities of electronic publishing.

Can the statutory definition of "copies" be applied to digital copies of arrangements using CD-ROM technology? If a competitor's programming permits an exact copy of a protected arrangement to be perceived easily, *in its entirety*, on a CD-ROM, can the competitor escape liability simply because his

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7. *Tasini v. New York Times Co.*, 972 F. Supp. 804, 816 (S.D.N.Y. 1997) (Sotomayor, J.). "[I]t is to be presumed that the terms of the 1976 Act encompass all variety of developing technologies," including computer technologies. *Id.* at 818, *citing* Act's legislative history and repeal of 17 U.S.C. § 117. *See also, e.g., WGN Continental Broadcasting Co. v. United Video, Inc.*, 693 F.2d 622, 627 (7th Cir. 1982), in which the court interpreted the Act to include a new medium, citing Congress' apparent intent (evidenced in the legislative history) that courts

> interpret the definitional provisions of the new act flexibly, so that it would cover new technologies as they appeared, rather than to interpret those provisions narrowly and so force Congress periodically to update the act.

programming does not require the *physical* replication of the copyrighted arrangement on the CD-ROM? Are new digital works ineligible for copyright protection if there is no originality in the way data is physically stored in the product? These are among the crucial questions raised by the Second Circuit's rulings. Absent this Court's clarification of the critical statutory concepts involved, the entire field of electronic compilation and database publishing will be plagued by uncertainty and underprotection.

According to the 1976 Copyright Act:

> "Copies" are material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and *from which the work can be perceived, reproduced, or otherwise communicated*, either directly or *with the aid of a machine or device.*

17 U.S.C. § 101 (emphasis added).

In this case, the Court of Appeals acknowledged or assumed that Bender's and HyperLaw's CD-ROMs contain in their respective databases every case that appears in West's volumes for the relevant jurisdictions; that Bender and HyperLaw have comprehensively star paginated each and every case that appears in a West volume by copying and inputting into the text of each case the West series name, volume number, and page numbers corresponding to each and every page of West's text; and that Bender and HyperLaw have programmed their CD-ROMs so that a user can readily display all the cases from each West volume in the precise order — case by case, page by page — that they appear in West's bound books. 158 F.3d at 696-98, Pet. App. 4a-9a.

The application of the Act appears to be straightforward: Bender and HyperLaw have copied (§ 101) West's original arrangement into another medium. The resulting copy can be perceived as such with a machine (§ 101) in violation of one of West's exclusive rights (§ 106(1)). The selling of this copy violates another exclusive right (§ 106(3)). Each violation of these exclusive rights is an infringement of West's copyright (§ 501).

Nonetheless, the Second Circuit reached an entirely opposite conclusion, making it clear that critical ambiguities arise when the statute, enacted over 20 years ago, is applied to CD-ROM technology. Congress intended the 1976 Act to be adaptable to new technologies, to encourage the creation of new works in electronic formats, and to protect copyright owners from computer-age "loopholes" for infringers. These goals will be subverted unless this Court provides authoritative clarification of the applicability of the Act's key definitions.

A. The Supreme Court's Guidance Is Needed To Clarify That The Statutory Definition Of "Fixed" Applies To All Pre-Programmed Arrangements On A CD-ROM

Without the Supreme Court's direction on the interpretation of the Copyright Act's fixation requirement, other courts will repeat and recycle the fundamental misunderstanding of the Second Circuit in this case — one that effectively immunizes digital infringement from liability under the Act. This same misinterpretation also leads to the conclusion that many digitally *created* works must be denied copyright protection because they are insufficiently "fixed." Without this Court's guidance, the creation of new works will be discouraged and the intent of Congress frustrated.

The Copyright Act provides that

> [a] work is "fixed" . . . when its embodiment in a copy . . . is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.

17 U.S.C. § 101.

The House Report leaves no doubt that the definition of "fixed" was intended to encompass the inputting of copyrighted elements onto a CD-ROM:

> Under the bill it makes no difference what the form, manner or medium of fixation may be — whether it is in words, numbers, notes, sounds, pictures, or any other graphic or symbolic indicia, whether embodied in a physical object in written, printed, photographic, sculptural, punched, magnetic, or any other stable form, and whether it is capable of perception directly or by means of any machine or device "now known or later developed."

H.R. REP. NO. 94-1476, at 52, *reprinted in* 1976 U.S.C.C.A.N. 5659, 5665. Under the statutory definition, any pre-programmed arrangement contained on a CD-ROM is "fixed" — *i.e.*, sufficiently non-transitory to permit reproduction. It is undisputed in this case, for example, that the Bender and Hyperlaw software enables a user to access, and print out, a copy of West's protected case arrangement.

Yet the Second Circuit failed to apply the plain meaning of the Act, concluding that West's arrangement is not "fixed" on the Bender and HyperLaw Products because it is not physically embedded on the CD-ROMs:

> [T]he only fixed arrangement is the (non-West) sequence that is *embedded* on plaintiffs' CD-ROM discs and that appears with the aid of a machine *without manipulation of the data*. . . . [T]he arrangement of the "work" on plaintiffs' CD-ROM discs is the arrangement of cases that is displayed by a CD player reading the information in the order in which it is *physically embedded* or "fixed" in the discs. . . .

158 F.3d at 703 and 704, Pet. App. 24a and 26a (emphasis added).[8]

In fact, there are no permanently fixed, "embedded," or visible arrangements on a CD-ROM. On the contrary, there are only those arrangements that, as a result of the CD-ROM manufacturer's programming and marking of the data, are readily perceivable to a user who accesses that pre-programmed arrangement.[9] The physical-storage arrangement of CD-ROM

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8. The Second Circuit apparently relied on the mistaken belief that CD-ROMs feature some garden-variety "browsing" arrangement related to the physical-storage arrangement. There is no basis, in general or in this case, for an inference that any so-called "browsing" arrangement is permanently visible or displayed without user "manipulation."

9. As one scholar has aptly put it:

> [I]t is often senseless to seek in [computer databases] a specific, fixed arrangement of data. There is simply a collection of information stored in an electronic memory — information that can be arranged and retrieved in variations limited only by the capabilities of the computer and the sophistication of the retrieval program.

See Robert C. Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 COLUM. L. REV. 516, 531 (1981).

data is not routinely made visible to users, nor is it of any practical significance or utility to them.[10] The physical "embedding" of information on a CD-ROM is in no way comparable to placing words on a page. No arrangement or sequence of data on any CD-ROM is perceivable "without manipulation of the data."

Thus, the Second Circuit's equation of a CD-ROM's physical-storage arrangement of information with the arrangement perceptible to the user strikingly demonstrates the degree of confusion that arises in applying the Act's "fixation" requirement to digital technology.[11] According to the Second Circuit, a digital work must be analyzed solely in terms of how the information in the work is physically stored, irrespective of how the information has been "tagged" and otherwise marked

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10. It would be highly unusual, and purposeless, to store data in any user-oriented order; rather, data storage is dictated by the technical logistics of optimizing the efficient storage of data in the smallest possible space. Data is stored on a CD by means of a series of "pits" (low spots) and "lands" (high spots). As the laser shines into the moving pits and lands, a sensor detects a change in reflection when it encounters a transition from pit to land or land to pit. Each transition is a 1; the lack of transitions are 0s. The computer then interprets these 1s and 0s and arranges them into the proper order to form readable text.

11. Indeed, The Second Circuit's holding, which effectively reduces compilation copyright to nothing more than protection from verbatim print photocopying, ignores the essential nature and character of electronic products:

> [D]igital works . . . cannot be perceived or read by humans except with the aid of a user interface. One cannot tell from viewing one portion of such a work on a computer screen how large the work is, nor can one navigate through the text unless navigation aids have been specially constructed in software to permit this.

Samuelson & Glushko, *supra*, 6 HARV. J. L. & TECH. at 241.

for retrieval. This approach is dangerous because, for example, it would deny copyright protection to virtually all CD-ROM compilers — who use a purely functional arrangement for storage but who tag the information so that a user can access a creative arrangement.

This Court's guidance is needed to clarify the "fixation" requirement in the context of digital technology — a critical issue for the future of electronic publishing.[12]

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12. The Second Circuit's analysis of "substantial similarity," based on the same misapprehensions about CD-ROM technology, also would permit unlimited infringement by CD-ROM. 158 F.3d at 704-06, Pet. App. 26a-30a. According to the majority, a manufacturer may encode an original, copyrighted arrangement of public domain material onto a CD-ROM so long as he also encodes some garden-variety arrangement of the data. There will be no "substantial similarity" because the copyrighted arrangement will always be compared, against all logic, to the garden-variety arrangement, not to the identical copy, readily perceivable on the CD-ROM, of the copyrighted arrangement. (Courts that follow the Second Circuit will assume, mistakenly, that this garden-variety arrangement corresponds to the actual physical-storage arrangement of data.) As the dissent noted:

> It is immaterial that plaintiffs' products may display other arrangements as well as West's. The capability of a CD-ROM to display more than one arrangement does not make the encoding of an original selection and arrangement such as West's any less of an infringement. It is also irrelevant that plaintiffs' products may contain material beyond West's selection and arrangement. Infringement is determined by how much of the copyright owner's work was taken, not by what else the copier's work contains. See, e.g., Warner Bros., Inc. v. American Broadcasting Cos., Inc., 720 F.2d 231, 241 (2nd Cir. 1983).

158 F.3d at 709, n.1, App. Pet. 40a n.1.

B. The Supreme Court's Guidance Is Needed To Clarify That The Statute's Definition Of "Copies" Applies To Copies Accessed By CD-ROM Users With The Aid Of A Computer

Congress anticipated digital technology by specifying that, for purposes of the Act, a "copy" of a work need not be visible but may be perceived "with the aid of a machine or device." CD-ROM users, with a computer, can access, view, and print data arrangements that are adequately pre-programmed or marked by the CD-ROM producer. These retrieved copies of data arrangements clearly would infringe under the statutory definition.[13] If they did not, anyone could sell exact copies of copyrighted data compilations with impunity, so long as the infringing copies are offered in the CD-ROM format, which requires user retrieval to make any arrangement visible.

The Second Circuit's decision, however, demonstrates that, absent this Court's guidance, the Act's reference to "with the aid of machine or device" may be seriously misinterpreted, particularly by anyone with a limited understanding of digital technology. The Second Circuit's reading of the statute arises, in large part, from its misapprehension that the computer, by itself, without any directive from a user, "reads" and "perceives" some permanently fixed arrangement on a CD-ROM:

> [W]e conclude that a CD-ROM disc infringes a copyrighted arrangement *when a machine or device* that reads it *perceives* the embedded material in the

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13. Similarly, in *Tasini*, *supra*, the court found that the component parts of a collective work remained collective despite being *stored* in an electronic database alongside innumerable unrelated articles, in part because of electronic "tagging." 972 F. Supp. at 823-24.

> copyrighted arrangement or in a substantially similar arrangement.

158 F.3d at 701, Pet. App. 20a (emphasis added). In fact, of course, the computer itself "perceives" nothing; rather, it is the tool through which the user perceives data. The essential nature of CD-ROM technology is that only the user's commands or searches dictate what is perceivable from the database, which has no inherent or meaningful arrangement. Nonetheless, the Second Circuit grounded its interpretation on the mistaken belief that some data arrangements are permanently fixed, and therefore instantaneously visible when a CD-ROM is "hooked up" to a computer.[14]

The Second Circuit's other fundamental misunderstanding is that the user of a CD-ROM *alters* "the fixed embedding of the work," "uses the machine to re-arrange the material into the copyrightholder's arrangement," and thereby becomes the "initiator" of the infringement. 158 F.3d at 702-03, Pet. App. 20a, 24a. In fact, no CD-ROM user can, or does, alter the data on the disc in any way.[15] He or she merely accesses, through a series of keystrokes or mouse clicks (analogous to turning book pages), the pre-programmed arrangement of data by the CD-ROM manufacturer. In this case, the user who decides to view the copy of West's arrangement pre-programmed on the CD-ROM is not initiating the infringement. That occurred long before — when Bender and HyperLaw systematically copied the expression of West's arrangement from every page of every volume and programmed it onto the CD-ROM, and again when they distributed their products.

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14. *See supra* note 8.

15. Indeed, the letters "RO" in CD-ROM stand for "Read Only."

Thus, the Second Circuit has effectively rewritten the statute to narrow the definition of "copies," transforming it from a forward-looking definition to one essentially limited to technologies well-known in 1976.[16] Congress' definition is purposely open-ended: a copy is a material object (such as a CD-ROM) from which the "work can be perceived" *by a human being* "with the aid of a machine or device." The statute, leaving room for technologies not yet developed, does not specify how the machine enables a person to perceive the work. The Second Circuit's interpretation of the statute requires that the work must be perceived, without any action by the user, by the "machine or device" itself.

This interpretation of "copies" simply immunizes all pre-programmed CD-ROM arrangements, none of which appear without a user's "manipulation." A CD-ROM manufacturer can copy an original arrangement of data, program it into a CD-ROM's database, and make it readily accessible for viewing and reproduction — all with little or no risk of a judicial finding of "copying." Moreover, the Second Circuit's interpretation of key statutory terms ("perceive" and "with the aid of a machine or device") makes original compilations and other works created on CD-ROM ineligible for any copyright protection, pursuant to Section 102(a) of the statute, since they cannot be instantaneously perceived by a computer without user "manipulation."

Data compilation and arrangement may be the most important segment of the nation's electronic publishing industry. This Court's intervention is needed to ensure that copyright protection is not effectively eliminated for an entire class of works — one particularly vital to the national economy — that

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16. *See* 158 F.3d at 702-03, Pet. App. 22a-24a.

Congress plainly intended to protect.[17] Absent clarification of the statutory provisions by this Court, the copyrights of compilers will be jeopardized by inconsistency of decision and the type of underprotection that results from the opinion below.

C. The Second Circuit's Ruling That "Mere Page Numbers" Can Never Be Protected Conflicts With This Court's Decision In *Callaghan* And Opens The Door To Unlimited Infringement Through Electronic Copying Of Arrangements

By departing from this Court's holding in *Callaghan*, the decision below threatens the very existence of arrangement and compilation copyright in an electronic environment. The Second Circuit's reasoning completely ignores the fact that West's volume and page numbers — or, to take another example, the paragraph numbers in CCH's reporters — are, when comprehensively linked to the case names or relevant texts, a complete expression of the compilation author's arrangement of the judicial opinions. In *Callaghan*, this Court recognized the potential expressiveness of pagination when it included "the order of the arrangement of the cases, the division of the reports into volumes, [and] the numbering and paging of the volumes" among the potentially copyrightable elements in case-report compilations.[18] The decision below conflicts with *Callaghan* as

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17. The Court of Appeals suggests that the only way a CD-ROM, involving "manipulation of the data" (as does every CD-ROM), might be a "copy" under the Act is if the "manipulation" were "invited." 158 F.3d at 703, Pet. App. 24a. Why isn't Bender and HyperLaw's insertion of star pagination precisely this type of "invitation"? Star pagination obviously invites the pre-programmed software to be used to view West's original, copyrighted arrangement of cases.

18. As the district court noted in *West v. Mead*, *Callaghan* does not stand for the proposition that pagination is *per se* protectible but (Cont'd)

well as *West v. Mead* by relying on the misconception that "mere page numbers" (or other expressions of order and arrangement) never can be protected, even when they function, *en masse*, as a code for copying an author's original arrangement. Ignored is the critical difference between the mere copying of facts and the making of a computer-perceptible copy of a copyrighted arrangement through the comprehensive electronic copying of all the information about the author's choices in arranging facts.[19]

The *Callaghan* Court's recognition that pagination may express copyrightable selection and arrangement has become particularly valid and meaningful in this electronic age. In database terms, the page numbers are "compilation markers" that, programmed into digital text, can fully replicate an original compilation, including its protectible selection and arrangement. In order to appropriate an arrangement of public domain material,

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(Cont'd)
rather that pagination "ascend[s] to a level appropriate for copyright protection" when it expresses creative selection and arrangement. 616 F. Supp. at 1576.

19. By characterizing all the page locations in West's compilations as unprotectible "facts," the Second Circuit again took an analytical mis-step that would render meaningless any copyright protection for compilations. The court failed to distinguish between pre-existing facts contained in a work (like the data in a white pages directory) and facts about a copyrighted work that come into existence only after the work has been created, and *solely as the result of authorship*. *Feist* expressly recognized the difference between "pre-existing uncopyrightable facts" and the copyrightable arrangement of those facts. *See* 499 U.S. at 361-62, 111 S. Ct. at 1296-97. The "facts" about West's arrangements (series names, volume numbers, page numbers), when comprehensively copied and programmed into a database, are clearly not "pre-existing uncopyrightable facts" but, rather, the expression of West's copyrightable arrangements. *See* 158 F.3d at 710, Pet. App. 41a (Sweet, J., dissenting).

it is not necessary to copy all the pieces in their arranged order. It is sufficient to copy the incremental data points required to express the arrangement and program them into the relevant public domain database. In this case, the incremental data points are the page numbers and their relative text position. Thus, the page numbers, placed in the proper position in the cases, are themselves the expression of the arrangement.[20]

Absent guidance from this Court, confirming that comprehensive copying of "compilation markers" sometimes can constitute infringement of an original arrangement or selection, copyright holders face the risk of unlimited electronic copying. Virtually all computer-based data compression methods rely on the principle of using incremental data points as a shorthand for conveying expression. Digital texts or images are not compressed by somehow "squeezing" the data into a smaller space, but by eliminating all data except those incremental points required to produce an exact copy of the original.[21] Without this

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20. This basic concept has numerous applications in everyday life — for example, the giving of street directions. In order to tell someone how to walk from one point to another, it is not necessary to describe each inch of the path along the way. It is sufficient to convey only the incrementally relevant data points: *i.e.*, walk east on Street A to Street B, turn south on Street B until you reach Street C, and then walk east until to reach Street D. If these short-hand instructions were electronically programmed into a database containing the overall street configuration, a user could view the *complete* path from one point to the other. This path is an exact analogy for the complete text of an original copyrightable arrangement. Just as the short-hand instructions fully express the path, so, too, West's pagination fully expresses its arrangement.

21. Hypothesize a computer displaying a simple picture — a screen half blue and half green — by arranging individual points of color in the proper order. Each pixel is identified to the computer by its coordinates along paired x, y axes. Thus, the computer could display the picture through a long, cumbersome series of individual instructions specifying the color for each individual pixel, arranged in the proper

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compression method, many of the high speed data transmissions we take for granted (*e.g.*, Internet transmissions, digital cellular phone transmissions, and digital television signals, such as satellite and HDTV) would not be possible. In each, the computer efficiently stores only the relevant incremental data points, rather than all the data itself.

According to the Second Circuit's reasoning, all data-compression computer technologies (not just CD-ROMs) could be used to deliver exact copies of copyrighted compilations without liability — since, in literal, non-statutory terms, they "copy" only the "facts" about the selection and arrangement of these works. Indeed, in the world of electronic publishing, any work, no matter how creative, can be freely copied by inputting and programming all the "facts" about its arrangement so that, in combination with the relevant raw database, a fully perceptible, reproducible copy of the author's original arrangement is displayed. *See CCC Information Services v. Maclean Hunter Market Reports, Inc.*, 44 F.3d 61, 71 (2d Cir. 1994), *cert. denied*, 516 U.S. 817 (1995) (at some level of abstraction, every recitation or copying of a work is "factual").

(Cont'd)

order. Alternatively, the computer could be given a single instruction to display every pixel green, until it reaches a particular designated pixel, and then display every pixel blue. This type of instruction allows the computer to arrange the colored pixels in exactly the same order, but accomplishes it much more efficiently by conveying only the incremental data necessary to produce the arrangement. This is exactly what HyperLaw and Bender have done by reproducing West's pagination. Rather than reproduce the full-text result of West's original arrangement by physically replicating the cases, arranged in West's order, they have taken only the compilation markers or incremental data points (the page numbers and page break locations) necessary to allow them to produce exactly the same expression of West's arrangement. Just as either set of instructions to the computer in the foregoing example expresses the same arrangement of pixels, West's case reporters and HyperLaw and Bender's star pagination express the same arrangement of cases.

Granting a writ in this case will provide this Court with an opportunity to reaffirm *Callaghan* and address an important federal question: the crucial distinction, in an electronic environment, between uncopyrightable facts and author-created "facts" that are copyrightable because they are the *sine qua non* of an original arrangement, and a code for verbatim copying.

CONCLUSION

For the foregoing reasons, West respectfully request that a writ of certiorari to the United States Court of Appeals for the Second Circuit be granted.

Respectfully submitted,

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APPENDIX

APPENDIX A — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT DATED NOVEMBER 3, 1998 AND FILED NOVEMBER 4, 1998

UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

August Term, 1997

(Argued: March 16, 1998 Decided: November 03, 1998)

Docket No. 97-7430

MATTHEW BENDER & COMPANY, INC.,

Plaintiff-Appellee,

HYPERLAW, INC.,

Intervenor-Plaintiff-Appellee,

– v.–

WEST PUBLISHING CO.; WEST PUBLISHING CORPORATION,

Defendants-Appellants.

Before: CARDAMONE and JACOBS, *Circuit Judges*, and SWEET,* *District Judge.*

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* The Honorable Robert W. Sweet, of the United States District Court for the Southern District of New York, sitting by designation.

Appendix A

JACOBS, *Circuit Judge*:

Defendants-appellants West Publishing Co. and West Publishing Corp. (collectively "West") create and publish printed compilations of federal and state judicial opinions. Plaintiff-appellee Matthew Bender & Company, Inc. and intervenor-plaintiff-appellee HyperLaw, Inc. (collectively "plaintiffs") manufacture and market compilations of judicial opinions stored on compact disc-read only memory ("CD-ROM") discs, in which opinions they embed (or intend to embed) citations that show the page location of the particular text in West's printed version of the opinions (so-called "star pagination").[1] Bender and HyperLaw seek judgment declaring that star pagination will not infringe West's copyrights in its compilations of judicial opinions. West now appeals from a judgment of the United States District Court for the Southern District of New York (Martin, *J.*), granting summary judgment of noninfringement to Bender and partial summary judgment of noninfringement to HyperLaw.[2]

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1. This cross-reference method is called "star pagination" because an asterisk and citation or page number are inserted in the text of the judicial opinion to indicate when a page break occurs in a different version of the case.

2. The district court granted summary judgment to HyperLaw on the star pagination issue. However, HyperLaw had sought an additional declaration that its duplication of West's version of the captions and text of judicial opinions does not infringe West's copyright. The district court denied summary judgment on that claim, and ruled for HyperLaw following a bench trial. West appeals from that decision as well and we uphold that ruling in a separate opinion issued today. *See Matthew Bender & Co. v. West Publ'g Co.*, No. 97-7910.

Appendix A

West's primary contention on appeal is that star pagination to West's case reporters allows a user of plaintiffs' CD-ROM discs (by inputting a series of commands) to "perceive" West's copyright-protected arrangement of cases, and that plaintiffs' products (when star pagination is added) are unlawful copies of West's arrangement. We reject West's argument for two reasons:

A. Even if plaintiffs' CD-ROM discs (when equipped with star pagination) amounted to unlawful copies of West's arrangement of cases under the Copyright Act, (i) West has conceded that specification of the *initial* page of a West case reporter in plaintiffs' products ("parallel citation") is permissible under the fair use doctrine, (ii) West's arrangement may be perceived through parallel citation and thus the plaintiffs may lawfully create a copy of West's arrangement of cases, (iii) the incremental benefit of star pagination is that it allows the reader to perceive West's page breaks within each opinion, which are not protected by its copyright, and (iv) therefore star pagination does not *create* a "copy" of any protected elements of West's compilations or infringe West's copyrights.

B. In any event, under a proper reading of the Copyright Act, the insertion of star pagination does not amount to infringement of West's arrangement of cases.

BACKGROUND

West creates "case reports" of judicial opinions by combining (i) certain independently authored features, such as syllabi (which summarize each opinion's general holdings),

headnotes (which summarize the specific points of law recited in each opinion), and key numbers (which categorize the points of law into different legal topics and subtopics), with (ii) the text of the opinions, to which West adds parallel citations to other reporters, information about the lawyers, and other miscellaneous enhancements. West then publishes these case reports (first in paperbacked advance sheets, and then in hardbound volumes) in various series of "case reporters." These case reporters are collectively known as West's "National Reporter System," and include (as relevant to this case): the *Supreme Court Reporter*, which contains all Supreme Court opinions and memorandum decisions; the *Federal Reporter*, which contains all federal court of appeals opinions designated for publication, as well as tables documenting the disposition of cases that are unpublished; the *Federal Rules Decisions* and *Federal Supplement*, which contain selected federal district court opinions; and the *New York Supplement*, which contains selected New York State case reports.[3] Cases appearing in West's case reporters are

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3. West's general arrangement of its case reporters is as follows (with each subsequent category dictating the order of cases within the previous category):

> *Supreme Court Reporter*: Cases are organized: (i) by type of opinion (full opinion, then orders and memorandum decisions); (ii) then by order of the filing date; (iii) then by the seniority of the Justice who authored the opinion (*per curiam* opinions follow opinions authored by individual justices); and (iv) then by docket number.
>
> *Federal Reporter*: Cases are organized in advance sheets: (i) by court (first the D.C. Circuit, then the numbered Circuits, (Cont'd)

universally cited by the volume and page number of the case reporter series in which they appear. One citation guide recommends — and some courts require — citation to the West version of federal appellate and trial court decisions and New York State court decisions. *See The Bluebook: A Uniform System of Citation* at 165-67, 200-01 (16th ed. 1996); *see, e.g.*, Third Cir. R. 28.3(a); Eleventh Cir. R. 28-2(k); *see also The University of Chicago Manual of Legal Citation* 15 (1989) ("When citing to a state case, indicate the volume

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(Cont'd)

and finally the Federal Circuit); (ii) then by type of opinion (first opinions and jacketed memoranda, then "sheet memoranda"; cases reported in tables are placed together at the end of the advance sheet); and (iii) then chronologically. Two or three advance sheets are then combined in a permanent volume.

Federal Supplement and *Federal Rules Decisions*: Cases are organized in advance sheets: (i) by circuit; (ii) then alphabetically by state; (iii) then if a state has multiple districts in the following order: Northern, Central, Middle, Eastern, Western and Southern; and (iv) then chronologically. The advance sheets are then combined into a bound volume.

New York Supplement: Cases are organized in advance sheets: (i) by format, such as fully headnoted opinions and memorandum decisions; (ii) then by court level; (iii) then by department; and (iv) then chronologically. The advance sheets are then combined into a bound volume.

These general guidelines are subject to specific editorial decisions to publish cases sequentially or in the same volume, or to combine an opinion with a subsequent order amending the opinion or denying rehearing.

and first page of the case for both the official and commercial reporters.").

Bender markets a series of CD-ROM discs[4] called *Authority from Matthew Bender*. One product in this series — the "New York product" — consists of three elements: (i) "New York Law and Practice" (one disc), which contains New York statutory and treatise materials; (ii) "New York Federal Cases" (three discs), which contains cases from the Second Circuit and New York's federal district courts from 1789 to the present; and (iii) "New York State Cases" (four discs), which contains New York State judicial opinions from 1912 to the present (the New York State Court of Appeals cases begin in 1884). These CD-ROM discs contain published opinions and unpublished opinions and orders from these courts.

Bender obtains the text of the judicial opinions through a license from LEXIS (an on-line database containing legal and non-legal data), and stores the opinions and orders on the discs arranged by court and date, which is also the order in which they would be seen by a user who for some reason browses through the discs without sorting the case reports in a search. For each case that appears in West's case reporters, Bender intends to insert (and in some cases already has

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4. As noted by the parties, CD-ROM publications have several advantages over books, including the capability of: (i) storing large amounts of information in a small amount of space; (ii) locating items in the text using word searches; and (iii) printing out portions of the text or downloading them to disks. In addition, unlike on-line retrieval services which provide some of the same benefits, the CD-ROM user does not incur time charges.

inserted) a parallel citation (*e.g.*, 100 F.3d 101) to the West case reporter at the beginning of the opinion and a citation to the successive West page numbers at the points in the opinion where page breaks occur in the West volume (*e.g.*, *104 or 100 F.3d 104).

Bender uses the FOLIO file-retrieval program, which allows a user to access opinions in several ways, including in the order in which they are stored on the disc, or through term searches, or through a West or LEXIS parallel or page citation. In addition, citations appearing within judicial opinions are "hot linked," so that a user may retrieve the cited case by clicking the mouse on the case citation.

West claims (and for the purposes of this summary judgment motion, we accept as true) that the FOLIO retrieval system permits a user of Bender's product to view (and print) judicial opinions in the same order in which they are printed in a West volume by repeating the following steps: (i) a user activates the jump feature in the program to go to the first page in a West case reporter volume, (ii) pages through to the bottom of the case, (iii) finds the last star pagination reference, and (iv) activates the jump cite feature to retrieve the case beginning on the same or next West page number.[5]

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5. West's counsel describes the retrieval procedure this way:

> Using the [Bender] product, I was able to act in all ways as though I had a physical, print copy of volume 628 of West's *New York Supplement (Second)* series. I typed the West citation "nys2d|628|1," and the product displayed the caption of the case, "*In the Matter of Neftali*

(Cont'd)

Appendix A

HyperLaw markets *Supreme Court on Disc*, an annual CD-ROM disc containing opinions of the United States Supreme Court since 1991, and *Federal Appeals on Disc*, a quarterly CD-ROM disc containing nearly all opinions (published and unpublished) of the federal courts of appeals

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D.," that West chose to arrange as the first case in volume 628. The product indicated that West's headnotes and other material occupied the rest of page 1, because the text of the court's decision begins after the star page **{628 N.Y.S.2d 2}**. Reading through the text of the decision, I saw where the text that West had put on page 2 ended and where the text on page 3 began, because there was a marker to show where in mid sentence page 2 ended and page 3 began. The marker was a bold green **{628 N.Y.S.2d 3}**. Likewise, I saw where page 3 ended, because there was a bold green **{628 N.Y.S.2d 4}**. From observing the fact that (1) that there was no marker to show where page 5 began, and (2) that the amount of text after the page 4 marker was notably less than the amount between page 3 and page 4, I could see that the next case in volume 628 also began on page 4 of the volume. I then entered the West citation "nys2d|628|4" to look at the next case, and continued similarly.

I found that I did not even need to type in the West citations if I simply put the cursor at the left hand bracket of the last star page marker of the previous case. With the cursor there, pressing control-d brought up a jump link destination box with the West cite already typed in for me, such as "nys2d|628|p4." Deleting the "p," I could then go to the next case as arranged in volume 628 of West's *New York Supplement* without having to type the full cite.

since January 1993.[6] HyperLaw currently obtains the text of its opinions directly from the courts and includes in its *Federal Appeals* CD-ROM disc many more cases than published by West. The opinions are organized on the CD-ROM disc in an order that is "approximately chronological." HyperLaw includes parallel citations to West's case reporters for all cases appearing in the *Supreme Court Reporter* and the *Federal Reporter*, and intends to add star pagination as well.[7]

Bender's complaint sought a judgment declaring that star pagination to West's case reporters will not copy West's arrangement or infringe West's copyright. HyperLaw intervened seeking the same relief. All parties then moved for summary judgment. The district court granted summary judgment to plaintiffs on the star pagination issue, concluding that the insertion of star pagination to West's volumes on the CD-ROM version of the cases would not reproduce any protectable element of West's compilation. The court noted that "the protection extends only to those aspects of the compilation that embody the original creation of the compiler" and that "where and on what particular pages the text of a court opinion appears does not embody any original

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6. The record seems to indicate that since the commencement of this suit, HyperLaw has combined these two products into one.

7. HyperLaw claims that its product does not permit users to view cases in the same order as they appear in the West case reporters. However, the district court did not distinguish between Bender's and HyperLaw's display and retrieval capabilities, and because it does not affect the outcome of this case, we will assume that HyperLaw's product has the same retrieval capabilities as the Bender product.

creation of the compiler, and therefore . . . is not entitled to protection." The court further ruled that star pagination would be permitted under the fair use doctrine even if West's pagination were copyrightable.

DISCUSSION

West's case reporters are compilations of judicial opinions. The Copyright Act defines a "compilation" as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship." 17 U.S.C. § 101 (1994). Compilations are copyrightable, but the copyright "extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work." 17 U.S.C. § 103 (1994).[8] Works of the federal

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8. Section 103 of the Copyright Act provides:

> (a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.
>
> (b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material.

17 U.S.C. § 103.

government are not subject to copyright protection, 17 U.S.C. § 105 (1994), although they may be included in a compilation.

Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 111 S. Ct. 1282 (1991), is the seminal Supreme Court decision on copyrights in compilations. In *Feist*, the publisher of a telephone book claimed that a competitor had infringed its compilation copyright by copying some of its white pages listings. The Court clarified the scope of a copyright in compilations: "A factual compilation is eligible for copyright if it features an original selection or arrangement of facts, but the copyright is limited to the particular selection or arrangement. In no event may copyright extend to the facts themselves." *Id.* at 350-51, 111 S. Ct. at 1290. Because of this limitation on protectability, "the copyright in a factual compilation is thin. Notwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, so long as the competing work does not feature the same selection and arrangement." *Id.* at 349, 111 S. Ct. at 1289. The Court expressly rejected the "sweat of the brow" doctrine, which had justified the extension of copyright protection to the facts and other non-original elements of compilations on the basis of the labor invested in obtaining and organizing the information. *Id.* 359-60, 111 S. Ct. at 1295.

Under *Feist*, two elements must be proven to establish infringement: "(1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original." *Id.* at 361, 111 S. Ct. at 1296. Bender and HyperLaw concede that West has proven the first element of infringement, *i.e.*, that West owns a valid copyright in each of its case reporters.

However, as is clear from the second *Feist* element, copyright protection in compilations "may extend only to those components of a work that are original to the author." *Id.* at 348, 111 S. Ct. at 1289. The "originality" requirement encompasses requirements both "that the work was independently created . . ., *and* that it possesses at least some minimal degree of creativity." *Id.* at 345, 111 S. Ct. at 1287 (emphasis added); *see also Key Publications, Inc. v. Chinatown Today Publ'g Enters., Inc.*, 945 F.2d 509, 512-13 (2d Cir. 1991) ("Simply stated, original means not copied, and exhibiting a minimal amount of creativity."). At issue here are references to West's volume and page numbers distributed through the text of plaintiffs' versions of judicial opinions. West concedes that the pagination of its volumes — *i.e.*, the insertion of page breaks and the assignment of page numbers — is determined by an automatic computer program, and West does not seriously claim that there is anything original or creative in that process. As Judge Martin noted, "where and on what particular pages the text of a court opinion appears does not embody any original creation of the compiler." Because the internal pagination of West's case reporters does not entail even a modicum of creativity, the volume and page numbers are not original components of West's compilations and are not themselves protected by West's compilation copyright.[9] *See Feist*, 499 U.S. at 363,

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9. The same conclusion can be arrived at using a different chain of reasoning. There is a fundamental distinction under the Copyright Act between the original work of authorship and the physical embodiment of that work in a tangible medium. *See* H.R. Rep. No. 94-1476, at 53 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5666 (noting "a fundamental distinction between the 'original work' which

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111 S. Ct. at 1297 ("As a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity.").

Because the volume and page numbers are unprotected features of West's compilation process, they may be copied without infringing West's copyright.[10] However, West proffers an alternative argument based on the fact (which West has plausibly demonstrated) that plaintiffs have inserted or will insert *all* of West's volume and page numbers for certain case reporters. West's alternative argument is that even

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is the product of 'authorship' and the multitude of material objects in which it can be embodied. Thus, in the sense of the [Act], a 'book' is not a work of authorship, but is a particular kind of 'copy.' Instead, the author may write a 'literary work,' which in turn can be embodied in a wide range of 'copies' and 'phonorecords' . . . ."). The embedding of the copyrightable work in a tangible medium does not mean that the features of the tangible medium are also copyrightable. Thus, here, the original element of West's compilation, its arrangement of cases, is protectable, while the features of the physical embodiment of the work, *i.e.*, the page numbers, are not.

10. The dissent would extend copyright protection to all page numbers because, when inserted into a complete set of opinions appearing in West's case reporters, they reflect the arrangement of those reporters. Dissent at 40a. But such an approach would extend copyright to page numbers which do not represent an exercise of original authorship. Although the arrangement of West's cases may be copyrightable, and although *complete* star pagination may permit the perception of that arrangement, there is no support for extending copyright protection to an unoriginal element because when completely copied it reveals a protected element rather than copies it.

though the page numbering is not (by itself) a protectable element of West's compilation, (i) plaintiffs' star pagination to West's case reporters embeds West's arrangement of cases in plaintiffs' CD-ROM discs, thereby allowing a user to perceive West's protected arrangement[11] through the

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11. West claims that its arrangement of cases, *see supra* note 3, is original and worthy of copyright protection. Hyperlaw (but not Bender) argues that West's arrangement of cases in the *Supreme Court Reporter* and the *Federal Reporter* (the case reporters containing the opinions included on HyperLaw's CD-ROM discs) is insufficiently original to be copyrightable. But because we find that West's arrangement has not been copied through the insertion of star pagination to West's case reporters, we can assume without deciding that West's case reporters contain an original and copyrightable arrangement.

In addition, this opinion will not address any copying by plaintiffs of the *selection* of cases included in West's case reporters. First, West argued below that Bender had copied West's arrangement of cases, not its selection. Second, it is uncontested that plaintiffs' compilations include many more opinions than West's case reporters. For example, *HyperLaw's* second quarter 1996 CD-ROM disc contained approximately 36,000 Supreme Court and court of appeals decisions, only 22,000 of which were published by West. The selection of cases for *Bender's* product also differs from West's: (i) it contains many unpublished decisions not found in West's reporters, and (ii) unlike West's *Federal Reporter*, *Federal Supplement*, and *Federal Rules Decisions*, Bender's product includes only federal cases decided by *New York* courts. Accordingly, we cannot find that the selection of cases in plaintiffs' compilations is substantially similar to West's selection. *See Tasini v. New York Times Co.*, 972 F. Supp. 804, 823 (S.D.N.Y. 1997) (Sotomayor, J.) (noting that to find infringement of selection, "the subsequent work cannot differ in selection by 'more than a trivial degree' from the work that preceded it") (citing *Kregos v. Associated Press*, 937 F.2d 700, 710 (2d Cir. 1991)).

plaintiffs' file-retrieval programs, and (ii) that under the Copyright Act's definition of "copies," 17 U.S.C. § 101, a work that allows the perception of a protectable element of a compilation through the aid of a machine amounts to a copy of the compilation. We reject this argument for two separate reasons.[12]

A

West asserts an indirect infringement theory: (i) the embedding of unprotectable volume and page numbers in a

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12. Plaintiffs cite *Banks Law Publishing Co. v. Lawyers' Co-Operative Publishing Co.*, 169 F. 386 (2d Cir. 1909), in arguing that star pagination to case reporters is permissible, and they intimate that *Banks* held that the arrangement of cases cannot be copyrightable. *Banks*'s holding seems to have rested on the plaintiff's status as an official reporter. *See id.* at 389 (reprint of text of district court opinion) ("A reasonable interpretation of the statute prescribing his duties implies pagination, volumes of uniform size and reasonable thickness, together with a suitable and convenient arrangement of the cases."). True, our opinion in *Banks* adds that "[i]t is not necessary to discuss so much of the opinion below as deals with the question[] of . . . the right of the official reporter to secure copyrights," *id.* at 391, which could imply either that our holding did not rest on the official status of the reporter but on the lack of originality in the arrangement *or* that the foregone analysis concerns the copyrightability of elements not dictated by statute. In any event, Bender concedes for the purpose of summary judgment that West's arrangement is sufficiently original to merit copyright protection; *Banks* does not assist in answering the distinct question of whether star pagination infringes the arrangement of another reporter if the arrangement of the cross-paginated work is copyrightable; and *Banks* preceded even the effective date of the Copyright Act of 1909. We decline to decide this case on the strength of *Banks*.

CD-ROM disc (so-called "compilation markers" or "tags"), (ii) permits a user to perceive West's arrangement of cases through the aid of a machine, and (iii) this amounts to a copy of the compilation's arrangement under § 101's definition of "copies." Assuming for the moment that West has properly read the Act, *i.e.*, that a copy of the arrangement is created when the arrangement can be perceived with the aid of a user *and* a machine, we think it is clear that the copy is not created by insertion of star pagination.

West concedes that insertion of parallel citations (identifying the volume and first page numbers on which a particular case appears) to West's case reporters in plaintiffs' products (as well as any other compilations of judicial opinions) is permissible under the fair use doctrine.[13] *See* West Reply Brief at 5 n.5 (noting "West's long-held position that parallel citation to West case reports by competitors (*without* additional star pagination) is a fair use under 17 U.S.C. § 107 — *i.e.*, an *otherwise infringing use* that, when analyzed under the § 107 factors, is deemed 'fair' "); West's Response to Bender's Rule 3(g) Statement ¶ 32, Joint Appendix at 1581; *see also West Publ'g Co. v. Mead Data*

13. According to Bender and HyperLaw, West has admitted before various courts and congressional panels that West's parallel citation is in the *public domain*. But these statements were not in the context of a legal proceeding or unequivocal, and there is no evidence that a court has adopted this position in some manner. *See AXA Marine & Aviation Ins. (UK) Ltd. v. Seajet Indus. Inc.*, 84 F.3d 622, 628 (2d Cir. 1996) (noting that "[a] party invoking judicial estoppel must show that (1) the party against whom judicial estoppel is being asserted advanced an inconsistent factual position in a prior proceeding, and (2) the prior inconsistent position was adopted by the first court in some manner").

Central, Inc., 799 F.2d 1219, 1222 (8th Cir. 1986) ("West concedes that citation to the first page of its reports is a noninfringing 'fair use' under 17 U.S.C. § 107."). West admitted at oral argument (as it did in the district court [14]) that these parallel citations already allow a user of plaintiffs' CD-ROM discs to perceive West's arrangement with the aid of a machine and that plaintiffs' CD-ROM discs therefore already have created a lawful "copy" of West's arrangement on their CD-ROM discs — as West defines "copy." [15]

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14. The following exchange occurred before the district court:

> THE COURT: Star pagination, though, you say if by using the star pagination they can duplicate through their computer the West system, why can't they do that, why . . . can't they reproduce your compilation simply by using the first page?
>
> MR. MUSILEK [West's Counsel]:
>
> Your Honor, they can. They cannot show where in fact page breaks occur; they cannot show the page numbers associated with those page breaks for finding specific portions of text.

Joint Appendix at 3507.

15. A user of plaintiffs' CD-ROM products containing only parallel citation to West's case reporters could use the same method described by West's attorney, *see supra* note 5, to recreate West's arrangement, although it might require some trial and error to locate the exact page where the next West case begins.

Once the copy has thus been created through parallel citation — assuming that anyone would wish to avail themselves of the capability of perceiving this copy — the only incremental data made perceivable (through the aid of a machine) by star pagination is the location of page breaks within each judicial opinion. But since page breaks do not result from any original creation by West, their location may be lawfully copied. We therefore conclude that star pagination's volume and page numbers merely convey unprotected information, and that their duplication does not infringe West's copyright.

The opposite conclusion was reached by the district court in *Oasis Publishing Co. v. West Publishing Co.*, 924 F. Supp. 918 (D. Minn. 1996), which reasoned that the fair-use copying of parallel citation, which could be used to perceive the arrangement of cases, did not excuse copying interior pagination, which could also be used to perceive arrangement. *See id.* at 926.[16] It is true that copying under the fair use

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16. The court noted:

> Although with either the parallel cites *or* an internal cite from each case a user could sort West's cases and determine West's arrangement, the former does not utterly supplant the need for West's product while the latter does.
>
> Conceding parallel citation to the first page of each case as a noninfringing fair use does not diminish West's copyright interest in the subsequent internal pages, which also would *independently* permit arrangement of the cases by sorting. Having gotten the inch under the

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doctrine will not necessarily permit additional uses, and will not excuse additional copying that in the aggregate amounts to infringement. But a compilation has limited protectability; only the original elements of a compilation (*i.e.*, its selection, arrangement, and coordination) are protected from copying. The insertion of parallel citations already creates a "copy" of West's arrangement (at least as West defines a copy), a copy that is permissible under the fair use doctrine. Star pagination cannot be said to create *another* copy of the same arrangement. Prohibiting star pagination would simply allow West to protect *unoriginal* elements of its compilation that have assumed importance and value. Accordingly, even were we to agree with West's interpretation of the Copyright Act, we would not find infringement.

B

But our rejection of West's position is even more fundamental. If one browses through plaintiffs' CD-ROM discs from beginning to end, using the computer software that reads and sorts it, the sequence of cases owes nothing to West's arrangement. West's argument is that the CD-ROM discs are infringing copies because a user who manipulates the data on the CD-ROM discs could at will re-sequence the cases (discarding many of them) into the West arrangement. To state West's theory in the statutory words on which West

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> conceded fair use of parallel citation to the first page of each case, Oasis is not thereby entitled to take the entire mile in star citation to *every* page.

Oasis Publ'g Co., 924 F. Supp. at 926.

(mistakenly) relies, each of the plaintiffs' CD-ROM discs is a "copy" because West's copyrighted arrangement is "fixed" on the disc in a way that can be "perceived . . . with the aid of a machine or device." 17 U.S.C. § 101 (1994).

For reasons set forth below, we conclude that a CD-ROM disc infringes a copyrighted arrangement when a machine or device that reads it perceives the embedded material in the copyrighted arrangement or in a substantially similar arrangement. At least absent some invitation, incentive, or facilitation not in the record here, a copyrighted arrangement is not infringed by a CD-ROM disc if a machine can perceive the arrangement only after another person uses the machine to *re*-arrange the material into the copyrightholder's arrangement.

1. Section 101's Definition of "Copies"

West relies on the statutory definition of "copies." To establish infringement, the copyright holder must demonstrate a violation of an exclusive right. 17 U.S.C. § 501 (1994). One such right is the right "to reproduce the copyrighted work in *copies* or phonorecords." 17 U.S.C. § 106(1) (1994) (emphasis added). Section 101 of the Copyright Act defines "copies" as follows, the emphasis supplied on terms implicated by the analysis in this case:

> "Copies" are material objects, other than phonorecords, in which a work is *fixed by any method* now known or later developed, and *from which the work can be perceived*, reproduced, or otherwise communicated, either directly or *with*

> *the aid of a machine or device*. The term "copies" includes the material object, other than the phonorecord, in which the work is first fixed.

17 U.S.C. § 101. "A work is 'fixed' in a tangible medium of expression when its embodiment in a copy . . . is sufficiently permanent or stable to permit it to be *perceived*, *reproduced*, or otherwise communicated for a period of more than transitory duration." *Id.* (emphasis added).

The Copyright Act establishes a "fundamental distinction" between the original work of authorship and the material object in which that work is "fixed." *See supra* note 9. The sole purpose of § 101's definitions of the words "copies" and "fixed" is to explicate the "fixation" requirement, *i.e.*, to define the material objects in which copyrightable and infringing works may be embedded and to describe the requisite fixed nature of that work within the material object. *See* 1 William F. Patry, *Copyright Law and Practice* 168 (1994) ("The two essential criteria of statutory copyright are originality and fixation."); *id.* at 174 (noting that the definition of "copies" is "intended to 'comprise all the material objects in which copyrightable objects are capable of being fixed' "). Under § 101's definition of "copies," a work satisfies the fixation requirement when it is fixed in a material object from which it can be perceived or communicated directly or with the aid of a machine.[17]

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17. The wording of the definition is set forth in the previous paragraph of text. 17 U.S.C. § 101. The dissent argues that the first "work" in this passage references the allegedly infringing work, while

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This definition was intended to avoid the distinctions "derived from cases such as *White-Smith Publishing Co. v. Apollo Co.*, 209 U.S. 1[, 28 S. Ct. 319] (1908), under which statutory copyrightability in certain cases [had] been made to depend upon the form or medium in which the work is fixed." H.R. Rep. No. 94-1476, at 52 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5665; *see also* S. Rep. No. 94-473, at 51 (1975).[18] In *White-Smith*, the Supreme Court held that

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the second "work" refers to the original work. Dissent at 42a-43a. Our interpretation of the statute flows from a plain reading, under which the same meaning is attached to each reference to a "work"; there is no indication in the statute that the second "work" is intended to refer to the original work of authorship, as opposed to simply the work that is fixed in the material object.

18. In explaining the fixation requirement, the House Report states in full:

> As a basic condition of copyright protection, the bill perpetuates the existing requirement that a work be fixed in a "tangible medium of expression," and adds that this medium may be one "now known or later developed," and that the fixation is sufficient if the work "can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." This broad language is intended to avoid the artificial and largely unjustifiable distinctions, derived from cases such as *White-Smith Publishing Co. v. Apollo Co.*, 209 U.S. 1 (1908), under which statutory copyrightability in certain cases has been made to depend upon the form or medium in which the work is fixed. Under the bill it makes no difference what the form,

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a piano roll did not infringe the copyrighted music it played because its perforations were unintelligible to the eye and therefore did not amount to a "copy" of the music (which the Court defined as " 'a written or printed record of [the musical composition] in intelligible notation' "). *See White-Smith Publ'g Co.*, 209 U.S. at 17, 28 S. Ct. at 323. There was no question in that case that the work embodied in the piano roll reproduced the original work of authorship, *i.e.*, the piece of music; the only question was whether this reproduction met the "fixation" requirement. Thus, the definition of "copies" is intended to expand the "fixation" requirement to include material objects that embody works capable of being perceived with the aid of a machine, thereby ensuring that reproductions of copyrighted works contained on media such as floppy disks, hard drives, and magnetic tapes would meet the Copyright Act's "fixation" requirement.

That definition — intended to clarify that a work stored on a disk or tape can be a copy of the copyrighted work even if it cannot be perceived by human senses without technological aid — means that CD-ROM discs can infringe

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> manner, or medium of fixation may be — whether it is in words, numbers, notes, sounds, pictures, or any other graphic or symbolic indicia, whether embodied in a physical object in written, printed, photographic, sculptural, punched, magnetic, or any other stable form, and whether it is capable of perception directly or by means of any machine or device "now known or later developed."

H.R. Rep. No. 94-1476, at 52, *reprinted in* 1976 U.S.C.C.A.N. 5659, 5665 (footnote omitted).

a copyright even if the information embedded upon them is not perceptible without the aid of a CD-ROM player. In this case, however, the only fixed arrangement is the (non-West) sequence that is embedded on plaintiffs' CD-ROM discs and that appears with the aid of a machine without manipulation of the data.

To recapitulate a bit, West relies on the definition of "copies" to argue that plaintiffs' CD-ROM discs duplicate its copyrighted arrangement of cases because star pagination permits a user to "perceive" the copyrighted element "with the aid of" a computer and the FOLIO retrieval system, *i.e.*, by manipulating the data embedded on a CD-ROM disc to retrieve the cases in the order in which they appear in the West case reporters. West's definition of a copy, as applied to a CD-ROM disc, would expand the embedded work to include all arrangements and *re*arrangements that could be made by a third-party user who manipulates the data on his or her own initiative. But the relevant statutory wording refers to material objects in which "a work" readable by technology "is fixed," not to another work or works that can be created, unbidden, by using technology to alter the fixed embedding of the work, by rearrangement or otherwise. The natural reading of the statute is that the arrangement of the work is the one that can be perceived by a machine without an uninvited manipulation of the data.

West cites no case which supports its interpretation of § 101's definition of "copies,"[19] and every case we have

19. West relies on *Tasini v. New York Times Co.*, 972 F. Supp. 804 (S.D.N.Y. 1997) (Sotomayor, J.); but that case is completely

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found has relied upon the definition solely to ascertain whether a work has met the fixation requirement, not to determine the arrangements and rearrangements of the work fixed on the material object. *See, e.g., Stenograph L.L.C. v. Bossard Assocs., Inc.*, 144 F.3d 96, 100 (D.C. Cir. 1998) (citing § 101's definition of "copies" to "support the

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consistent with our interpretation of § 101's definition of "copies." At issue in *Tasini* was a collective work author's right to produce several electronic databases containing the collective work under § 201(c)'s "revision" right for collective works. The contributors to the collective works argued, *inter alia*, that § 201(c) did not contemplate that a computer database of the collective work could amount to a revision, arguing that because § 201(c) did not confer the right to display the copyrighted work publicly, the work could not be reproduced on a computer because "a work cannot be reproduced electronically unless it is 'displayed' on a computer screen." *Id.* at 816. However, the court rejected this argument, noting that the reproduction right, which *is* granted under § 201(c), and "which necessarily encompasses the right to create copies of that work, presupposes that such copies might be 'perceived' from a computer terminal." *Id.*

This statement merely affirmed that a reproduction of an original work may be found on a material object that allows the work to be perceived on a computer terminal. But it does not explain the arrangement of the "work" fixed on that copy and whether a particular copy is a reproduction of the original work. Nor did *Tasini* read § 101's definition of "copies" to mean that the data was arranged in any way that could be perceived by a third party with the aid of a sorting device. In fact, when the court did consider whether the work embedded on the CD-ROM was substantially similar to the original collective work, it did not refer to § 101's definition of "copies". *Id.* at 823-25.

proposition that the installation of software onto a computer results in 'copying' within the meaning of the Copyright Act"); *Stern Elecs., Inc. v. Kaufman*, 669 F.2d 852, 856 (2d Cir. 1982) (using § 101's definition of "copies" to determine whether an audiovisual work met the "fixation" requirement); *Sega Enters. Ltd. v. Accolade, Inc.*, 785 F. Supp. 1392, 1396 (N.D. Cal.) (using § 101 to determine whether an intermediate copy was actionable and noting substantial similarity between intermediate copy and allegedly infringed work as the test for determining whether intermediate copy was reproduction of copyrighted work), *aff'd in part and rev'd in part*, 977 F.2d 1510 (9th Cir. 1992).

2. Substantial Similarity

The question presented — whether an element of West's copyrighted work has been reproduced in a "copy" — is answered by comparing the original and the allegedly infringing works, and inquiring whether the copyrightable elements are substantially similar. Under the facts of this case, the arrangement of the "work" on plaintiffs' CD-ROM discs is the arrangement of cases that is displayed by a CD player reading the information in the order in which it is physically embedded or "fixed" in the discs and not all possible arrangements that can be perceived through the manipulation and rearrangement of the embedded data by a third party user with a machine.

The Supreme Court in *Feist* emphasized that copyright protection for a factual compilation is "thin," and that a compilation containing the same facts or non-copyrightable elements will not infringe unless it "*feature[s]* the same

selection and arrangement" as the original compilation. *Feist*, 499 U.S. at 349, 111 S. Ct. at 1289 (emphasis added); *see also Key Publications, Inc. v. Chinatown Today Publ'g Enters., Inc.*, 945 F.2d 509, 514 (2d Cir. 1991) (holding that to establish infringement, a compilation copyright holder must demonstrate "substantial similarity between those elements, and only those elements, that provide copyrightability to the allegedly infringed compilation"). To determine whether two works contain a substantially similar arrangement, courts compare the ordering of material in the two works, finding infringement only when both compilations have featured a very similar literal ordering or format. *See, e.g., Lipton v. Nature Co.*, 71 F.3d 464, 472 (2d Cir. 1995) (finding infringement of arrangement when of 25 terms contained in copyrighted work, 21 are listed in same order on allegedly infringing work); *Worth v. Selchow & Righter Co.*, 827 F.2d 569, 573 (9th Cir. 1987) (holding that alphabetical arrangement of factual entries in a trivia encyclopedia was not copied by a copyrighted game that organized the factual entries by subject matter and random arrangement on game cards); *see also* Jane C. Ginsburg, *No "Sweat"? Copyright and Other Protection of Works of Information After Feist v. Rural Telephone*, 92 Colum. L. Rev. 338, 349 (1992) (noting that under *Feist*, nothing "short of extensive verbatim copying" will amount to infringement of a compilation). "If the similarity concerns only noncopyrightable elements of [a copyright holder's] work, or no reasonable trier of fact could find the works substantially similar, summary judgment is appropriate." *Williams v. Crichton*, 84 F.3d 581, 587 (2d Cir. 1996) (internal quotation marks and citations omitted).

We agree with plaintiffs and *amicus* United States that West fails to demonstrate the requisite substantial similarity.[20] West's case reporters contain many fewer cases than plaintiffs' CD-ROM discs, and are arranged according to classification such as court, date, and genre (opinions, per curiam opinions, orders, etc.), subject to certain exceptions characterized by West as features of originality, whereas plaintiffs organize their cases simply by court and date. Comparison of the works reveals that cases that appear adjacent in the West case reporters are separated on plaintiffs' products by many other cases; and even if these other cases are disregarded, the West cases included on plaintiffs' products are not in an order at all resembling West's arrangement.[21]

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20. West does not claim that the appearance or layout of the cases on Bender's product reproduces the appearance or layout of West's case reporters. In fact, the layout is quite different; Bender displays its cases in one column with no page breaks, and with footnotes displayed at the end of the case or through a pop-up window that can be accessed by clicking the mouse-button on the footnote number.

21. As for Bender's product, there can be no substantial similarity in arrangement to the *Federal Reporter*, *Federal Supplement* and *Federal Rules Decisions*. Those reporters contain case reports from many non-New York courts (Second Circuit cases account for approximately 8.4% of the cases reported in the *Federal Reporter*, and New York federal courts contribute approximately 16.3% of the cases reported in the *Federal Supplement* and *Federal Rules Decisions*) while the Bender product contains only New York cases.

Even those cases that appear in both Bender's product and West's case reporters are organized differently. For example, a viewer

(Cont'd)

Appendix A

Star pagination (in addition to revealing the page location of the text of judicial opinions) may incidentally reveal to the reader how *the reader* could create a copy of West's arrangement by various computer key operations; but by the same token, if the CD-ROM discs were published on paper in the same order as the cases are embedded in the CD-ROM disc, a reader so minded could assemble a "copy" of the West arrangement by use of scissors. *Cf. Horgan v. MacMillan, Inc.*, 789 F.2d 157, 162 (2d Cir. 1986) (noting that "the standard for determining copyright infringement is not whether the original could be recreated from the allegedly infringing copy, but whether the latter is 'substantially similar' to the former").

True, CD-ROM technology is different from paper, for as West points out, the arrangement of judicial opinions in a CD-ROM disc does not correspond necessarily to how the information will be displayed or printed by the user, because

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(Cont'd)

who retrieves *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2d Cir. 1995), in Bender's product will find that the case preceding *Knitwaves* and the case following it are not published in the West case reporter, and that the Second Circuit case preceding it in the *Federal Reporter* volume, *Aetna Cas. & Sur. Co. v. United States*, 71 F.3d 475 (2d Cir. 1995), is not nearby in the Bender product. Or to give another example, a viewer who retrieves *Delchi Carrier SpA v. Rotorex Corp.*, 71 F.3d 1024 (2d Cir. 1995), on the Bender system will find *United States v. Muniz*, 71 F.3d 93 (2d Cir. 1995), a case that begins 931 pages earlier in the West reporter, following it.

Nor is the arrangement of Bender's New York state court opinions similar to West's. West organizes them initially by court while Bender organizes them strictly by date.

the file-retrieval system allows users to retrieve cases in a variety of ways. *See* Robert C. Denicola, *Copyright in Collections of Facts: A Theory for the Protection of Nonfiction Literary Works*, 81 Colum. L. Rev. 516, 531 (1981) ("[I]t is often senseless to seek in [electronic databases] a specific, fixed arrangement of data."). But having rejected West's argument under § 101, we can conclude that the arrangement of plaintiffs' work is the sequence of cases as embedded on the plaintiffs' CD-ROM discs and as displayed to the user browsing through plaintiffs' products. That sequence is not substantially similar to West's case reporters. There is no evidence that Bender and HyperLaw's case-retrieval systems allow a user to browse the cases in the West arrangement without first taking steps to create that arrangement. Thus, an actionable copy of West's sequence of cases, *i.e.*, a work with a substantially similar arrangement fixed in a tangible medium (probably a print-out of the cases), could be created by a user of the CD-ROM discs, but only by using the file-retrieval program as electronic scissors. We cannot find that plaintiffs' products directly infringe West's copyright by inserting star pagination to West's case reporters.

3. Contributory Infringement

Notwithstanding the absence of substantial similarity, a database manufacturer may be liable as a contributory infringer (in certain circumstances) for creating a product that assists a user to infringe a copyright directly. West has hypothesized that users of Bender and HyperLaw's products, using star pagination and the search functions of the CD-ROM products, will retrieve and print cases in the order in which they appear in West's case reporters. *See* Affidavit of

Michael A. Trittipo ¶ 5, Joint Appendix at 1287. A CD-ROM disc user who replicated the West compilation in that way would be an infringer. But West has failed to identify any primary infringer, other than Mr. Trittipo, West's counsel. *See Cable/Home Communication Corp. v. Networks Prods., Inc.*, 902 F.2d 829, 845 (11th Cir. 1990) ("Contributory infringement necessarily must follow a finding of direct or primary infringement."); 2 Paul Goldstein, *Copyright* § 6.0 (1996) ("For a defendant to be held contributorily or vicariously liable, a direct infringement must have occurred.").

Assuming there is a class of primary infringers, then a party "who, with knowledge of the infringing activity, induces, causes, or materially contributes to the infringing conduct of another, may be held liable as a 'contributory' infringer." *See Gershwin Publ'g Corp. v. Columbia Artists Management, Inc.*, 443 F.2d 1159, 1162 (2d Cir. 1971). Two types of activities that lead to contributory liability are: (i) personal conduct that encourages or assists the infringement; and (ii) provision of machinery or goods that facilitate the infringement. *See ITSI T.V. Prods., Inc. v. California Auth. of Racing Fairs*, 785 F. Supp. 854, 861 n.13 (E.D. Cal. 1992). West argues that Bender and HyperLaw's sale of their CD-ROM products falls within the second category.

However, as *amicus* United States notes, the provision of equipment does not amount to contributory infringement if the equipment is "capable of substantial noninfringing uses," including uses authorized under the fair use doctrine. *See Sony Corp. of Amer. v. Universal City Studios, Inc.*, 464 U.S. 417, 442, 104 S. Ct. 774, 788-89 (1984). In determining whether liability is foreclosed by substantial noninfringing

uses, the Supreme Court in *Sony* emphasized that the alleged contributory infringer did not influence or encourage unlawful copying with the equipment it provided. *Id.* at 438, 104 S. Ct. at 787; *see also Cable/Home Communication Corp.*, 902 F.2d at 846.

The arrangement of cases in the West case reporters, however meticulous and thoughtful, is of small assistance to the primary use of these products — searching for cases, and retrieval. After all, the useful order of access is almost always determined by the research goal of each user rather than the publisher's sequencing (a compilation of law cases being not much like a musical medley or a sonnet sequence). And the primary use of West's pagination in plaintiffs' products is to allow the user to refer to the location of a particular text within the West case reporters as has become standard practice in the legal community. West concedes that use of its volume and page numbers for pinpoint citation purposes is at least a fair use (if it even amounts to actionable copying). There is no evidence that plaintiffs have encouraged the users of their products to reproduce West's arrangement. In fact, the CD-ROM products provide no easy means for using the star pagination to create a substantially similar arrangement; a user must retrieve each case, one at a time, in the order in which they appear in the West volume, and then print each one. What customer would want to perform this thankless toil? We conclude that plaintiffs' products have substantial, if not overwhelming, noninfringing uses, and that the plaintiffs are not liable as contributory infringers.[22]

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22. In addition to the reasons discussed above, plaintiffs cannot be subject to liability for vicarious infringement because they cannot (Cont'd)

West distinguishes *Sony* on the ground that that case involved a neutral "staple article of commerce" (a video tape recorder) which "is sold without reference, connection, or linkage to any copyrighted work," while plaintiffs' CD-ROM discs "contain . . . exact copies of West's proprietary arrangements permanently embedded within its database." This argument bespeaks direct infringement (a claim we have already rejected for other reasons) rather than contributory infringement. In any event, we think the "substantial noninfringing use" test is as applicable here as it was in *Sony*. The Supreme Court applied that test to prevent copyright holders from leveraging the copyrights in their original work to control distribution of (and obtain royalties from) products that might be used incidentally for infringement, but that had substantial noninfringing uses. *See Sony*, 464 U.S. at 440-42, 104 S. Ct. at 788-89; *see also* 2 Goldstein, *supra* § 6.1.2 ("To hold that the distribution of such materials or equipment constitutes contributory infringement, and thus to bring them within the scope of the copyright owner's control, may enable the copyright owner to influence the price and availability of goods that are not directly connected to its copyrighted work."). The same rationale applies here: West has a thin copyright in its compilations, which it seeks to leverage to protect its pagination (an element of its compilation that is unprotected altogether) and thereby to foreclose (or draw royalties from) CD-ROM products that might be used incidentally to replicate West's arrangement of cases, but that

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(Cont'd)
control the conduct of the direct infringer. *See Shapiro, Bernstein & Co. v. H.L. Green Co.*, 316 F.2d 304, 307 (2d Cir. 1963) (holding that vicarious infringement requires that defendant possess the right and ability to supervise the infringing conduct).

have substantial, predominant and noninfringing uses as tools for research and citation.[23]

C

We differ with the Eighth Circuit's opinion in *West Publishing Co. v. Mead Data Central, Inc.*, 799 F.2d 1219 (8th Cir. 1986). In that case, LEXIS (an on-line database provider) announced plans to star paginate its on-line version of cases to West case reporters. West claimed that the star pagination would allow users to page through cases as if they were reading West volumes, and in that way copied West's arrangement of cases. *Id.* at 1222. The court held that "West's arrangement is a copyrightable aspect of its compilation of cases, that the pagination of West's volumes reflects and expresses West's arrangement, and that MDC's intended use of West's page numbers infringes West's copyright in the arrangement." *Id.* at 1223. Even if it was not "possible to use LEXIS to page through cases as they are arranged in West volumes," the court said that insertion of comprehensive star pagination amounted to infringement:

> Jump cites to West volumes within a case on LEXIS are infringing because they enable LEXIS

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23. Even if the "substantial noninfringing use" test does not apply beyond the context of staple articles of commerce, it is hard to say that plaintiffs, with knowledge of the infringing activity, "materially contribute[d]" to the direct infringement of West's copyright, *see Gershwin Publ'g Corp.*, 443 F.2d at 1162, because no showing of knowledge has been made, the infringement itself (if done) would have been pointless, and the predominant uses of plaintiffs' products are noninfringing.

> users to discern the precise location in West's arrangement of the portion of the opinion being viewed. . . .
>
> With [LEXIS's] star pagination, consumers would no longer need to purchase West's reporters to get every aspect of West's arrangement. Since knowledge of the location of opinions and parts of opinions within West's arrangement is a large part of the reason one would purchase West's volumes, the LEXIS star pagination feature would adversely affect West's market position. "[A] use that supplants any part of the normal market for a copyrighted work would ordinarily be considered an infringement." S. Rep. No. 473, 94th Cong., 1st Sess. 65 (1975) . . . .

Id. at 1227-28; *see also Oasis Publ'g Co. v. West Publ'g Co.*, 924 F. Supp. 918, 922-25 (D. Minn. 1996) (holding that (i) *West Publishing Co.* had not been overruled by *Feist*'s disavowal of the "sweat of the brow" doctrine, and (ii) that even if it had, "the internal pagination of [West's reporter] is part of West's overall arrangement, and similarly protected").

The Eighth Circuit in *West Publishing Co.* adduces no authority for protecting pagination as a "reflection" of arrangement, and does not explain how the insertion of star pagination creates a "copy" featuring an arrangement of cases substantially similar to West's — rather than a dissimilar arrangement that simply references the location of text in West's case reporters and incidentally simplifies the task of someone who wants to reproduce West's arrangement of

cases. It is true that star pagination enables users to locate (as closely as is useful) a piece of text within the West volume. But this location does not result in any proximate way from West's original arrangement of cases (or any other exercise of original creation) and may be lawfully copied. So any damage to the marketability of West's reporters resulting from such copying is not cognizable under the Copyright Act. It is interesting that the Eighth Circuit's quotation from the Senate Report on supplanting use is drawn from the Report's discussion of the fair use doctrine, which applies only when the copyright holder has first demonstrated infringement of a protectable element of its work.

At bottom, *West Publishing Co.* rests upon the now defunct "sweat of the brow" doctrine. That court found that LEXIS had infringed West's copyright simply because it supplanted much of the need for West's case reporters through wholesale appropriation of West's page numbers. In reaching this conclusion, the court (i) noted that LEXIS's appropriation would deprive West of a large part of what it "[had] spent so much labor and industry in compiling," *West Publ'g Co.*, 799 F.2d at 1227, and (ii) cited *Hutchinson Telephone v. Fronteer Directory Co.*, 770 F.2d 128 (8th Cir. 1985), *see West Publ'g Co.*, 799 F.2d at 1228, which in turn relied on *Leon v. Pacific Telephone & Telegraph Co.*, 91 F.2d 484 (9th Cir. 1937), and *Jeweler's Circular Publishing Co v. Keystone Publishing Co.*, 281 F. 83 (2d Cir. 1922) — classic "sweat of the brow" cases that were overruled in *Feist*. Thus, the Eighth Circuit in *West Publishing Co.* erroneously protected West's industrious collection rather than its original creation. Because *Feist* undermines the reasoning of *West Publishing Co.*, *see United States v. Thomson Corp.*, 949 F. Supp. 907, 926 (D.D.C. 1996), we decline to follow it.

Appendix A

CONCLUSION

We hold that Bender and HyperLaw will not infringe West's copyright by inserting star pagination to West's case reporters in their CD-ROM disc version of judicial opinions. The judgment of the district court is affirmed.

Appendix A

Matthew Bender & Co. and Hyperlaw, Inc. v. West Publishing Co.

97-7430

Sweet, D.J.

I respectfully dissent.

This appeal from the grant of summary judgment in favor of the appellee Bender presents challenging issues, the extent of copyright protection for compilations under the §501(a) and §106(1) and (3) of Title 17, U.S.C., what constitutes copying in the electronic age, and the propriety of summary judgment in determining issues of fair use. Because the majority reaches conclusions on the first two issues, with which I disagree, and consequently failed to address the third issue, I feel required to dissent, emboldened by the holdings of the three other courts which have considered the issue, *West Pub. Co. v. Mead Data Central, Inc.*, 616 F.Supp.1571 (D.Minn. 1985), *aff'd*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987); *Oasis Pub. Co. v. West Pub. Co.*, 924 F.Supp. 918 (D.Minn. 1996), and reached conclusions contrary to those stated by the majority. By concluding that page numbers in the context of the West citation system are facts rather than an expression of originality the majority permits the appellee Bender and the intervenor Hyperlaw to appropriate the practical and commercial value of the West compilation.

The West page numbers which are inserted by appellee Bender in the text of each of its CD-ROM disks[1] by star

1. Bender's CD-ROMs obtain the text of the opinions they report from Lexis, opinions which are, of course, in the public domain).

pagination result from the totality of the West compilation process which includes its concededly original and copyrightable work, *i.e.* attorney description, headnotes, method of citation and emending of parallel or alternate citations. These result in a compilation work with page numbers assigned mechanically. The West page numbers and the corresponding Bender and Hyperlaw star pagination are the keys which open the door to the entire West citation system which as the majority noted is an accepted, and in some instances, a required element for the citation of authorities.

The majority initially assumes the copyrightability of the West work but cites the statement in *Feist Publications, Inc., v. Rural Telephone Service Company, Inc.*, 499 U.S. 340 (1991), that "a factual compilation is eligible for copyright if it features an original selection or arrangement of the facts, but the copyright is limited to the particular selection or arrangement. In no event may copyright extend to the facts themselves." 499 U.S. 340 at 350-51, and its conclusion that the compiler's copyright is "thin" permitting a subsequent compilier to use facts "so long as the competing work does not feature the same selection and arrangement." *Id.* By characterizing star pagination as a fact, rather than as an essential part of the selection or arrangement the majority deprives the West pagination of its originality and consequent copyright protection.

The majority concludes that because the volume and page numbers are "unprotected features" of West's compilation process, they may be copied without infringing West's copyright. The majority reasons that, pursuant to the Copyright Act, the "embedding of the copyrightable work in a tangible medium does not mean that the features of the

tangible medium are also copyrightable." Therefore, West's arrangement of cases is protectible, but the page numbers are not. The classification of page numbers as physical embodiment rather than the result of originality is the foundation stone of the majority's interpretation of the authorities dealing with the copyright statute.

In my view West's case arrangements, an essential part of which is page citations, are original works of authorship entitled to copyright protection. Comprehensive documentation of West's selection and arrangement of judicial opinions infringes the copyright in that work.

This reasoning is consistent with *Feist*. As discussed above, the majority notes that the compiler's copyright is "thin." *Feist*, 499 U.S. 340 at 350-51. Therefore, "a subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, *so long as the competing work does not feature the same selection and arrangement*." *Id.*, at 349 (emphasis added). In this case, allowing plaintiffs to use the page numbers contained in West's publication enables them to feature West's same selection and arrangement.[2] Indeed, were it not

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2. It is immaterial that plaintiffs' products may display other arrangements as well as West's. The capability of a CD-ROM to display more than one arrangement does not make the encoding of an original selection and arrangement such as West's any less of an infringement.

It is also irrelevant that plaintiffs' products may contain material beyond West's selection and arrangement. Infringement is determined by how much of the copyright owner's work was taken, not by what else the copier's work contains. *See e.g., Warner Bros., Inc. v. American Broadcasting Cos., Inc.*, 720 F.2d 231, 241 (2d Cir. 1983).

for the ability to reproduce West's arrangement, its pagination would be of limited (if any) use.

According to *Feist*, "[t]he originality requirement articulated in the The Trade-Mark Cases and Burrow-Giles remains the touchstone of copyright protection today . . . . It is this bedrock principle of copyright that mandates the law's seemingly disparate treatment of facts and factual compilations." 499 U.S. 340 at 347 (citations omitted).

Here the pagination results from West's arrangements, selections, syllabi, headnotes, key numbering, citations and descriptions. The page number, arbitrarily determined, is the sole result of the West system, appears nowhere else, and is essential to its coordinated method of citation. It is, so to speak, an original fact resulting from West's creativity.

Having determined that the West page numbers are not original, but factual, the majority then deals with West's contention that by use of the CD-ROM technology plaintiffs have violated §101's prohibition against copying its selection and arrangement and defeats this contention by noting that West has conceded fair use of parallel citation as to the first page of a report. It rejects Chief Judge Magnuson's view: "Having gotten the inch under the conceded fair use of parallel citation to the first page of each case," plaintiffs are not "thereby entitled to take the entire mile in star citation to every page . . ." *Oasis Publishing Company, Inc. v. West Publishing Company, Inc.*, 924 F. supp. 918, 926 (D. Minn. 1996).

The comprehensive copying of first-page parallel citations alone, even in a competing work, is arguably fair

use because citations do not substantially supplant the need for the West volumes. Conversely, complete electronic cross-pagination fulfills the same market demand as West's volumes. As the *Oasis* Court explained, "Although with either the parallel cites or an internal cite from each case a user could sort West's cases and determine West's arrangement, the former does not utterly supplant the need for West's product while the latter does." *Id.* The view of the *Oasis* court correctly assesses the reality in my view.

According to the majority, a more fundamental reason to reject West's argument that plaintiffs have copied its arrangement is that the arrangement can be perceived only after a person uses the machine to rearrange the material.

Some of the most seminal developments in copyright law have been driven by technological change. There was a time when people questioned whether photographs, *see Burrow-Giles Lithographic co. v. Sarony*, 111 U.S. 53 (1994), or advertisements, *see Bleistein v. Donaldson Lithographic Co.*, 188 U.S. 293 (1903), were copyrightable. Here again it is necessary to reconcile technology with pre-electronic principles of law. Clearly, plaintiffs' CD-ROM disks are not "copies" in the traditional sense. Yet, plaintiffs provide the ability for a user to push a button or two and obtain West's exact selection and arrangement. This technological capacity presents a new question. The majority's answer threatens to eviscerate copyright protection for compilations.

West's position is that plaintiffs directly infringe. "[T]he owner of a copyright . . . has the exclusive rights to . . . reproduce the copyrighted work in copies." 17 U.S.C. §106.

The reproduction must be in a "material object . . . in which a work is fixed . . . from which the work can be perceived . . . either directly or with the aid of a machine or device." 17 U.S.C. §101 (definition of "Copies"). Closely read, the word "work" in the statutory text refers in the first instance to the infringing work, and in the second instance to the infringed work. Accordingly, plaintiffs' CD-ROMs infringe West's reproduction right if the information is "fixed" in the CD-ROM (which it is) and if West's protected selection and arrangement "can be perceived . . . with the aid of a machine."

Broadly read, plaintiffs' inclusion in their work of West's precise page break information permits the Reporters to be "perceived" by the aid of a computer. Plaintiffs' inclusion of the selection and arrangement software feature make the perception easy. Even if the focus is placed upon the intervening deliberate act by the Bender or Hyperlaw CD-ROM user, liability might attach for contributory infringement, which requires (1) actual knowledge of direct infringement, (2) the ability to police the infringing conduct and (3) derivation of substantial benefit from the actions of the primary infringers. *See Gershwin Publishing Corp. v. Columbia Artists Management, Inc.*, 443 F.2d 1159, 1163 (2d Cir. 1971).

Finally, the majority dismisses *West Publishing Co.* on which I rely for lack of authority. By its *ipse dixit*, that location by star pagination does not result from the concededly original West arrangement of cases, the majority rejects the result obtained by the Eighth Circuit and attributes it to the pre- *Feist*, "now defunct 'sweat of the brow' doctrine," an attribution not warranted by the reliance of the

Eighth Circuit upon West's originality. The question of whether or not *Feist* overruled *West* was argued and carefully considered by the *Oasis* court. Creativity was the issue, and I subscribe to Chief Judge Magnuson's view of the interrelationship between *West* and *Feist*.

While the Eighth Circuit did take note of the considerable "labor" exercised by West, it did so in conjunction with a consideration of West's "talent and judgment" in organizing its compilations. *See West Publishing Co.*, 799 F.2d at 1226 (concluding that West's arrangement is the result of "considerable labor, talent and judgment").

The Eighth Circuit applied essentially the same creativity standard articulated and applied in *Feist*. Instead of a mere "sweat of the brow" analysis of West's selection and arrangement of cases in the National Reporter System, the Court considered the "originality and intellectual creation" requirements of the arrangement. *West Publishing Co.*, 799 F.2d at 1225-26.

In *West Publishing Co.*, the Eighth Circuit's persuasively reasoned that (i) comprehensive pagination, when linked to the text of a compilation, is copyrightable in terms of originality because it expresses the compiler's expression and arrangement, and (ii) a compilation's selection and arrangement is copied when comprehensive cross-pagination is inserted into an electronic database containing the compilation's text. 799 F.2d at 1227-28.

Because of the views set forth above, I believe the District Court erred in not granting copyright protection to West. In

addition, the District Court granted summary judgment for plaintiffs on their contention that their acts were permitted as "fair use." The resolution of this issue, factually contested, required a trial and the reversal of the grant of summary judgment. *See, e.g., Ringgold v. Black Entertainment Television, Inc.*, 126 F.3d 70 (2d Cir. 1997); *see also Wright v. Warner Books, Inc.*, 953 F.2d 731, 735 (2d Cir. 1991) (stating that while the copyright holder is not protected from summary disposition of claims where there are no material factual disputes, the "the fact driven nature of the fair use determination suggests that a district court should be cautious in granting Rule 56 motions in this area").

For these reasons I believe the grant of summary judgment granting the declaratory judgment requested by Bender was error, and I therefore dissent from the majority's affirmance of that judgment.

APPENDIX B — AMENDED ORDER OF THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK DATED DECEMBER 4, 1996

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

94 Civ. 0589 (JSM)

MATTHEW BENDER & COMPANY, Inc.,

Plaintiff,

and

HYPERLAW, Inc.,

Intervenor-Plaintiff,

–v.–

WEST PUBLISHING COMPANY,

Defendant.

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95 Civ. 4496 (JSM)

MATTHEW BENDER & COMPANY, Inc.,

Plaintiff,

–v.–

WEST PUBLISHING COMPANY,

Defendant.

Appendix B

AMENDED ORDER

JOHN S. MARTIN, Jr., District Judge:

In these related copyright actions, the parties' motions for summary judgment were argued before the Court on November 22, 1996. For the reasons stated at oral argument, plaintiff Matthew Bender's motion for summary judgment is granted and defendant West's cross motion is denied.

The Court also heard argument on Hyperlaw's motion and West's cross motion for summary judgment. Hyperlaw's motion for summary judgment is granted only with regard to the pagination issues that parallel Matthew Bender's motion for summary judgment. For the reasons stated at oral argument, West's motion for summary judgment is denied. Hyperlaw and West must submit a pre-trial order to this Court by January 17, 1997. The trial on the remaining issues will begin January 27, 1997 at 9:30 a.m. in Courtroom 15-C.

SO ORDERED.

Dated: New York, New York
December 4, 1996

s/ John S. Martin, Jr.
JOHN S. MARTIN, JR., U.S.D.J.

* * * *

APPENDIX C — TRANSCRIPT OF PROCEEDINGS OF THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK DATED NOVEMBER 22, 1996

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

94 Civ. 0589(JSM)

MATTHEW BENDER & CO.,

Plaintiff,

v.

WEST PUBLISHING, INC.

Defendant.

HYPERLAW, INC.,

Intervenor-Plaintiff,

v.

WEST PUBLISHING, INC.,

Defendant.

November 22, 1996
2:35 p.m.
New York, N.Y.

Appendix C

Before:

HON. JOHN S. MARTIN, JR.,

District Judge

* * *

[2] (In open court)

THE COURT: Let me start by saying I have reviewed the papers, and when I tell my law clerk to set an hour down for an argument I don't really expect to have to respond to three different calls from lawyers telling them I really did mean what I said. My law clerks have other things to do than to respond to phone calls and I really don't appreciate that type of conduct.

Now, let's talk about the issues. It seems to me that for the sake of this argument, we can take it assumed that when West puts together a volume of the Federal Reporter there is a compilation that is entitled to copyright protection. However, I think that is not what's at issue in this case.

The issue is, as I see it in this case, starts, to quote from Judge Leval's opinion in CC Information Services, "The facts set forth in the compilation are not protected and may be freely copied. The protection extends [3] only to those aspects of the compilation that embody the original creation of compiler."

Now,let's talk first about the Matthew Bender case. There is no question that if Matthew Bender took a volume of F.3d,

ran it through its xerox machine or its computer and printed it out and called it Bender's Federal Third Reporter, that that would violate West's copyright.

But it seems to me to start with the proposition that the title and the citation to a West reported decision are facts, facts that anybody is free to use. It is a fact that the opinion of Judge Leval is reported at 44 F.3rd, 61. That is not as a result of the creative activity that West engaged in to put that page at, they didn't decide that the best place for the Leval opinion is at 44 F.2d page 61. They decided that a group of cases should be compiled together in a certain order, and a consequence of that compilation was that the case with that title appeared at that page. That's a fact.

It is a fact that the words in Judge Leval's opinion beginning "compilations that devise new and useful selections" and ending with the words "McLean, Hunt" appear on page 66 of 44 F.2d. That's a fact.

Again, that is a consequence of the way the compilation is put together, but it is not any part of the aspect of the compilation that embody the original creation [4] of the compiler.

Why don't I have West's counsel address themselves to that part of the question.

MR. MUSILEK: Your Honor, I am Joe Musilek and I will be speaking on behalf of West this afternoon.

Addressing just those first two questions, your Honor, there is a difference in the law between pre-existing facts

which exist independent of the work and facts which result as a result of the creation of the work. And to make the most easiest example I can think of, everyone has an address, a name and a telephone number regardless of whether or not those are ever compiled into a telephone directory. However, a slip opinion from Judge Leval does not have a volume number, West Reporter publication name and page number independent of the compilation and creation of an arrangement by West in Federal Supplement or Federal Reporter.

Your Honor, a novel which is clearly completely comprised of the original writings of the author is clearly copyrightable and yet it is also true that I could say it is a fact that this novel says this.

THE COURT: But every word in the novel is the author's original creation. That's not case you have here.

MR. MUSILEK: Your Honor, after the novel is created it is in fact the case. Those facts did not exist [5] prior to their being written down and put into a novel but after that they are fact. And if I start off by saying it is a fact that this novel says, and then reproduce the novel, I cannot rely on, as my defense, that I have only stated a fact, your Honor. You have taken the say essence of the protectable expression.

Here —

THE COURT: The essence of the protectable expression here, the essence of the protectable compilation has nothing to do with the accident as to the page upon which a particular portion of text falls.

MR. MUSILEK: Your Honor, the arrangement has everything to do with where case reports are found in volumes and how they are displayed and how they are reported by West.

It is a group of slip opinions that come into West that are arranged in a volume. If not for the citation, if not for the very material that's copied by Matthew Bender, there would be no arrangement.

I think I would cite to you, your Honor, back to the CC case, which is very good on this point in stating that very clearly, obviously you have to have facts and you can't copyright them; but to the extent a compilation, the protectable expression in a compilation is an arrangement, anything that copies that arrangement is indeed copying the [6] protectable expression. That really in a nutshell is the sum and substance of West's position on star pagination, your. And you cannot rely on the defense that these are facts because they are not the kind of pre-existing facts dealt with by the Supreme Court in Feist. They are not the kind of pre-existing facts, namely what a used car is sold for at auction in the CCC case.

THE COURT: In CCC, Judge Leval I'm not sure would have found what the used car price was alone. It was because that was combined with certain judgments by the author as to those valuations that he found them protected.

MR. MUSILEK: I think that's correct. But what the judge in CC also found, what the court found in that decision was that an arrangement, in other words the ordering by even

something as simple as the geographic region from which the car sales were compiled, was sufficient.

THE COURT: Are you telling me every time I write an opinion in which I give the citation to a West opinion, I violate West's copyright because I put down the name of the case and the citation?

MR. MUSILEK: Absolutely not, your Honor, because you are citing to a West Reporter. You are referring the reader to a West Reporter.

And in the singular sense what we are talking [7] about here —

THE COURT: What does that have to do with whether or not that citation is protectable?

MR. MUSILEK: Because, your Honor, the issue here isn't a compilation copyright. It is not any one piece of it that is claimed to be copyrightable. It is a protectable expression of the entire work as a whole.

The works we are talking about here are advance sheets and bound volumes of a reporter, not an individual citation. So no issue even arises when you simply cite someone to a citation in a West book. This is only an issue in this case in star pagination because you are talking about providing someone else with a copy of the entirety of the West arrangement.

So it goes far beyond. And I think it is truly a red herring for Matthew Bender or Hyperlaw to try to make reference of

the need of the bar to access to the law, the need of judges and lawyers to cite to West cases. That is not the issue here. All that is in issue here is whether a commercial, for-profit competitor of West may copy West's arrangements in their entirety.

THE COURT: They are not copying your arrangements in their entirety. All they are doing is making reference in copies that they make. Matthew Bender doesn't copy any of the text that's in West. All it is [8] doing is making reference to a specific cites within a West Reporter.

MR. MUSILEK: Your Honor, that is not what they are doing. What they are attempting to do is supplant the market for West's books by providing a copy —

THE COURT: That's absolutely true. But they are not —

Look, I think the best case for you would be if they took the Federal Rules decision and put out a CD ROM called Bender's Federal Rules Decision in which they simply took all of the cases that you have on Federal Rules decisions and used those. That would be using your compilation because they would take the skill that and creativity you used in selecting those cases for publication and using them to their own benefit.

But that's not the case here. They have put on the CD ROM cases that are some reported by West, others that are not.

MR. MUSILEK: Your Honor, that's a very important point and I'm glad you raised it because that's is another red

herring in the law of copyright infringement. Judge Preska, your fellow judge on this bench, in the Robinson case in 1995 addressed that issue. And the point of law which is not in controversy is that it does not matter how much additional other material is in the infringing work. [9] All that matters is how much of the original work did they copy.

You can not get outside of a copyright infringement by copying the West arrangement and then throwing in a bunch of nondispositive orders and scheduling orders and whatever and say: Oh, we have a lot of things West doesn't have.

The point is, your Honor, and I think it is most evidenced most clearly by the Tritippo affidavit submitted in conjunction with this motion, by taking the Matthew Bender product you can recreate an entire volume of case reports from New York Supplement, with every page break, every page number, every volume designation, every publication title name as if you had the West book.

The statutory definition of "copies" in the Copyright Act makes it clear that's an infringement. Nemmer On Copyright, a treatise written by one of the counsel for Matthew Bender says in unequivocable terms that such copying constitutes an infringement when it is input into the computer, and nothing you do thereafter, whether it to be to strip out additional material or add in other noninfringing material can remove the infringement that occurs at that point.

The Tritippo affidavit shows that using the Matthew Bender product you can print out volumes of West [10] Reporters, you can printout individual pages of West

Reporters. That can only be because they have copied West's arrangement. Without copying West's arrangement, that could not be done.

THE COURT: Sure it could because the computer could sort anything but criteria.

MR. MUSILEK: Your Honor, I can go out and knock on doors and come up with names and addresses and telephone numbers for everyone on the block. I defy Matthew Bender's counsel to stand up and tell you that they can go out without reference to a West book and find those facts outside of a West book and star page to West Reporters. It cannot be done. That is the critical difference between the facts that are addressed in Feist and the protectable expression that is at issue when you talk about star pagination.

THE COURT: Let me hear from counsel to Matthew Bender.

MR. CHU: Good afternoon, your Honor. Morgan Chu and Elliot Brown from Irell & Manella for Matthew Bender. The principal argument being made by West is that there is protectable copyrightable expression in a series of Arabic numerals that are in order, 1, 2, 3, 4, and are inserted by a computer. It is an astounding position and we have nothing to add to our briefs.

[11] THE COURT: All right. Let's talk then about the Hyperlaw. Let me ask counsel for West the following question.

Appendix C

Assume Justice O'Connor said to her law clerk: I'm giving a lecture over Georgetown Law School tonight and I want the students to have a copy of my opinion in Feist v. Rule Telephone. Go to the Supreme Court Reporter, just copy the caption and then that portion of the report that begins "O'Connor, J. delivered the opinion of the court.

That is done.

Has Justice O'Connor violated your copyright?

MR. MUSILEK: Justice O'Connor clearly has not for two reasons.

One, under the standard of de minimus copying, which we cite in our briefs and as the Warner v. ABC case in the Second Circuit which stands for that proposition, de minimus copying even of copyrighted material is not an infringement, does not rise to the level of an infringement.

Two, it would certainly be a fair use for a judge or justice of a court to photocopy and use in connection with official duties or in connection with teaching, which is of course one of the expressly enumerated exceptions stated in the Fair Use statute; but in either event, it is either de minimus copying or —

THE COURT: So the entire text of the opinion?

[12] MR. MUSILEK: Either de minimus copying or it is a fair use.

Now, your Honor, just so can make clear the hypothetical here, if in fact there is nothing in that case report as published by West that did not issue from the court, then there is with respect to taking one case report, taking one case, there is nothing copyrightable to be taken. West has never claimed, and this case is not at all about, any claim by West to any portion of the text of a judicial decision issued by a court. Whether it be a correction issued by a court or the original language of the original opinion issued by the court. That is not the issue.

If you look carefully at a Supreme Court Reporter, that is the West publication case reports you will see, however, it is editorially enhanced text. There will be headnote reference numbers, there will be parallel and alternative citations which are creatively selected and compiled and arranged by attorney editors at West from among a myriad variety. Especially with Supreme Court decisions, they are reported and cited in hundreds of places.

You will find that West editors have chosen with parallel citation or replacement citations to include in that case report. If you take and start adding those things in and you start talking about a commercial competitor of West copying all of the text —

[13] THE COURT: Are the parallel citations any substantially different than the street address of a subscriber to a phone?

MR. MUSILEK: Actually not, your Honor. It is not the parallel citation text that is copyrightable. It is the selection

and arrangement and coordination of the parallel citation in the case report. And I always want to bring the court back to that distinction because it is so important in this case.

There is protection both for original creative texts and there is protection for any selection, coordination or arrangement of pre-existing material. With respect to parallel citations, we are talking about the collection, selection, coordination and arrangement of pre-existing facts, i.e., the citation as that case appears.

However, your Honor, that's very different when you talk about copying one case report or making reference to one parallel citation from a commercial competitor taking the West books and scanning them wholesale, which is what Hyperlaw in testimony, in deposition in this case has said it intends to do if you authorize it.

THE COURT: If they can do it to one case why can't they do it to them all?

MR. MUSILEK: Because that is when you start talking about the issue that goes beyond de minimus copying [14] and you get into the work as a whole. And I think if I understood, your initial presumption was that the West works as a whole are copyrightable compilations.

THE COURT: That's correct.

MR. MUSILEK: So you have a continuum.

THE COURT: To the extent that they made selections of what order in which they are going to put the opinions.

But it is not in the context of what is in each individual opinion, and that's where I go back to what I started with from Judge Leval. The protection extends only to those aspects of the compilation that embody the original creation of the compiler.

MR. MUSILEK: Your Honor, I would cite you to Judge Leval's Law Review article which is cited in our brief where he makes the very important point that there can be justifications for a taking a little bit of a work which cannot be used to justify taking more of the work. And the issue with commercial competitors such as Matthew Bender and Hyperlaw is that they are taking entire arrangements and entire compilations.

So when you are talking about, for instance, parallel citation and alternative citations selected and compiled by West, if they take them out of one case report it is no big dial, it is de minimus fair use, however you want to characterize it. But when they take volume after [15] volume and use the need to obtain corrections, for instance, as the excuse for scanning entire case reports, your Honor, you are on a continuum now where you get into a very hazy fact situation as to what they are taking, how much they are taking and what effect it is going to have on West, which are all directly relevant fact issues as to whether or not there has been a copyright infringement.

It cannot be dealt with in this manner on summary judgment, your Honor. It simply cannot. At the one end of the continuum where you are talking about scanning whole case reports it can be, and the court can find, as other courts have all found, that that's an infringement.

Appendix C

At the far end of the —

THE COURT: What other courts have found that?

MR. MUSILEK: We cite a number of them, your Honor, in our briefs, but there is a Walt Disney animation case.

THE COURT: Nothing to do with case reports?

MR. MUSILEK: No, your Honor, I do not believe there is a scanning decision on case reports other than a consent judgment in Atlanta where Judge Shoop found based on the consent of the defendant after it had been found out that scanning was in fact an infringement. But that was not a contested proceeding.

But the principle applies, your Honor. [16] Intermediate copying and scanning is infringement.

THE COURT: If you had a copyrightable product to begin with, but I have real question that you have a copyright in my opinions if you publish in your volume and that you can stop anybody from copying my opinion.

MR. MUSILEK: We have never tried to stop anybody from copying your opinions. They can get them from the court, from Lexis, from the Internet. They can't scan them out of a West book.

THE COURT: That's why I have a problem.

MR. MUSILEK: Your Honor, that's the essence of the CC case. The CCC case says you can go and make the same

compilations, you can get the same data as to used-car values and create your own publication, but you can't copy the McLean Reports and say that they are just facts and I can do it myself.

THE COURT: That's true. But it would be true if you added something to my opinion.

Now, you may clean up my citations, but I don't think you've added anything substantial to my opinion that gives you a copyright interest in my opinion that would prevent somebody from scanning it out of your text.

MR. MUSILEK: Your Honor, I don't disagree as long as we are talking about a single case report. But again, the work is a copyrightable work as a whole.

[17] THE COURT: But that's opinion and you don't have any more right to Judge Wood's opinion or Judge McKenna's opinion or Judge Sand's opinion when you put them all together.

MR. MUSILEK: Your Honor, that's not true because at that point we have compiled them and we have a protective interest in the compilation.

THE COURT: But that doesn't give you any protectable interest in the text of any one of those opinions.

MR. MUSILEK: It does with respect to things like headnote reference numbers, parallel citations, synopsis, headnotes, all of the various material which clearly is original to West.

If you take a little of it, that's one issue, perhaps de minimus. If you start taking all of it out of the entire volumes you are doing massive, substantial copying of designated portions of original material.

THE COURT: You are taking advantage of the sweat of West's brow.

MR. MUSILEK: Absolutely not. Not in the least. It is a matter of copying protectable expression and that is the whole arrangement of copyrights. Of course it takes sweat, it takes labor to compile something and arrange it, but it takes intellectual labor.

[18] What the court protects is the intellectual labor, not the physical labor. It is not the labor of clerical people who put the parallel citation by keying it into the computer after the attorney-editor has chosen which one to use. It is the selection of which one to use and where to put it that involves intellectual effort. That is something that cannot be found. I defy —

THE COURT: That is what the framers meant in Article 1, Section 8: The progress of science in the useful arts, deciding which parallel citation to use.

MR. MUSILEK: Absolutely, your Honor.

THE COURT: I knew we fought the Revolution for some reason and now I know.

MR. MUSILEK: Your Honor, when this case started three years ago Matthew Bender came into this court and

said: this is a simple case, the Feist case by the Supreme Court has come down and you know what, you can't copyright facts and you can't have a copyrightable arrangement unless it is creative, the West arrangement is not creative and so we can copy it.

two years later there are a series of very favorable Second Circuit decisions, favorable to West, and they are in here turning 180 degrees around and saying forget all that we said about the copyrightability of the compilation, what we're really here to say is that we are [19] not copying it.

Your Honor, that is a lie and it is not true. You cannot look at the Tritippo affidavit where they create West volumes and say we haven't copied the arrangement. That is what they copied.

If they haven't copied that, what have they copied? If you say it is facts, I say, explain how, your Honor, if they can go door to door, go somewhere else and find those facts outside of a West book if they are truly pre-existing facts. They are not pre-existing facts.

Where an alternative or parallel citation is going to go and which one is going to be chosen cannot be ascertained.

You cannot look at Justice O'Connor's slip opinion from the Supreme Court and say which parallel citation, which alternative citations are going to be used, where headnote reference numbers are going to be put, what headnotes are going to be drafted by West, what syllabus will be drafted but West. It doesn't exist absent West's intellectual labor in creating all of them and that is copied by Hyperlaw.

MR. HARTMANN: Your Honor, Carl Hartmann for Hyperlaw.

As is frequently the case with West, we are mixing lots of apples and lots of oranges. Let's go back [20] for a second to the question you asked specifically about the Hyperlaw argument, which is text.

West adds nothing to the Supreme Court text. Period. End of discussion.

Now, it may correct a spelling mistake, although it didn't in the examples it gave. And it may take out parallel citation that the court puts in, or add some, but that's it.

It's a government work. West doesn't dispute that. West, as far as I know, doesn't dispute Section 403 or the language that the Congress stated which underlies 403: 403 is aimed at a publishing practice that while technically justified under the present law has been the object of considerable criticism in cases where government work is published or republished commercially where it has frequently been the practice to add some new matter in the form of an introduction, editing, illustrations, et cetera, and to include a general copyright notice in the name of the commercial publisher suggests publicly that the bulk of the work is not copyrightable and therefore free for use."

What could be more public governmental work than a Supreme Court case, your Honor?

What could be less intellectual, less creative than a parallel cite or citation or a correction to text? I mean,

everything else I think is pretty much in our briefs, [21] your Honor.

Furthermore, now to get to the other question that West is kind of trying to bring into the back door with regard to the Supreme Court Reporter, there is no selection, there is no arrangement. They arrange it in the same way the Supreme Court does. They select it in the same way the Supreme Court does. They say so in their answers. There's not even the minimum. Doesn't even come close on the Supreme Court.

Moving now to — by the way, your Honor, we believe that partial summary judgment, despite whatever else happens here today, partial summary judgment should be granted with regard to both the text and the pagination with regard to Supreme Court Reporters.

moving now to the courts of appeals. West has taken the position that its intellectual value, its creative value is nothing more than cross references. Mr. Musilek just said it.

We've pointed out to text over and over and over, your Honor, and we've said to West, point this Court to one thing you do so that the Court can examine anything you claim is. They have never done it.

We have taken a hundred pages, given it to your Honor. We said: These are the changes they make, tell us differently.

[22] I refer your Honor to West's statements in its opposition to our statement of uncontested fact. It is dribble. There is not one single statement by West about text that it

adds to the first hundred pages of 1 F.3d. Nor has it pointed to anywhere else anywhere else in F.3d or F.2d where into the text of a court's opinion it has added anything of value. Anything.

It says today — I guess what we have devolved to after five years of fighting this issue, what we have basically devolved to I guess is that West is claiming that there's some value in its cross-reference to other books.

I have no answer for that at all, your Honor. I don't. They are taking government works, written by judges.

Furthermore, I know that this has been briefed over and over —

THE COURT: Do you have section 403?

MR. HARTMANN: Page 35 of our reply brief is the Conference Committee report to 403 which is what I was reading from. And 403 is at 34 of the reply brief.

THE COURT: Your reply brief page 35?

MR. HARTMANN: Yes, your Honor, 34 is the text of 403 and 35 toward the bottom is the text of the Conference Committee report. Your Honor, the Conference Committee report describes exactly, word for word, exactly what West does.

[23] Now, your Honor, I know that we have gone over this a half dozen times in the brief and I don't want to belabor

the point, but I think that it is as critical to note West's response to number 81, which is at 40 of our brief. It says "other editor enhancements on comparison of case reports to slip opinions. While it may not be possible to show who authored certain corrections to the text of opinions, West's understanding is that many judges do see to it that corrections made by them are noted in the court's files."

Your Honor, West gets corrections from judges. West puts them into West's version of these opinions. West doesn't have the records, and I know it because I have been through their records, your Honor, everything they say that they have got.

West does not keep the records to tell you what changes were made by judges and which ones were made by West. They are now using this word "suggest." Judges don't really make the changes, you see, they suggest the changes to West. But after they've suggested the changes to West, West puts them into those decisions and West now can't tell you what in that decision West did.

So even if there was the slightest bit of creativity, the slightest bit of value in those hundred pages of 1 F.3d that we have cited your Honor to or anywhere [24] else in F.3d in correcting a word, which is all they've ever done, we don't even know that they did it. There's nothing more that can be said.

Now, with regard to the pagination issue, your Honor, West has told Hyperlaw without any reference to fair use that Hyperlaw can use its first page citations. It has told

everybody else in the world that too. They are just moving the shells around in different ways. The truth is once you know the first page you know everything about the order and arrangement.

With regard to the internal, they say it is done by machine, and even when it isn't, your Honor, we have shown in our brief that those breaks occur in four or five different places. There is no value to the breaks. They are facts. Period. End of discussion. There is nothing else I can add.

THE COURT: What about the head notes?

MR. HARTMANN: The head notes, this is one of those don't-get-me-started things.

The headnotes are sometimes as shown in the affidavit from our expert that's attached here — who is a noted law librarian — are sometimes copied verbatim out of Federal court opinions. When they are, they are text of government works. They can't be copyrighted. Period. End of discussion. The text can't be.

[25] The fact that they order them in the headnotes, fine, that's great. But not the text. Never the text of a Federal work.

THE COURT: The fact is when they do a headnote they put a key number in the opinion.

MR. HARTMANN: Fine. Then you can't copy it without the key number and I can't copy all the stuff —

THE COURT: But you are copying the key number, are you not —

MR. HARTMANN: Not me.

THE COURT: When you scan —

MR. HARTMANN: We don't, your Honor. That's just a bold outright known lie. West has said this over and over and over again. We've put five pages on it in our reply. Hyperlaw does not do intermediate copying.

What we do is take the West document, ablate, redec anything that has any intellectual claim, even a claim, we ablate that. We then copy it. We then key stroke or scan. When we say scan, we don't mean scan the whole page. We mean scan the text of a judicial decision as written by a judge. That's all we ever scan.

THE COURT: Do you block out all of the key numbers in the text?

MR. HARTMANN: Yes. And that was done years ago, your Honor, five of them. We sent the original text, the [26] ablated text, the scanned text and the resultant text to West and said: Tell us what in here do you claim a copyright.

Now, we played this game for five years, and what it comes down to, what Mr. Musilek just said if I understood him right, your Honor, is there is an intellectual, some value, some choice, some decision in putting cross-references in.

Nothing more, your Honor.

MR. MUSILEK: Your Honor, this is not closing argument at a trial. This is a summary judgment motion, and yet what I heard from Mr. Hartmann was not nothing more than personal testimony as to what he thinks the facts are. Of course, those facts are highly contested in sworn affidavits.

THE COURT: But you are saying they are highly contested. You put in some generalized statements in an affidavit. That doesn't establish the detail that you need to sustain your claim.

MR. MUSILEK: Your Honor, if I may, this is out of Alan Sugarman's deposition. This is not generalized. This is specific testimony by Alan Sugarman, the owner and president of Hyperlaw.

"Q. What plans do you have with respect to scan? Do you have particular groups of material that you [27] would scan?

"A. Well, the first group would be to fill in pieces of the court's information whatever reason are not made available to us even though they might make them available to others in digital form. Then we would work back with regards to, perhaps, to depending on the upon the court's opinion we would fill in Federal, we would take the decisions from the Federal Reporter and have them converted. Again, that is basically an economic decision.

"With regard to scanning these materials in" —

THE COURT: I don't give tests to the court reporter.

MR. MUSILEK: "Question: With regard to scanning these materials in, are there any other preparations you would need to make? Are there any preparations you would need to make with regard to the beginning of this operation if the court's decision gives you permission to do so?

"A. In the older decisions all you would have to do is purchase a set of used books from a law book dealer.

"Q. In terms of technology and products and in terms of procedures, is there anything you have not yet put in place?

"A. No."

Mr. Sugarman testified that he intended to scan. [28] That is evidence in the record. That fact and every inference from it must be granted to West on a summary judgment motion, your Honor, and so you have to assume that what they intend to do is scan.

THE COURT: Suppose all I am going to do is grant summary judgment that says that Hyperlaw may copy, may scan the text of a West opinion, not including any headnotes, identity of counsel, or any key number, without any key numbers in the opinion?

MR. MUSILEK: What about alternative and parallel citations?

THE COURT: Let's just deal with that. I can do that.

Then the question is whether I think that the alternative and parallel citations are really a substantial contribution that

gives you a separate copyright with the exception of me, the author.

MR. MUSILEK: Your Honor, with regard to a summary judgment motion, and again that's a standard we are dealing with here, not a summation at trial, with regard to summary judgment motion, we have an affidavit from Donna Bursgard that is specific on that point which is that alternative citations are creatively selected, created and prepared by West attorney-editors. That fact must be taken as true.

[29] THE COURT: The fact that alternative citations are selected has to be selected. I don't have to take it as a matter of law what the law is saying is created.

MR. MUSILEK: Your Honor, the law does say and no one disputes it that if it is a creative selection that is copyrightable. That is statutory language. That is Section 101 of the copyright.

The selection, coordination or arrangement, any one of these three things is entitled to protection. When you tell someone they can scan all of our selection of alternative and parallel citations you are telling them they can copy our selection. That's an infringement.

And what I am saying is on a summary judgment motion that's entirely inappropriate and you cannot really piece out and parse out of pieces —

THE COURT: Are you ready for trial next week?

MR. MUSILEK: I understand Mr. Chu is gone for three weeks to Southeast Asia.

THE COURT: He's not going to have to try this. He's got a different issue.

MR. MUSILEK: Your Honor, I don't know if we are ready for next week. Our witnesses are ready to testify and to testify in front of a jury about what they do.

There are a couple of other things that I do want to bring to the Court's attention because I think we have [30] gotten afield. West does take very much umbrage at the notion that they are coming in and arguing about the copyright provision 403 without having ever pleaded it and given the clear fact dispute that arises simply by looking at the copyright notion that Matthew Bender and Hyperlaw uses on their products.

The legislative history cited by Mr. Hartmann made mention of using government works with a general copyright notice. There is no general copyright notice here. We are talking about a very specific copyright notice in West books, in Matthew Bender CD-ROMs and in Hyperlaw CD-ROMs that states clearly that no copyright is claimed in government works.

Your Honor, Section 403 states that you may show affirmatively or negatively in your copyright notice what you claim a copyright in. West, Matthew Bender and Hyperlaw all show it the same way. They all claim a copyright in the text of the opinions that's entirely enhanced, and we cite that in the briefs and it is there, and given that it seems implausible

even if it weren't procedurally improper, it seems implausible and in fact impossible to grant a summary judgment motion on the issue when there is no testimony in the record, no discovery in the case on that issue and we have as known fact that all three parties use the same copyrights.

[31] The other thing I do want to say they make statements about what they have seen and what they did in discovery. They don't rebut what West says it does and how it says it does it.

Your Honor, I would take issue with the notion that the affidavits of West are not specific. In large part they are very specific. Certainly as to the arrangement of the works. Certainly as to the arrangement of Supreme Court Reporter being different from U.S. Reports. All you have to do, your Honor, is take judicial notice by looking at a single volume of Supreme Court Reports, and if you look and I am looking at Volume 106, if you look at the very first case that is referenced there, there is a parallel citation to the U.S. Reports which shows that it is in Volume 473 U.S. 1308.

If you then go to the next case that's reported by West it is 473 U.S. 1307, followed by 473 U.S. 1315 which means we have three cases in a row. You then turn to the next case and you go back two volumes to look 471, 473, 473. Your Honor, there is not an identical arrangement. There never has been. How different it is is, of course, a fact question.

Finally, of course with no offense to the government but with respect to Supreme Court decisions, it is West that comes out with Supreme Court Reporter two years [32] before U.S.

Reports, so they obviously are not copying it from U.S. Reports.

THE COURT: Let's take a five-minute recess.

(Recess)

THE COURT: Do both sides agree in the Matthew Bender case that the issue can be decided an summary judgment?

MR. CHU: We do, your Honor.

MR. MUSILEK: Your Honor, West takes the legal position that it can be decided on summary judgment with the assumption that West has a creative arrangement and that the copying that is done by Matthew Bender has been admitted to be done. If they are going to contest either of those, then of course we think we have a fact dispute.

THE COURT: I don't think what Matthew Bender has done is contested.

MR. MUSILEK: It says in its brief and statement of undisputed facts that it has copied nothing from a West book.

THE COURT: It has copied nothing from a West book that is inserted in star pages. They copied them from other sources. The text of the opinion comes from other sources.

MR. MUSILEK: I guess all I am saying is in response to the question is the standard is the fact that we [33] have cross-moved —

THE COURT: That I know, but I am trying to find out whether anybody thinks there are really any facts in dispute here, material issues of fact in dispute.

MR. MUSILEK: Applying the undisputed facts asserted by West, West believes summary judgment is appropriate that star pagination is an infringement.

THE COURT: Let's assume I disagree with that. What is not factually disputed that would prevent me from granting summary judgment for Matthew Bender?

MR. MUSILEK: The facts as set forth in all of the material by West as applying Section 106 of the Copyright Act, which defines copies and says that copies are anything that results in the underlying working capable of being perceived, communicated.

We are saying that can be done, and in our statement of undisputed fact we are saying the Matthew Bender product allows you to perceive and communicate the West arrangement. If that is accepted as fact in the Court's factual findings, then we are prepared to have the Court rule on summary judgment.

If the Court says that the Matthew Bender product does not communicate or that the arrangement cannot be perceived by using the West arrangement, cannot be perceived using the Matthew Bender product, then there is a fact [34] dispute.

THE COURT: What difference is there between using the star pagination as simply the first name, the first page pagination?

MR. MUSILEK: Your Honor, that's a very important fact question that goes to the fair-use portion of the case. That is in essence the fair-use portion of the case. One use is a reference to a West work. It is fair use. One use. Star pagination, on the other hand, is a supplanting use, not a fair use.

THE COURT: Star pagination, though, you say if by using the star pagination they can duplicate through their computer the West system, why can't they do that, why they can't they reproduce your compilation simply by using the first page?

MR. MUSILEK: Your Honor, they can. They cannot show where in fact page breaks occur; they cannot show the page numbers associated with those page breaks for finding specific portions of text.

THE COURT: I have enough of what I need.

I am going to grant summary judgment to Matthew Bender and to the star pagination.

As I indicated at the outset of this argument, with the quote from Judge Leval in CCC, that the facts set forth in the compilation are not protected and may be freely [35] copied, the protection extends only to those aspects of the compilation that embody the original creation of the compiler.

Here, the original creation of West is not in the number of lines in any case, it is not in the number of any pages of any case. The original creation may be in the way West selects

cases for reporting, the cases that it puts, any headnotes that it adds to the report and similar additional material when put together with the official report that that they obtain from the Court.

However, where and on what particular pages the text of a court opinion appears does not embody any original creation of the compiler, and, therefore in my view, is not entitled to protection.

Even if the Court were to find that this matter were entitled to protection, the use of star pagination would in the Court's view constitute fair use.

I think it is important in looking at the fair use analysis to start with the decision in the Second Circuit in Weissman v. Freeman which underscores an important factor which I think is often overlooked by lawyers' mechanical arguments about fair use, and that is the statement that appears, if I am not violating any copyright, on page 1323 of 868 F.2d. "Analysis begins not by elevating the statutory guides to inflexible rules but [36] with a review of the underlying equities."

It seems clearly the underlying equities here lie with allowing use of star pagination. On the one hand it can be said that somehow Matthew Bender is taking advantage of the sweat of West's brow. But Feist did away with that concept. What West is attempting to do by trying to inhibit star pagination is to create a monopoly over reported court decisions. That, in my view, is not an equitable activity and therefore should play some role in the analysis of whether or not there is fair use here.

Appendix C

The purpose and character of the use is, yes, that it is commercial, but it is only concluding whether it is commercial. Matthew Bender is not using the star pagination to take advantage of some structure in West's compilation that has these bits of text appear on a particular pages. It is simply providing a method whereby users of its product who wish to look at the text in its hard copy form can go to the volumes and find it. It is also providing a method by which the users of its product can in their legal writings refer others to the official reports as is often required by the rules of courts and the rules of individual judges, such as my rules.

So that if we look at the purpose and character of the use, even though it is commercial, it still seems to me that it has purposes here that make it a worthwhile [37] purpose and that there is no great advantage to West from that use.

Again, we look at the nature of the copyrighted work. It is a compilation. The star pagination does not in any way take advantage of that part of West's effort in making the compilation that reflects its intellectual effort. It simply, as I indicated earlier, reflects the accident of where a particular portion of an opinion ended up in a West reporter.

Similarly, the star pagination does not take a substantial amount in relation to the copyrighted work as a whole. West has its copyright because of the compilation, not because of where a particular portion of court-authored text falls on a page.

As to the effect of the use upon the potential market for a value of the copyrighted work, it does not seem to me that

this factor weighs heavily in West's favor because the use of the star pagination does not necessarily impact on the market for those who want printed books in which they can look at the decisions of the court and want to have compilations; that is, works that lay out those opinions in a specific creative order that West has compiled. It simply will affect the market for text of court decisions. But West has no copyright on the text of the court decision. It only has a copyright in a [38] compilation. So for all of those reasons the Court concludes that summary judgment should be issued on the question of the use of star pagination.

With respect to the Hyperlaw issues, the Court is going to deny summary judgment to Hyperlaw because I think under the standards of the Second Circuit there are disputed issues of fact, and although on the facts as they have been presented to me I would decide in Hyperlaw's favor, and indeed if I were a circuit judge I might well find that the issue was clear enough that there were not disputes of material fact. I'm not at all confident that the Second Circuit would adopt that position and I am very confident that it is not in anybody's interest given the extended nature of this case that we simply set off a round of briefing in the Second Circuit and then if I am correct that that court might find that there are factual issues to have to come back here two or three years from now to deal with that issue. I think it is a more practical approach and I think required here that the issues of fact be developed at the trial.

Whether at the end of the trial it showed no more than the record before me, I would direct a verdict or enter a judgment NOV is a question that will be left open. But I think

that summary judgment is not the appropriate vehicle to deal with this case.

[39] MR. HARTMANN: Your Honor, may I inquire. At 6 of our reply brief we conceded that the matter was ripe for summary judgment with regard to pagination and made the parallel motion.

THE COURT: As to parallel motion, with respect to pagination it applies completely and I am happy to enter summary judgment for you and to have that entered as a final judgment and so that it may be taken up because it should go up and there is no difference in my view.

MR. HARTMANN: Thank you, your Honor.

THE COURT: This is going to be a jury trial?

MR. MUSILEK: Your Honor, yes, at this point I think all parties have asked for a jury.

THE COURT: And after what I've just said I would be very surprised if West would waive a jury.

How long do you anticipate this trial will take?

MR. HARTMANN: Your Honor, Hyperlaw suggests as Mr. Musilek represented earlier in the argument that all of the witnesses are known, all of the basic testimony is already before the court, we would expect it not to take more than three days.

MR. MUSILEK: Your Honor, I think that's a gross underestimate of the time. It is going to take all the West attorney-editors to tell what they do and show what's in the books. I think it is a two-week trial.

[40] THE COURT: January 27th.

MR. HARTMANN: Thank you, your Honor.

THE COURT: Give me a pretrial order by January 17th. Thank you.

(Proceeding adjourned)

* * * *

APPENDIX D — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT DENYING PETITION FOR REHEARING DATED AND FILED DECEMBER 18, 1998

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT
UNITED STATES COURT HOUSE
40 FOLEY SQUARE
NEW YORK 10007

CAROLYN CLARK CAMPBELL
CLERK

At a stated term of the United States Court of Appeals for the Second Circuit, held at the United States Courthouse, Foley Square, in the City of New York, on the day of one thousand nine hundred and ninety-eight.

Dkt No: 97-7430

Matthew Bender & Co.

Plaintiff-Appellee,

v

West Publishing Co.

Defendant-Appellant.

A petition for rehearing en banc having been filed herein by the appellant West Publishing Co.

Appendix D

Upon consideration by the panel that decided the appeal, it is Ordered that said petition for rehearing is **DENIED.**

It is further noted that the petition for rehearing in banc has been transmitted to the judges for the court in regular active service and to any other judge that heard the appeal and that no such judge has requested that a vote be taken thereon.

FOR THE COURT

CAROLYN CLARK CAMPBELL,
Clerk

By: s/ Beth J. Meador
Beth J. Meador,
Administrative Attorney

APPENDIX E — JUDGMENT OF THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT DATED NOVEMBER 3, 1998 AND FILED NOVEMBER 4, 1998

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT
UNITED STATES COURT HOUSE
40 FOLEY SQUARE
NEW YORK 10007

SDNY/NYNY
94-cv-589
Trj: Martin
Mag: Buchwald

At a stated Term of the United States Court of Appeals for the Second Circuit, held at the United States Courthouse in the City of New York, Foley Square, on the 3rd day of November, one thousand nine hundred and ninety-eight.

BEFORE: Hon. Richard J. Cardamone
Hon. Dennis Jacobs
Circuit Judges
Hon. Robert W. Sweet
District Judge*

Docket No. 97-7430

MATTHEW BENDER & COMPANY, INC.,

Plaintiff-Appellee,

---

* The Honorable Robert W. Sweet, of the United States District Court for the Southern District of New York, sitting by designation.

Appendix E

HYPERLAW, INC.,

Intervenor-Plaintiff-Appellee,

–v–

WEST PUBLISHING CO.; WEST PUBLISHING CORPORATION,

Defendants-Appellants.

Appeal from the United States District Court for the Southern District of New York.

This cause came on to be heard on the transcript of record from the Southern District of New York and was argued by counsel.

ON CONSIDERATION WHEREOF, it is now hereby **ORDERED, ADJUDGED, and DECREED** that the judgment of said district court be and it hereby is affirmed in accordance with the opinion of this court.

FOR THE COURT
Carolyn Clark Campbell, Clerk
By:

s/ Beth J. Meador
Beth J. Meador
Administrative Attorney

Supreme Court, U.S.
FILED
APR 16 1999
CLERK

No. 98-1500

In The

Supreme Court of the United States

October Term, 1998

WEST PUBLISHING CO. and
WEST PUBLISHING CORPORATION,

Petitioners,

v.

MATTHEW BENDER & COMPANY, INC.
and HYPERLAW, INC.,

Respondents.

**On Petition For Writ Of Certiorari
To The United States Court Of Appeals
For The Second Circuit**

BRIEF IN OPPOSITION

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TABLE OF CONTENTS

Page

STATEMENT OF THE CASE 1

REASONS FOR DENYING THE WRIT 5

I. THERE IS NO SPLIT IN AUTHORITY BETWEEN THE COURTS OF APPEALS FOLLOWING THIS COURT'S DECISION IN *FEIST* 5

II. THE COURT SHOULD NOT USE THIS CASE TO RESOLVE ISSUES REGARDING THE COPYRIGHTABILITY OF COMPILATIONS OF FEDERAL JUDICIAL DECISIONS, BECAUSE OF WEST'S IMPROPER ATTEMPTS TO INFLUENCE THE FEDERAL JUDICIARY, INCLUDING JUSTICES OF THE SUPREME COURT.... 9

III. THE RELATIONSHIP BETWEEN THE CURRENT OWNER OF MATTHEW BENDER & COMPANY AND WEST SUGGESTS THE POSSIBLE ABSENCE OF AN ACTUAL CASE OR CONTROVERSY BETWEEN MATTHEW BENDER AND WEST (THOMSON) 11

CONCLUSION 15

TABLE OF AUTHORITIES

Page

CASES

Chicago & Grand Trunk R. Co. v. Wellman, 143 U.S. 339 (1892) 14

Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991) ..... *passim*

Flast v. Cohen, 392 U.S. 83, 88 S. Ct. 1942, 20 L. Ed. 2d 947 (1968) 14

Hutchinson Telephone Co. v. Fronteer Directory, 770 F.2d 128 (8th Cir. 1985) 6

Matthew Bender & Company, Inc. v. West Publishing Co., 158 F.3d 674 (2d Cir. 1998) 8, 13

Matthew Bender & Company, Inc. v. West Publishing Company, 1995 U.S. Dist. LEXIS 3280 (S.D. N.Y. 1995) 9

Oasis Publishing Co., Inc. v. West Publishing Co., 924 F. Supp. 918 (D. Minn. 1996) 8

Sony Corp. of Amer. v. Universal City Studios, Inc., 464 U.S. 417, 104 S. Ct. 774, 78 L. Ed. 2d 574 (1984) 7

United States v. Johnson, 319 U.S. 302 (1943) 14

United States v. Thomson Corp., 949 F. Supp. 907 (D.D.C. 1996) 11

West Publishing Co. v. Mead Data Central, Inc., 799 F.2d 1219 (8th Cir. 1986) 5, 6, 7, 8, 9, 12

TABLE OF AUTHORITIES – Continued

Page

OTHER AUTHORITIES

Arthur R. Miller, Copyright Protection for Computer-Generated Works: Is Anything New Since Contu?, 106 Harv. L. Rev. at 1040 (fn. 284)..... 7

Levine and Squires, "Notice, Deposit and Registration: The Importance of Being Formal", 24 U.C.L.A. Law Rev. 1232 3

Patterson & Joyce, Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations, 36 UCLA L. Rev. 719, 763 n. 155 (1989) 8

STATEMENT OF THE CASE

On June 21, 1996, at an evidentiary hearing before the District Court (Martin, J.) on West's motion to dismiss HyperLaw's complaint, HyperLaw demonstrated its case law product, showing that its Second Quarter 1996 CD-ROM contained over 36,000 appellate opinions, of which *only* approximately 22,000 were also published by West – 14,000 were not published by West. Thus, it was shown at that hearing that for any given time period covered by HyperLaw's product, HyperLaw reports approximately 63% more decisions than are published by West in the Supreme Court Reporter and the Federal Reporter.

Despite West's grandiose pronouncements about how important these issues are, in the end they are quite simple. HyperLaw seeks to add to its product cross references to page numbers in West's reporters. West simply does not want HyperLaw or anyone to do so. (Of course, West's copyrights on its digests and key number aides remains unaffected by the judgment herein.)

Thus, this case is not, as West suggests, a "brink of a new millennium" case. It is a simple and obvious application of *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991). West seeks to make cross referencing to page numbers in a copyrighted compilations a protected right.

The Second Circuit's ruling does not give a "free pass" to infringers of copyrighted compilations. On the contrary, this case (and the companion case on text) are not really about compilations, they are about the copying of and reference to the text of an opinion written by a *federal judge*. The two cases taken together are simply

attempts by West to expropriate public documents by either the insertion of minuscule and rote changes or by stopping cross references to those cases.[1] This is the exact issue that Congress addressed when it re-wrote the Copyright Act in 1976.[2] H.R. Rep. No. 94-1476, 94th Cong., 2d

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[1] It is important to remember that the Trial Court made a factual finding with regard to West's intent: "[T]he underlying equities here lie with allowing use of star pagination . . . What West is attempting to do by trying to inhibit star pagination is to create a monopoly over reported court decisions." *Summary Judgment Decision* at 36.

[2] In 1976, Congress revised the Copyright Act. Section 105 states, "Copyright protection under this title is not available for any work of the United States Government." Congress also included § 403, to ensure that § 105 would have meaning when works of the federal government were re-published by private publishers. Section 403 states,

> Whenever a work is published in copies or phonorecords consisting preponderantly of one or more works of the United States Government, the notice of copyright provided by sections 401 or 402 *shall also include a statement identifying, either affirmatively or negatively, those portions of the copies* or phonorecords embodying any work or works protected under this title. [Emphasis added.]

West omits from its copyright notices, any identification, either affirmatively or negatively, of those portions of its case reports embodying any work or works of the federal judiciary, or those parts of the text of judicial opinions in which West claims copyright. Nor is there any great mystery regarding why § 403 was enacted – to stop *exactly* what West has tried to do – expropriate governmental works by vaguely identified, minuscule variations. The House Judiciary Committee Report No. 94-1476 contains a discussion of § 403:

Sess. 145 (1976); S. Rep. No. 94-473, 94th Cong., 1st Sess. 128 (1975). *See also* Levine and Squires, *"Notice, Deposit and Registration: The Importance of Being Formal"*, 24 U.C.L.A. Law Rev. 1232.

West misstates the facts of the case[3] and the facts regarding a so called "split of authority" between the

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> Section 403. Notice for Publications Incorporating United States Works
>
> Section 403 is aimed at a publishing practice that, while technically justified under the present law, has been the object of *considerable criticism. In cases where a Government work is published or republished commercially, it has frequently been the practice to add some "new matter" in the form of an introduction, editing, illustrations, etc., and to include a general copyright notice in the name of the commercial publisher. [which] suggests to the public that the bulk of the work is [not] uncopyrightable and therefore free for use.*
>
> *To make the notice meaningful rather than misleading,* section 403 requires that, when the copies or phonorecords consist "preponderantly of one or more works of the United States Government," the copyright notice (if any) identify those parts of the work in which copyright is claimed. *A failure to meet this requirement would be treated as an omission of the notice,* subject to the provisions of section 405.

[3] Despite West's self-serving statements to the contrary, there is indeed a dispute that West's ordering of reported cases in its Reporter volumes represents an original and copyrighted arrangement. HyperLaw disputed this West assertion both in the District Court and in the Court of Appeals. Both Courts assumed a copyrightable arrangement, *arguendo*, without deciding the issue. Moreover, as HyperLaw demonstrated to the District Court below, and never disputed by West during the hearing, HyperLaw's CD-ROM product is *incapable of displaying West's arrangement.* (West tries to lump HyperLaw's product

Second and Eighth Circuits. The Eighth Circuit's decision was implicitly overruled by this Court in *Feist Publications, Inc. v. Rural Telephone Service Co., supra.* The alleged "split" is between this post-*Feist* decision and a decision which was either implicitly overruled, or so affected by *Feist* that its reasoning is no longer a valid benchmark for a discussion of the issues. There have been no other cases in any other Circuit in the post-*Feist* era which would inform this Court with regard to the opposing views on this issue.

As the record shows, this case is muddled by several unique problems concerning its posture as it comes before the Court. First, there is the situation involving West's relationship, on these exact issues, with the federal judiciary (including this Court). Second, this case is complicated by justiciability concerns arising out of the undisclosed relationship between two of the putative opponents – West and Matthew Bender. (This complication arose after the recent acquisition of Matthew Bender by Reed Elsevier, the parent company of LEXIS. There is an 1988 settlement agreement between West and Mead Data, former owner of LEXIS, which apparently remains binding upon Reed Elsevier, the current owner of both LEXIS and Matthew Bender. Reed Elsevier filed an opposing amicus brief in the companion text case[4], although

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with Bender's to obscure this critical distinction.) Again, since both Courts' decisions were reached without reliance on whether or not HyperLaw's product could or could not display West's arrangement, both courts assumed it without ever deciding the fact.

[4] *West Publishing Co. v. HyperLaw, Inc.*, Docket No. 98-1500.

Matthew Bender has filed a separate action against West challenging West's text claims.) Third, Reed Elsevier and Thomson are joined together in a massive effort to overrule this and the companion text case by database protection legislation.

For all of these reasons, HyperLaw opposes the granting of a Writ of Certiorari.

REASONS FOR DENYING THE WRIT

I. THERE IS NO SPLIT IN AUTHORITY BETWEEN THE COURTS OF APPEALS FOLLOWING THIS COURT'S DECISION IN *FEIST*

In 1991, the Court decided *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 111 S. Ct. 1282, 113 L. Ed. 2d 358 (1991), and clarified the minimal constitutional requirement for copyright. In doing so, it finally disposed of any remaining application of the "sweat of the brow" doctrine. To the extent that the Eighth Circuit applied the "sweat of the brow" doctrine in *West Publishing Co. v. Mead Data Central, Inc.*, 799 F.2d 1219 (8th Cir. 1986), that case was overturned by *Feist*, and cannot serve as the basis for asserting a split in the Circuits.

In *West Publishing*, the Eighth Circuit applied the "sweat of the brow" doctrine, when it stated,

> We conclude, as did the District Court, that the arrangement West produces through this process is the result of considerable labor, talent, and judgment. As discussed above, *supra*, slip

> op. pp. 5-6, to meet intellectual-creation requirements a work need only be the product of a modicum of intellectual labor.

Id. at 1226-1227. Rather than considering the originality featured or expressed in the work itself, the *West Publishing* court considered the labor, talent and judgment expended. *Feist*, to the contrary, instructs us that it is the expressive element in which one must find originality, in order for copyrightability to exist. Moreover, *Feist* tells us that "the constitutional minimum for copyright protection [is that a work] *features* an original selection or arrangement." [Emphasis added.] *Feist*, 499 U.S. at 348.

Thus, whereas *West Publishing* rests its test for copyrightability upon a finding that the efforts of the author involved labor, talent and judgment, *Feist* rests copyrightability on the expression or features of originality in the work itself. This is what distinguishes the *Feist* view of originality from the "sweat of the brow" decision. Moreover, it is clear that the Eighth Circuit misunderstood this distinction. That court's express cite to the authority of a "sweat of the brow" phone directory case reveals its error.

> The names, addresses, and phone numbers in a telephone directory are "facts"; though isolated use of these facts is not copyright infringement, copying each and every listing is an infringement. *See Hutchinson Telephone Co. v. Fronteer Directory*, 770 F.2d 128 (8th Cir. 1985).

799 F.2d at 1228.

In addition, the Eighth Circuit applied the wrong test for infringement. In *West Publishing*, which also involved the insertion of star pagination into electronic databases

of cases, Mead Data did not feature its cases with the same selection or arrangement as West. Yet the Eighth Circuit found that the mere insertion of star pagination could constitute infringement.

> Jump cites to West volumes within a case on LEXIS are infringing because they *enable* LEXIS users *to discern* the precise location in West's arrangement of the portion of the opinion being viewed. [Emphasis added.]

Id. at 1227. As West invites this Court to do here, the Eighth Circuit found infringement from mere enabling of users to discern – contrary to the instructions of *Feist* and *Sony Corp. of Amer. v. Universal City Studios, Inc.*, 464 U.S. 417, 104 S. Ct. 774, 78 L. Ed. 2d 574 (1984). *Feist* expressed the rule that,

> Notwithstanding a valid copyright, a subsequent compiler remains free to use the facts contained in another's publication to aid in preparing a competing work, *so long as the competing work does not feature the same selection and arrangement.* [Emphasis added.]

499 U.S. at 349.

West correctly points out that a myriad of legal scholars, analyzing the effect of *Feist* on *West Publishing* have determined that *West Publishing* was overruled by *Feist*.[5] Indeed, in *Feist* the Court cited with approval,

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[5] Indeed, West's own counsel, Arthur Miller, was one such scholar – until he was retained by West to argue this appeal before the Second Circuit and in this Petition. *See* Arthur R. Miller, Copyright Protection for Computer-Generated Works: Is Anything New Since Contu?, 106 Harv. L. Rev. at 1040 (fn. 284)

Patterson & Joyce, Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations, 36 UCLA L. Rev. 719, 763, n. 155 (1989), which severely criticized West Publishing. West appears to have been reluctant to revisit this issue in the Eighth Circuit since *Feist*. *Oasis Publishing Co., Inc. v. West Publishing Co.*, 924 F. Supp. 918 (D. Minn. 1996) was on appeal to the Eighth Circuit, fully briefed, argued and *sub judice*. At the 11th hour, West settled that case, the appeal was dismissed, and the Eighth Circuit was prevented from revisiting *West Publishing Co.*

West argues that the existence of a split in authority between the Circuits is evidenced by the Second Circuit's statement that, "We differ with the Eighth Circuit's opinion in *West Publishing Co. v. Mead Data Central, Inc.*" *Matthew Bender & Company, Inc. v. West Publishing Co.*, 158 F.3d 693, 707 (2d Cir. 1998). This is pure deception – all one has to do is continue reading to see that West is simply being "clever". West intentionally omits that *the Second Circuit explained that its difference with the Eighth Circuit was based on Feist.*

> At bottom, *West Publishing Co.* rests upon the now defunct "sweat of the brow" doctrine. . . . Thus, the Eighth Circuit in *West Publishing Co.* erroneously protected West's industrious collection rather than its original creation. Because *Feist* undermines the reasoning of West Publishing Co., *see United States v. Thomson Corp.*, 949

("*Feist* raises questions concerning the continued viability of such cases as *West Publishing Co. v. Mead Data Central, Inc.* . . . which held that star pagination was copyrightable.")

F. Supp. 907, 926 (D.D.C. 1996) we decline to follow it.

There is presently no split in authority between the Circuits regarding this issue. Either *Feist* overruled *West Publishing*, as the Second Circuit found, or *Feist's* clarification of the minimum constitutional requirement for copyrightability has yet to be applied by any other Circuit in such a "pagination case" – so that no "split" currently exists.

II. THE COURT SHOULD NOT USE THIS CASE TO RESOLVE ISSUES REGARDING THE COPYRIGHTABILITY OF COMPILATIONS OF FEDERAL JUDICIAL DECISIONS, BECAUSE OF WEST'S IMPROPER ATTEMPTS TO INFLUENCE THE FEDERAL JUDICIARY, INCLUDING JUSTICES OF THE SUPREME COURT.

In 1995, HyperLaw's counsel wrote a series of letters to United States District Judge Preska, the initial judge below, with regard to West's attempts to influence that and other courts on the issues presented here. That correspondence culminated in a letter to Judge Preska dated March 8, 1995, which Judge Preska responded to (and included) in a Memorandum and Order dated March 15, 1995. *Matthew Bender & Company, Inc. v. West Publishing Company*, 1995 U.S. Dist. LEXIS 3280 (S.D. N.Y. 1995).[6] Judge Preska recused herself thereafter.

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[6] Attached to Judge Preska's decision, as it is published by LEXIS, are a series of major newspaper articles and West's responses thereto. Included are articles from the Minneapolis Star Tribune of March 5 and 6, 1995 which uncovered documents proving that even while its matters were before

There are many allegations of record regarding West's attempts to influence members of the judiciary who are hearing cases in which it is a party – including the instant case. HyperLaw sought a writ of mandamus on this matter from the Second Circuit, but was never allowed to conduct discovery with regard to West's improper attempts at influencing the federal judiciary. Although HyperLaw's petition for a writ of mandamus was denied, Judge Preska removed herself from the case shortly thereafter. Since it was denied discovery in this area, HyperLaw cannot now confirm or definitively state that any member of the federal judiciary was, in fact, improperly influenced – but it remains an issue for which preliminary proceedings before this Court may be appropriate, in order to resolve possible conflicts.

The Star Tribune articles mentioned sitting and former Justices of the Supreme Court as recipients of West trips and gifts in the same time frame as matters of interest to West were before the Court. While it may not be improper for a federal judge to accept such travel and gifts from West, it was certainly unseemly for West to give them, and a serious error not to so inform the courts sitting on its live controversies. The articles also mention an appeal before the Fifth Circuit in which West was a party while also awarding its Devitt Award to a member of the panel hearing the appeal. West failed to disclose

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courts, West gave federal judges, including Supreme Court Justices, lavish trips and gifts. The articles included references to the failure by federal judges to properly report such gifts – and detailed an extensive effort by West to effect decisions on its copyright issues.

that situation. (In a parallel antitrust proceeding related to the acquisition of West by Thomson and involving the impact of the merger upon the market for authors seeking publication of legal treatises, *United States v. Thomson Corp.*, 949 F. Supp. 907 (D.D.C. 1996), a federal district judge recused himself only after HyperLaw wrote, inquiring as to the publishing contracts between the judge and Thomson. The judge then disclosed that he had publishing contracts with West, as well.)

It is impossible to tell whether there are similar concerns in the instant Petition – and West cannot be trusted, based on its record, to inform the Court and the parties in this regard. Because this case is not in a posture which would allow determination of the substantive issues without such distractions, the Court should exercise its discretion and decline to issue a Writ of Certiorari.

III. THE RELATIONSHIP BETWEEN THE CURRENT OWNER OF MATTHEW BENDER & COMPANY AND WEST SUGGESTS THE POSSIBLE ABSENCE OF AN ACTUAL CASE OR CONTROVERSY BETWEEN MATTHEW BENDER AND WEST (THOMSON).

When this case was before the District Court, Matthew Bender & Co. was owned by Times Mirror. After West appealed this case to the Second Circuit, Matthew Bender was sold to Reed Elsevier. Previously, Reed Elsevier had acquired LEXIS from Mead Data Central, Inc. It is beyond dispute that there exists a contractual relationship between LEXIS (Reed Elsevier) and West (Thomson) which affects the ability of Reed Elsevier to

challenge West copyright claims. This relationship suggests that the instant Petition may not involve an actual case or controversy between West and Matthew Bender.

In 1988, following the Eighth Circuit's decision in *West Publishing Co. v. Mead Data Central, Inc., supra,* and following a trial in the district court but before judgment, West and Mead Data entered into a confidential settlement agreement disposing of the litigation issues between them. (According to the district court docket in *West Publishing,* there were actually two agreements – one concerning case law and the other concerning statutes). These agreements have since controlled the relationship between West and LEXIS (and the companies that own them) relating to citations and perhaps text. That settlement agreement was sealed and allegedly (but actually not) placed into the district court's record (District of Minnesota).

In the instant case, both HyperLaw and Matthew Bender, prior to its acquisition by Reed Elsevier (which, as a successor, has become a party to such agreement), attempted to discover the contents of that confidential agreement during discovery in the District Court, but that discovery was denied by Judge Preska before she recused herself. On information and belief, those two agreements and subsequent amendments thereto provide, *inter alia,* for West to grant a star pagination license to LEXIS (Mead Data and its successors), and restrict how or whether LEXIS (Mead Data) may contest any of West's assertions of pagination copyright claims.

HyperLaw also has reason to believe that these agreements apply to related entities of the parties – and provide that all terms of the agreement would survive the –

sale or transfer of LEXIS or West to other entities, and be binding on their successors and assigns and companies owned or controlled by their successors and assigns. HyperLaw was denied discovery with regard to those facts, and neither West, Mead Data, LEXIS, Thomson, Reed Elsevier, or now Matthew Bender has voluntarily disclosed those facts, as they should – other than to make reference to the existence and amendment of them.

The existence of other circumstances support HyperLaw's beliefs. Reed Elsevier filed an amicus curiae brief in support of West's position in the related text appeal to the Second Circuit (*Matthew Bender & Company, Inc. v. West Publishing Co.*, 158 F.3d 674 (2d Cir. 1998)). In that same appeal, Matthew Bender originally agreed with HyperLaw that it would file an amicus curiae brief supporting HyperLaw's position, and had actually shown drafts of that brief to HyperLaw. But contemporaneously, Matthew Bender's then owner, Times Mirror, was in the process of selling Matthew Bender to Reed Elsevier (which had already submitted its opposing amicus brief). On the eve of the due date of its amicus brief, Matthew Bender informed HyperLaw that it would not be filing it. Thereafter Matthew Bender disclosed that it had been sold to Reed Elsevier.[7] The obvious question raised by

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[7] Additionally, Matthew Bender had filed a motion for attorneys fees in the District Court in December 1996, seeking over one million dollars for its successful prosecution of its pagination copyright declaratory judgment against West. After the Second Circuit's decision affirming that judgment, and after Matthew Bender had been acquired by Reed Elsevier, West and Matthew Bender notified the District Court that they had settled the matter of Matthew Bender's attorneys fees, and Matthew Bender was withdrawing its motion. Neither Matthew Bender

Reed Elsevier's acquisition of Matthew Bender is whether Matthew Bender must now modify its position on the copyrightability of pagination as a consequence of its new owner being a party to a settlement agreement that resolved these same issues as between West and LEXIS (Matthew Bender's now sister company). In light of these and other circumstantial facts, there is certainly an inference that West and Matthew Bender have reached at least a partial resolution of the issues in the instant Petition, without disclosing it to the Court or the courts below.

Decisions of this Court over its history have firmly established the rule that federal courts will not entertain friendly suits, or those which are feigned or collusive in nature. *Flast v. Cohen*, 392 U.S. 83, 88 S. Ct. 1942, 20 L. Ed. 2d 947 (1968); *Chicago & Grand Trunk R. Co. v. Wellman*, 143 U.S. 339 (1892); *United States v. Johnson*, 319 U.S. 302 (1943). It is unlikely that the parties will voluntarily provide a copy of their original agreement (with the subsequent amendments) and related agreements to this Court. But the circumstantial evidence does beg for further explanation and disclosure by West and Matthew Bender[8] before the Court considers granting the Writ. In any event, in light of the unclear relationship between West and Matthew Bender, (and in light of the fact that

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nor West provided the District Court or HyperLaw with the terms of that settlement or the consideration for Matthew Bender to withdraw a motion for over one million dollars in attorneys fees, and neither would even tell HyperLaw if the settlement included any cash payment at all.

[8] HyperLaw has entered into no settlement agreements with West or Matthew Bender, or any of its parent or related companies. Accordingly, this is not a friendly or collusive suit as between HyperLaw and the other parties.

their parents have obtained an almost complete monopoly in the industry) this Petition would not present the best case for the Court's consideration of the important copyright issues decided below.

CONCLUSION

For the foregoing reasons, HyperLaw respectfully requests that a Writ of Certiorari to the United States Court of Appeals for the Second Circuit be denied.

Respectfully submitted,

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(3)

Supreme Court, U.S.
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No. 98-1500

IN THE
Supreme Court of the United States
OCTOBER TERM, 1998

WEST PUBLISHING CO. and
WEST PUBLISHING CORPORATION,
Petitioners,

v.

MATTHEW BENDER & COMPANY, INC.
and HYPERLAW, INC.,
Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Second Circuit

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BRIEF OF RESPONDENT MATTHEW BENDER & COMPANY, INC.

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36pp

QUESTIONS PRESENTED

Matthew Bender & Co., Inc. ("Bender") publishes on CD-ROM a compilation of state and federal judicial opinions. For those opinions that are published in West Publishing Co.'s ("West") reporters, Bender has included parallel citations (initial page citations) and star pagination references (citations to intermediate pages) to indicate where the text of those opinions are located in West's reporters. West concedes Bender's use of parallel citations to West's reporters does not infringe West's copyright. However, West contends Bender's use of star pagination to West's reporters infringes West's copyright. The questions presented are as follows:

1. Whether the page break locations, and the corresponding page numbers, of a book in which a literary work has been embodied are merely accidental features of the physical object in which the work is embodied, not elements of the work itself and, in any event, fail to constitute an original element of the work warranting copyright protection.

2. Whether the use of star pagination to reference page break locations and corresponding page numbers in a compilation does not constitute a reproduction of the arrangement of that compilation.

3. Whether the use of star pagination is non-infringing if it is conceded that the use of parallel citations is a non-infringing "fair use."

RULE 29.6 DISCLOSURE

Matthew Bender & Company, Inc. is a wholly owned subsidiary of Reed Elsevier Overseas BV, Reed Elsevier U.S. Holdings, Inc. and CBM Acquisition Parent Co. Reed Elsevier Overseas BV and Reed Elsevier U.S. Holdings, Inc. are wholly owned indirect subsidiaries of Reed Elsevier plc, which is publicly traded as Reed International plc and Elsevier NV. CBM Acquisition Parent Co. is a wholly owned indirect subsidiary of Reed Elsevier plc and The Times Mirror Co. Matthew Bender & Company, Inc. has less than a whole ownership interest in Ballantine & Sterling, Versus Law, Inc. and Webster Street Partners.

TABLE OF CONTENTS

	Page
OPINIONS BELOW	1
JURISDICTION	1
CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED	1
STATEMENT OF THE CASE	2
A. Overview	2
B. The Controversy	3
C. The Decisions Below	7
ARGUMENT	12
I. THE WRIT SHOULD BE GRANTED AND THE DECISION BELOW SUMMARILY AFFIRMED SO THAT WEST CAN NO LONGER CLAIM A "SCARECROW" COPYRIGHT IN PAGINATION ANYWHERE IN THE UNITED STATES	12
A. Overview	12
B. Review Is Needed To Create Clear National Uniformity Regarding The Copyrightability Of Star Pagination	15
1. The Importance Of Star Pagination	15
2. West's Scarecrow Copyright In The Eighth Circuit	16
(a) The Nature Of The Conflict	17
(b) The Continued Specter Of *West v. Mead*	18
C. This Case Furnishes The Appropriate Vehicle To Vindicate The Repeated Efforts By The United States To Make Star Pagination Available To All	21

TABLE OF CONTENTS—Continued

Page

1. The Copyright Office's Efforts To Amend The Copyright Act To Clarify That Star Pagination Is Not An Infringement 21
2. Antitrust Enforcement Efforts To Force West To Make Star Pagination Available To All 22
3. The United States' *Amicus* Participation In Star Pagination Case Is In Favor Of Bender's Position 25

II. THERE IS NO NEED TO GRANT THE WRIT TO EXPLICATE THE COPYRIGHT ACT'S DEFINIION OF "COPIES" OR TO PROTECT WORKS FIXED IN CD-ROMS 26

CONCLUSION 29

TABLE OF AUTHORITIES

Cases Page

Banks Law Publ'g Co. v. Lawyers' Co-operative Publ'g Co., 169 F. 386 (2d Cir. 1909), *app. dism'd*, 223 U.S. 738 (1911) 26
Callaghan v. Myers, 128 U.S. 617, 661-62 (1888) 26
Eggers v. Sun Sales Corp., 263 F. 373 (2d Cir. 1920) 27
Feist Publications, Inc. v. Rural Tel. Service Co., 499 U.S. 340 (1991) .....*passim*
Matthew Bender & Co. v. West Publ'g Co., 158 F.3d 693 (2nd Cir. 1998), Pet. App. 6a-7a .....*passim*
Matthew Bender & Co. v. West Publ'g Co., 41 U.S.P.Q.2d at 1329-30, Pet. App. 78a-79a..... 8, 13
Matthew Bender & Co. v. West Publ'g Co., 39 U.S.P.Q.2d 1079 (S.D.N.Y. 1996) 1, 7, 17, 20
Matthew Bender & Co. v. West Publ'g Co., 37 U.S.P.Q.2d 1402 (S.D.N.Y. 1995) 1
Myers v. Callaghan, 20 F. 441, 442 (C.C.N.D. Ill. 1883) 26
Oasis Publishing Co. v. West Publishing Co., 924 F. Supp. 918 (D. Minn. 1996) .....*passim*
Ramsey v. Bowersox, 149 F.3d 749 (8th Cir. 1998).. 18
United States v. Thomson, 949 F. Supp. 907 (D.D.C. 1996) .....*passim*
United States v. Thomson, 42 U.S.P.Q.2d 1867 (D.D.C. 1997) 24
University of Texas v. Camenisch, 451 U.S. 390 (1981) 17
Wembley, Inc. v. Superba Cravats, Inc., 315 F.2d 87 (2d Cir. 1963) 14
West Publishing Co. v. Mead Data Central, Inc., 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987) .....*passim*
White-Smith Publishing Co v. Apollo, Co., 209 U.S. 1 (1908) 10, 27, 28

Statutes

17 U.S.C. § 101 .....*passim*
17 U.S.C. § 103(b) 1-2

TABLE OF AUTHORITIES—Continued

Court Rules Page

Eleventh Circuit Rule 28-2(k) 16
Third Circuit Rule 18.3(a) 16

Other Authorities

Arthur R. Miller, *Copyright Protection for Computer Programs, Databases, and Computer-Generated Works: Is Anything New Since CONTU?*, 106 Harv. L. Rev. 978 (1993) 19
Brandriss, *Writing in Frost on a Window Pane: E-Mail and Chatting on RAM and Copyright Fixation*, 43 J. Copyright Soc'y 237 (1996) 28
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Hearings on H.R. 4426, Serial No. 105 (May 14, 1992) 13-14, 19, 21, 22
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Matthew Bender Takes On West Publishing's Copyright, 2 Information Alert, Vol. 2 (February 11, 1994) 14
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Susan Hansen, *Fending Off the Future*, American Lawyer 73 (September 1994) 14
The Bluebook: A Uniform System of Citation (16th Ed. 1997) 16
United States Constitution, Article I, section 8, clause 8 1
Vera Titunik, *That Was Then, This Is Now*, American Lawyer 21 (April 1996) 14
1 William F. Patry, *Copyright Law and Practice* 660 (1994) 19

BRIEF OF RESPONDENT MATTHEW BENDER & COMPANY, INC.

Respondent Matthew Bender & Company, Inc. ("Bender") respectfully prays that a writ of *certiorari* be granted to review the decision of the United States Court of Appeals for the Second Circuit in this case and that the decision be summarily affirmed.

OPINIONS BELOW

See Petition for Certiorari ("Pet.") at 1. Earlier proceedings in this case are reported at 39 U.S.P.Q.2d 1079 (S.D.N.Y. 1996) (denying West's motions to dismiss) and 37 US.P.Q.2d 1402 (S.D.N.Y. 1995) (granting Bender's motion to file supplemental complaint).

JURISDICTION

See Pet. 1.

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article I, section 8, clause 8 of the United States Constitution provides:

> The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.

Section 101 of the Copyright Act of 1976, 17 U.S.C. § 101, provides:

> "Literary works" are works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied.

Section 103(b) of the Copyright Act of 1976, 17 U.S.C. § 103(b), provides:

> The copyright in a compilation . . . extends only to the material contributed by the author of such work . . . .

STATEMENT OF THE CASE

A. Overview

Bender instituted this declaratory relief suit against West Publishing Co. and West Publishing Corp. (collectively "West"), challenging West's assertion of copyright over information regarding the location of page breaks and the corresponding page numbers that are mechanically inserted into its reports of judicial opinions. HyperLaw, Inc. ("HyperLaw") intervened as a plaintiff and sought a similar declaration. Bender and HyperLaw prevailed both on summary judgment before the Southern District of New York and on West's appeal to the Court of Appeals for the Second Circuit.

The Second Circuit correctly ruled that West has no copyright in the page breaks and pagination inserted into its reporters. As discussed below, that ruling is a watershed in a decades-long struggle waged by West to inhibit competition by asserting a copyright interest in the pagination of its reporters. However, because West previously secured a contrary ruling from the Eighth Circuit, one which was recently followed by the District of Minnesota, there is no guarantee that the Second Circuit ruling will exert nationwide impact. To the contrary, it is likely that, as a practical matter, West will be able to continue to trot out the Eighth Circuit rulings in its favor in order to squelch competition. This case presents an opportunity, perhaps the only opportunity, to set to rest once and for all West's erroneous star pagination copyright claim. Bender therefore respectfully submits that a writ of *certiorari* should issue and that the Second Circuit's decision should be summarily affirmed.

B. The Controversy

Bender is one of this nation's leading publishers of legal secondary literature, including such well-known treatises as *Moore's Federal Practice, Collier On Bankruptcy*, and *Weinstein's Evidence*. Bender now offers most of its secondary literature on CD-ROM under the tradename *Authority from Bender*.

To provide better legal research tools to its users, Bender has begun to bundle collections of judicial opinions with secondary sources in *Authority from Bender*. The first such product—the "New York Product"—combines secondary literature regarding New York practice (*e.g., Weinstein, Korn and Miller CPLR Manual*) with a comprehensive collection of published and unpublished judicial opinions from the state and federal courts in New York that Bender obtained under license from LEXIS-NEXIS. The New York Product is accessed by users via FOLIO software, which enables users to search the primary and secondary materials using words and citation searches. Citations in the opinions and in the secondary literature materials have been "hot linked" so that a user can retrieve the cited text—*e.g.*, an authority relied upon by a judge or treatise author—by placing the cursor over the citation and clicking the mouse. *Matthew Bender & Co. v. West Publ'g Co.*, 158 F.3d 693, 697 (2d Cir. 1998), Pet. App. 6a-7a. West's paper reporters, by contrast, guide research through traditional analytic tools such as syllabi, headnotes, and key number topic designations, features that are lacking in *Authority from Bender*. 158 F.3d at 696, Pet. App. 3a-4a.

Bender's New York Product and West's reporters both contain the uncopyrightable text of judicial opinions authored by federal and state judges. However, the selection and arrangement of opinions in the two products is funda-

mentally dissimilar.[1] Bender has selected for inclusion in the New York Product all the published and unpublished decisions available via LEXIS-NEXIS from the Second Circuit Court of Appeals, the four United States District Courts within the State of New York, the New York Court of Appeals, and the lower courts of the State of New York. It has arranged those opinions by court in strict chronological order without volume divisions. The opinions are stored on the New York Product CD-ROM discs in that order, and that is "also the order in which they would be seen by a user who for some reason browses through the discs without sorting the case reports in a search." 158 F.3d at 697, Pet. App. 6a.[2]

West, by contrast, definitionally has selected for inclusion in its reporters only published opinions and it includes cases from jurisdictions outside New York.[3] West, moreover, does not arrange cases in strict chronological order and divides them by advance sheets and then bound

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[1] The two products arrange the text of each given judicial opinion in an entirely different manner as well. 158 F.3d at 705 n.20, Pet. App. 28a n.20 ("West does not claim that the appearance or layout of the cases on Bender's product reproduces the appearance or layout of West's case reporters. In fact, the layout is quite different.").

[2] West's Petition repeatedly invokes the pretense that Bender's New York product contains a "pre-programmed arrangement" that replicates the arrangement in West's reporters. *See, e.g.*, Pet. 6, 24. That assertion is untrue, as is evident from the undisputed record that Bender's New York Product stores and displays a different arrangement. 158 F.3d 697, Pet. App. 6a.

[3] West's Petition suggests that Bender's New York Product copies West's selection of cases. That assertion is untrue and West failed to raise it below. 158 F.3d at 700 n.11. Pet. App. 14a n.11 ("[T]his opinion will not address any copying by plaintiffs of the *selection* of cases included in West's case reporters. First, West argued below that Bender had copied West's arrangement of cases, not its selection. Second, it is uncontested that plaintiffs' compilations include many more opinions than West's case reporters.") (emphasis original).

volumes. 158 F.3d at 696-97, 700 n.11, 705 n.21. Pet. App. 4a-5a, 14a n.11, 28a n.21.

In sum, the arrangement of cases in Bender's New York Product simply does not copy West's arrangement of cases. 158 F.3d at 702, Pet. App. 19a ("If one browses through [Bender's] CD-ROM discs from beginning to end, using the computer software that reads and sorts it, the sequence of cases owes nothing to West's arrangement.").

For each opinion in the New York Product that is also published in a West reporter, Bender has added citation information—facts about the location of parallel text in West's reporters.[4] At the beginning of the opinion, Bender provides "parallel citations," information about the volume and first page number on which the case appears in the West reporter. For example, Bender would use "158 F.3d 693" as the parallel citation stating where the Second Circuit's opinion in this case begins in West's *Federal Reporter*. In addition, Bender provides information about the location of page breaks and corresponding page numbers within a given judicial opinion via the convention of "star pagination," *e.g.*, Bender would insert "[158 F.3d 696]" at the appropriate location in the opinion to indicate the location of the page break occurring immediately before the page in *Federal Reporter, 3d Series* that contains the text from the Second Circuit's opinion stating: "under a proper reading of the Copyright Act, the insertion of star pagination does not amount to infringement of West's arrangement of cases."

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[4] Providing citation information to a parallel source is a familiar convention of print reporters. For example, West's *Supreme Court Reporter* provides comprehensive parallel citations and star pagination to the *United States Reports*; West's *New York Reporter* provides comprehensive parallel citations and star pagination to Lawyers Cooperative's *New York Reports*; West's *California Reporter* provides comprehensive parallel citations and star pagination to Bancroft Whitney's *California Reports*.

West concedes that Bender's use of parallel citations is a non-infringing fair use. 158 F.3d at 700, Pet. App. 16a ("West concedes that insertion of parallel citations . . . to West's case reporters in plaintiffs' products (as well as any other compilations of judicial opinions) is permissible under the fair use doctrine."). But West claims that Bender's use of star pagination—factual information about the location of the page breaks—infringes West's copyright by allegedly reproducing West's arrangement of cases. 158 F.3d at 695-96, Pet. App. 3a.

Because West's infringement claim rides entirely on star pagination references to numbers corresponding to page breaks, it is critical to appreciate the following:

> West concedes that the pagination of its volumes—*i.e.*, the insertion of page breaks and the assignment of page numbers—is determined by an automatic computer program, and West does not seriously claim that there is anything original or creative in that process. As Judge Martin noted, "where and on what particular pages the text of a court opinion appears does not embody any original creation of the compiler."

158 F.3d at 699, Pet. App. 12a. Star pagination, which conveys factual information about the location of page breaks and corresponding page numbers, in sum, states a fact about an aspect of West's reporters that is even more devoid of "authorship" than the margins that surround the text or the size of the type font on the page.

When Bender commenced production of the New York Product, it possessed an apprehension that it would be sued by West were it to add star pagination to the product. That apprehension was based in part on *West Publishing Co. v. Mead Data Central, Inc.*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070 (1987) (hereinafter, "*West v. Mead*"), a suit in which West sued

Mead Data Central, then owner of LEXIS-NEXIS,[5] for allegedly infringing West's copyright by adding star pagination to cases in the Lexis database. Bender's apprehension also arose from explicit threats of litigation made by West representatives to Bender employees in order to dissuade Bender from using star pagination, and from six other cases West filed between 1988 and 1993 claiming copyright infringement in connection with the use of star pagination. *See Matthew Bender & Co. v. West Publ'g Co.* 39 U.S.P.Q.2d 1079, 1084-85 (S.D.N.Y. 1996). To eliminate the cloud created by West's threats, Bender initiated this suit in 1994 to obtain a declaration that its use and intended use of star pagination to West's reporters would not infringe any West copyright.

C. The Decisions Below

On November 22, 1996, the district court granted Bender's motion for summary judgment on its copyright claim and denied West's cross-motion for summary judgment.

> [Copyright] protection extends only to those aspects of the compilation that embody the original creation of the compiler.[¶] Here, the original creation of West is not in the number of lines in any case, it is not in the number of pages of any case. The original

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[5] LEXIS-NEXIS is now indirectly owned by Reed Elsevier plc, which also recently acquired Bender. In opposition to the Petition, HyperLaw speculates that "the instant Petition may not involve an actual case or controversy between West and Matthew Bender." HyperLaw Brief in Opposition at 12. Without any evidentiary basis, HyperLaw imagines that as a result of the acquisition by Reed Elsevier, Bender "must now modify its position on the copyrightability of pagination," from which it draws "an inference that West and Matthew Bender have reached a partial resolution of the issues in the instant Petition without disclosing it to the Court or the courts below." *Id.* at 14. These baseless speculations about matters not of record are false. As Bender's request for summary affirmance and the arguments herein should make evident, Bender's position on the merits is unchanged and the actual controversy that impelled this lawsuit remains very much alive.

> creation *may be* in the way West selects cases for reporting, the cases that it puts, any headnotes that it adds to the report and similar additional material when put together with the official report that they obtain from the Court.[¶] However, where and on what particular pages of the text of a court opinion appears does not embody any original creation of the compiler, and, therefore in my view, is not entitled to protection.

Matthew Bender & Co. v. West Publ'g Co., 41 U.S.P.Q.2d at 1329-30. Pet. App. 78a-79a (emphasis added).[6]

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[6] West's Petition contains several inaccurate assertions regarding the decision. The court did not assume that "West's original case arrangement is protected by copyright." Pet. 7. Rather, the court assumed *arguendo* that a given volume of *Federal Reporter*—when considered *as a whole*, as opposed to based on arrangement alone—would be entitled to a compilation copyright. The court nowhere specified which elements in the totality of the compilation—headnotes, syllabi, key numbers, on the one hand, or arrangement, on the others—justified its assumption of copyright protection. 41 U.S.P.Q.2d at 1321, Pet. App. 49a ("[F]or the sake of this argument, we can take it [as] assumed that when West puts together a volume of the *Federal Reporter* there is a compilation that is entitled to protection.").

Similarly, the court did not assume that "a photocopy of a West volume would 'violate West's copyright' *by copying its original selection and arrangement*." Pet. 7 (emphasis added). Having made no assumptions about the copyrightability of West's selection and arrangement, the court merely stated that "if Matthew Bender took a volume of F.3d, ran it through its xerox machine or its computer and printed it out and called it Bender's Federal Third Reporter, that would violate West's copyright." 41 U.S.P.Q.2d 1321, Pet. App. 49a-50a. Again, the court merely assumed that the totality of West's work was protected, a proposition that Bender has never contested.

Finally, the court never assumed that Bender's product "can display West's original selection and arrangement with a minimum of user effort." Pet. 7. It was West's counsel, not the Court, that argued that Bender's product could be used to "recreate" a West volume; not even he asserted that this laborious project involved minimal effort, as the record belies any such claim. 41 U.S.P.Q.2d at 1323, Pet. App. 55a; 158 F.3d 696 n.5, Pet. App. 7a n.5.

On November 23, 1998, the Second Circuit affirmed. After reciting the fundamental rule under *Feist Publications, Inc. v. Rural Tel. Service Co.*, 499 U.S. 340 (1991) (hereinafter, "*Feist*"), that "copyright protection in compilations 'may extend only to those components of a work that are original to the author,'" 158 F.3d at 699, Pet. App. 12a, the Second Circuit held:

> Because the internal pagination of West's case reporters does not entail even a modicum of creativity, the volume and page numbers are not original components of West's compilations and are not themselves protected by West's compilation copyright. *See Feist*, 499 U.S. at 363, 111 S. Ct. at 1297 ("As a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimis* quantum of creativity.")[¶] Because the volume and page numbers are unprotected features of West's compilation process, they may be copied without infringing West's copyright.

Id. at 699, Pet. App. 12a-13a.

The Second Circuit found an idependent basis for its holding in the "fundamental distinction under the Copyright Act between an original work of authorship and the physical embodiment of that work in a tangible medium." *Id.* at 699 n.9, Pet. App. 12a n.9. Applying that dichotomy to the facts, it held that page breaks are merely a "feature[] of the physical embodiment of the work" not an "element of West's compilation," and are therefore not subject to copyright protection. *Id.* In other words, it found that the page breaks and corresponding page numbers of West's volumes are not a part of West's *work*, and thus not even potentially the subject of copyright protection, but rather are an accidental feature of the *physical object in which the work has been embodied.*

The Second Circuit considered and rejected West's argument that the embedding of star pagination in Bender's New

York Product enables a user to "perceive" West's arrangement through the aid of a machine and that this amounts to creating a "copy" of West's reporters under 17 U.S.C. § 101's definition of "copies." The court observed that the "sole purpose of § 101's definition of the words 'copies' and 'fixed' is to explicate the 'fixation requirement,' *i.e.*, to define the material objects in which copyrightable and infringing works may be embedded and to describe the requisite fixed nature of that work within the material object." *Id.* at 702, Pet. App. 21a. It noted that the definition was crafted to overrule the effect of *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U.S. 1 (1908), which held that a piano roll was not a "copy" of the music it embodied because the perforations in which the music was fixed were unintelligible to the human eye. Section 101's definition clarified that the fixation requirement is met by objects embodying works capable of being perceived with a machine. *Id.* at 703, Pet. App. 23a.

Th Second Circuit held that under Section 101's definition of "copies," Bender's New York Product was a "copy," but of "the (non-West) sequence that is embedded on [its] CD-ROM discs and that appears with the aid of a machine without manipulation of the data," *i.e.*, a strictly by-court chronological arrangement. *Id.* at 703, Pet. App. 24a. Comparing the allegedly infringing "copy" embodied in Bender's New York Product with West's allegedly infringed reporters, the Second Circuit determined that no "substantial similarity" existed:

> West's case reporters contain many fewer cases than plaintiffs' CD-ROM discs, and are arranged according to classification such as court, date, and genre (opinions, per curiam opinions, orders, etc.), subject to certain exceptions characterized by West as features of originality, whereas plaintiffs organize their cases simply by court and date. Comparison of the works reveals that the cases that appear adjacent in

> the West case reporters are separated on plaintiffs' products by many other cases; and even if these other cases are disregarded, the West cases included on plaintiffs' products are not in an order at all resembling West's arrangement.

Id. at 705, Pet. App. 28a.

The Second Circuit rejected West's interpretation of § 101's definition of "copies" because it would mean that a given CR-ROM is a "copy" of "all arrangements and *re*-arrangements that could be made by a third-party user who manipulates the data [in it] on his or her own initiative." 158 F.3d at 703, Pet. App. 24a (emphasis original). The Second Circuit observed that West could "cite no case supporting its interpretation of § 101's definition of 'copies,' and every case we have found has relied upon the definition solely to ascertain whether a work has met the fixation requirement, not to determine the arrangements and rearrangements of the work fixed on the material object." *Id.* at 704, Pet. App. 24a-25a.

The Second Circuit further found that even if, *arguendo*, one accepted West's interpretation of "copies," there was no infringement because West admitted both (i) Bender's insertion of parallel citations is a non-infringing fair use; and (ii) using parallel citations alone, a user of Bender's product could create a lawful copy of West's arrangement as West defines "copies." The only incremental data perceivable through star pagination are facts about the locations of page breaks, which are not part of West's arrangement, do not constitute original expression, and which therefore may be lawfully copied. *Id.* at 701, Pet. App. 16a-18a.

Judge Sweet, sitting by designation, dissented. In his view, the Second Circuit should have followed the reasoning of the Eighth Circuit in *West v. Mead* and *Oasis Publishing Co.*, 924 F. Supp. 918 (D. Minn. 1996) (hereinafter, "*Oasis*"). 158 F.3d at 708, Pet. App. 38a.

ARGUMENT

I. THE WRIT SHOULD BE GRANTED AND THE DECISION BELOW SUMMARILY AFFIRMED SO THAT WEST CAN NO LONGER CLAIM A "SCARECROW" COPYRIGHT IN PAGINATION ANYWHERE IN THE UNITED STATES

A. Overview

Bender agrees that this case of national importance merits granting the writ of *certiorari*. Bender disagrees with West, however, not only about the merits—the Second Circuit opinion deserves summary affirmance—but also regarding what makes this case worthy of *certiorari*.

This case concerns whether using star pagination to parallel sources of judicial opinions constitutes copyright infringement. The proper resolution of this question is of vital interest to the bench, bar and public. Indeed, it is an issue of sufficient import that it has repeatedly and consistently attracted the efforts of the United States—through proposed amendments to the Copyright Act, antitrust litigation, and *amicus* participation in star pagination litigation—to bring about nationally the result reached below in the Second Circuit. *United States v. Thomson*, 949 F. Supp. 907, 925 (D D.C. 1996) ("The United States has consistently maintained that the use by others of star pagination does not constitute copyright infringement."). *See* Section I.C *infra*.

To appreciate the importance of star pagination, and the destructive effect wrought by West's copyright claim, one need only reflect how deeply citations to West's reporters are embedded in our legal practice. They form part of the fundamental grammar by which we communicate about law. *Cf.* Gary Wolf, *Who Owns the Law?*, 2.Q5 Wired Magazine 98, 138 (May 1994), available at http://www.wired.com/wired/archive/2.05/the.law.html ("Citations fulfill an intrastructural role in legal circles which is simi-

lar to that of currency in a modern society. . . . Just as the currency system allows financial transactions to occur, so the system for citing law materials facilitates information exchanges.") (citation omitted). Judicial opinions, secondary literature and attorney work product overflow with references to judicial text in the form of citations to West's reporters. Simply put, that is how judicial authority is cited. For a copy of an opinion to be citable in that form —as law, custom and practice demand—it is imperative for it to contain information concerning which volume, and on what pages, the opinion is located in West's reporters. *Id.* at 138 ("Any publisher is free to compile collections of federal decisions, but without citable page numbers these collections are little more than worthless."). *See* Section I.B.1, *infra.*

Because of the critical importance of citation information, West has asserted a copyright interest in its pagination for the purpose of preventing others from disseminating judicial opinions in a citable form. As the district court stated: "What West is attempting to do by trying to inhibit star pagination is to create a monopoly over reported court decisions." 41 U.S.P.Q. at 1330, Pet. App. 79a. Armed with its Eighth Circuit victory in *West v. Mead* under the "sweat of the brow" doctrine, in its continued claim of copyright after *Feist,* and its massive litigation resources, West has succeed in using its claim of star pagination copyright to chill the development of legal publishing. *See United States v. Thomson*, 949 F. Supp. 907, 925 (D.D.C. 1996) ("As reflected throughout its complaint, the government was concerned that West's copyright claim and its refusal to issue any licenses would impede entry into the markets affected by the merger [between West and Thomson], particularly emerging electronic forms of enhanced primary law and secondary law products."); *see also* Testimony of Kathryn Downing, President & COO Thomson Electronic Publishing, Subcommittee on Intellectual Property, *Hearings on H.R.*

4426, Serial No. 105, at 92 (May 14, 1992) (hereinafter "*Hearings*") (*West v. Mead* "has made it commercially impossible for Thomson or anyone else to publish, with page number citations, the decisions of the lower federal courts."); [7] *Who Owns the Law?, supra* at 138 ("West's provisional victory in [*West v. Mead*] has kept other electronic publishers at bay."); *Matthew Bender Takes On West Publishing's Copyright*, 2 Information Alert, Vol. 2 (February 11, 1994) ("It seems so silly—almost a joke —the notion that a company can hold monopoly control over such items as page numbers. But don't ever tell that to West Publishing Co. West takes very seriously, even religiously, its copyright on its federal reporters, including the page numbers."); Susan Hansen, *Fending Off the Future*, American Lawyer 74, 75 (September 1994) ("West's lawyers have earned a reputation for menacing letters and quick-strike lawsuits, hunting down infringers from coast to coast. One by one, 'copyists' as [West's president] likes to call them, have been marched into court and crushed."). *See* Section I.B.2, *infra.*

The Second Circuit has dubbed a dubious intellectual property right used to menace competitors a "scarecrow." *See Wembley, Inc. v. Superba Cravats, Inc.*, 315 F.2d 87, 98 (2d Cir. 1963). Through this case, Bender has attempted to reveal West's pagination claim for what is—a "scarecrow" copyright that, on examination, is baseless. The ruling below takes an imporant step towards eradicating West's pernicious "scarecrow" copyright claim. But if this Court declines to review the Second Circuit's decision, West will be able to continue to use *West v. Mead* coupled with artful litigation tactics to intimidate legal publishers from disseminating citable judicial opinions. The losers

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[7] Thomson subsequently acquired West. Apparently, it simultaneously acquired West's views on star pagination. *See* Vera Titunik, *That Was Then, This Is Now*, American Lawyer 21 (April 1996) (quoting Thomson's general counsel Michael Harris as saying "We believe star pagination is copyrightable.").

under that senario would be the public, the intended beneficiaries of copyright law. Legal publishers (other than Bender and HyperLaw) would continue to face the Hobson's choice of paying West fees for the right to copy what is in the public domain or facing costly and protracted litigation against West—potentially in the Eighth Circuit, where West has successfully parlayed its star pagination claims into something approximating post-*Feist* enforceability. *See* Section I.B.2(b), *infra.*

Only by affirming the Second Circuit's ruling now can this Court eliminate the *in terrorem* effect of West's "scarecrow" copyright claim. By granting *certiorari* and affirming the decision below, this Court will terminate, once and for all, West's assertion of a baseless (and highly anti-competitive) copyright claim by drawing the correct line between copyright and an endangered free market in the judicial opinions that constitute the law of the land.

B. Review Is Needed To Create Clear National Uniformity Regarding The Copyrightability Of Star Pagination

1. *The Importance Of Star Pagination*

Citations to West's reporters[8] are ubiquitious in the state and federal *corpus juris*, submissions to the courts, and the vast secondary literature about our laws. Information about the location of page breaks in West reporters

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[8] West has long been this nation's dominant publisher of judicial opinions of the federal and state courts. Its federal reporters, which are the only comprehensive collection of published decisions of the U.S. district courts and the courts of appeals in book form, are the *de facto* official reporters of the lower courts. *See, e.g.*, 1 F. Cas. iii (1894) (West refers to itself as "the official Reporter of the Federal Courts."); L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 U.C.L.A. L. Rev. 719, 727, n.21 (1989) ("As to the federal judiciary, West operates as the functional equivalent of an official reporter for all courts below the Supreme Court.") (citing numerous local rules).

has thus become a standard frame of reference for discussion, debate and advocacy about the law of this country. 158 F.3d at 696, Pet. App. 4a-5a ("universally cited by the volume and page number of the case reporter series in which they appear"). In fact, many courts mandate, whether through local rules or judges' individual rules of practice, that citations in briefs be to the apropriate volume and page number of West's reporters. *See, e.g.*, Third Cir. R. 28.3(a); Eleventh Cir. R. 28-2(k). Legal citation manuals similarly require citation to West's reporters. *See, e.g., The Bluebook: A Uniform System of Citation* 165-67 (16th ed. 1997).

When a copy of a judicial opinion is published in a non-West source whose publisher wishes to be linked to the vast web of citations to West's reporters,[9] that copy of the judicial opinion must include parallel citations and star pagination. Absent these capabilities, that copy of the judicial opinion will be unusuable to generate citations in proper form or to evaluate the authority cited by others.

2. *West's "Scarecrow" Copyright In The Eighth Circuit*

From the foregoing considerations, there can be no doubt of the necessity for citations to West reporters, and the necessity of including them in copies of opinions if the publisher of those copies has any hope to make them usable. The opinion below secures that right to Bender and HyperLaw. Nonetheless, West's "scarecrow" copyright exerts continued vitality.

The source of this mischief is the Eighth Circuit's pre-*Feist* ruling, via a divided panel, in *West v. Mead*. With-

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9 West is now part of West Group, a division of The Thomson Corporation. West Group also includes, *inter alia*, Lawyers Co-operative Publishing Company, Bancroft-Whitney Company, Banks-Baldwin, Clark Boardman Callaghan. West Group publishers are responsible for publishing many states' (e.g., California and New York) "official" reporters. *See* About West Group, http://www.westgroup.com/newsinfo./aboutwg/Welcome.html

out question, the Second Circuit majority reached a ruling below at odds with that case. However, as developed below, West mischaracterizes the legal import of this doctrinal clash as a "paradigmatic" circuit split, and petitons for *certiorari* on that basis. Although West overstates the extent to which a circuit split exists as a matter of law, it must be acknowledged that West's ability to make continued headway against other publishers based on *West v. Mead* has, *as a practical matter*, the same real-world impact of a split. West's potential offensive use of *West v. Mead* continues to stifle competiton and deform copyright doctrine in a way that demands redress from this Court.

(a) *The Nature Of The Conflict*

West is wrong to posit a true circuit split. *West v. Mead* reviewed the grant of a preliminary injunction on a record devoid of evidence as to whether West's pagination "is nothing more than an electronic response to a direction given a machine or whether, as a mater of fact, West's new pagination may be considered an original work of authorship." *West v. Mead*, 799 F.2d at 1237 (Oliver, J., dissenting).[10] Its holding was tentative. 799 F.2d at 1229 ("our observations as to the governing law made in this opinion[] are tentative and provisional, in the sense that different findings or conclusions might be warranted after a trial on the merits.") (internal quotations omitted); *see also University of Texas v. Camenisch*, 451 U.S. 390, 395 (1981) ("the findings of fact and conclusions of law made by a court granting a preliminary injunction are not binding at trial on the merits."). Accordingly, *West v. Mead* does not carry the same precedential weight as an appellate panel review of a final judgment—such as this

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10 This case resolved that critical question: "West concedes that the pagination of its volumes—i.e., the insertion of page breaks and the assignment of page numbers—is determined by an automatic computer program, and West does not seriously claim that there is anything original or creative in that process." 158 F.3d at 699, **Pet. App. 12a.**

case—and therefore does not create a full-blown circuit split.[11]

(b) *The Continued Specter Of* West v. Mead

The Second Circuit rightly condemned *West v. Mead* as bad law after this Court's *Feist* decision unanimously abolished the "sweat of the brow" line of authorities pursuant to which *West v. Mead* had extended copyright to pagination. *See* 158 F.3d at 708, Pet. App. 36a ("At bottom, *West Publishing Co.* [*v. Mead*] rests upon the now defunct 'sweat of the brow' doctrine."); *see also United States v. Thomson*, 949 F.Supp. at 926 ("this Court has serious doubts about the continuing vitality of the Eighth Circuit's 1986 opinion in *Mead Data* in view of the subsequent decision of the Supreme Court in *Feist*.").

Critics of *West v. Mead* have included the United States, which has particpated as *amicus curiae* in this case and in *Oasis*, the Register of Copyrights, who is the senior official of the United States government charged with the formulation of copyright policy, and copyright scholars. *See* Brief for Amicus Curiae United States in Support of Appellees at 5, available at http://www.usdoj.gov/atr/cases/fl100/1191.htm ("*Mead* itself has been fatally undermined by *Feist*. *Mead's* conclusion regarding copying rests on the 'sweat of the brow' theory of compilation copyright, which *Feist* squarely rejected."); Testimony of Ralph Oman, Register of Copyrights, *Hearings* at 6

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[11] Before the Eighth Circuit, West itself acknowledged as much in its appeal of *Oasis:* "West did not argue in the Court below that [the Eighth Circuit's] decision in *West v. Mead*, which arose on an appeal from entry of a preliminary injunction, was binding on the District Court." Appellee West Publishing Company's Brief at 6, *Oasis Publ'g Co v. West Publ'g Co.*, No. 96-2887 (8th Cir., filed October 8, 1996). Were it not for the limited precedential nature of *West v. Mead*, that case would have been binding not only on the *Oasis* district court, but on the Eighth Circuit too. *See Ramsey v. Bowersox*, 149 F.3d 749, 760 (8th Cir. 1998) ("One panel of this court is bound by the decisions of other panels.").

("*Mead* . . . was a substantial departure from existing precedent. . . . Even if the eighth circuit's decision were consistent with existing law, *Feist* tolled the death knell for creations based exclusively on sweat-of-the-brow instead of on originality."), 1 Melville Nimmer & David Nimmer, *Nimmer on Copyright* § 3.03 (1999) (*West v. Mead* "extends compilation copyright too far."); 1 William F. Patry, *Copyright Law and Practice* 660 n.595 (1994) (*West v. Mead* "was bad law before *Feist*, . . . and in light of *Feist*, which firmly established originality and infringement of expression as the bases of copyright, it should no longer be cited as precedent even in the Eighth Circuit."); 1 Neil Boorstyn, *Boorstyn on Copyright* § 2.16[1] (1999) ("*Mead* protected West's page numbers because West spent so much labor and industry in compiling them. The Supreme Court has effectively overruled *Mead* on this point."); L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 U.C.L.A. L. Rev. 719, 813 (1989) (*West v. Mead* was "wrongly decided in terms of the copyright clause of the Constitution, the case law, and the Copyright Act of 1976."); [12] *see also* Arthur R. Miller, *Copyright Protection for Computer Programs, Databases, and Computer-Generated Works: Is Anything New Since CONTU?*, 106 Harv. L. Rev. 978, 1041 n.284 (1993) ("*Feist* raises questions concerning the continued viability of such cases *West Publishing Co. v. Mead Data Central, Inc.*, . . . which held that star pagination was copyrightable.").

Notwithstanding the tentative nature of *West v. Mead* and the blistering criticism it has drawn, the opinion has continued to enjoy post-*Feist* vitality in the Eighth Circuit. A district judge in Minnesota recently followed it stating,

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[12] This Court in *Feist* favorably cites six times to the Patterson and Joyce article, which is a 150-page critique of *West v. Mead*. 499 U.S. at 347, 348-49, 351, 361-62.

"*Feist* did not overrule *Mead*." *Oasis*, 924 F.Supp. at 923; *see also* 158 F.3d at 711, Pet. App. 44a (Sweet, J., dissenting) ("I subscribe to [the *Oasis* court's] view of the interrelationship between *West* [*v. Mead*] and *Feist*."). If, as seems reasonably likely, other district courts in the Eighth Circuit follow the lead of *Oasis*, West will be able to continue to perpetuate *West v. Mead* by litigating its "scarecrow" copyright in the Eighth Circuit, and settling (or mooting) after obtaining favorable lower court rulings.[13] By so doing, West will be able to deny the Eighth Circuit the opportunity to reexamine *West v. Mead* and West will thereby extend its "scarecrow" copyright claim.

In sum, a split of authority now exists as a practical matter. Through selective enforcement of its copyright

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[13] It is precisely this strategy that West followed in *Oasis*. Oasis Publishing brought a declaratory judgment action against West in the Southern District of Florida. West moved to dismiss for lack of a justiciable controversy, and moved in the alternative to transfer the case to the District of Minnesota. West's motion to dismiss was not ruled on, but its motion to transfer was granted. Once in Minnesota, West dropped its jurisdictional argument. *Oasis*, 924 F. Supp. at 921. Then, after achieving a district court decision endorsing the continued vitality of *West v. Mead*, West settled the case, paying the loser, Oasis Publishing, attorney's fees and granting Oasis a star pagination "license." West thereby effectively preserved the favorable result it had obtained and prevented the Eighth Circuit from reevaluating *West v. Mead* in light of *Feist*.

As a related strategy, West attempted to avoid the Second Circuit's jurisdiction in this case. It asserted in an early filing that there was no personal jurisdiction over West in the Southern District of New York because West was not doing business there. West subsequently attempted to moot the controversy before summary judgment by promising not to sue Bender for the initial version of the New York Product. West was unwilling, however, to represent that it would not sue Bender over subsequent versions (including the existing second version), and the court rejected West's mootness gambit. *See* 39 U.S.P.Q.2d 1079, 1086 (1996). West also moved unsuccessfully to dismiss the case for alleged lack of a justiciable controversy, claiming that Bender did not have the intent or ability to manufacture (the now commercialy available) New York Product or possess a reasonable apprehension that West would sue Bender for adding star pagination to it. *See id.* at 1084-85.

and strategic settlements, West has in the past and will in the future be able to insulate a bad Eighth Circuit ruling from correction. The upshot is to leave all parties other than Bender and HyperLaw vulnerable to West's litigation juggernaut.

C. This Case Furnishes The Appropriate Vehicle To Vindicate The Repeated Efforts By The United States To Make Star Pagination Available To All

For many years, the officials of the United States entrusted with refining and enforcing our nation's copyright and antitrust laws have endeavored to overcome *West v. Mead* and to put an end to the ill effects caused by West's fantastic claim of copyright protection in the pagination of its reporters. In other words, the United States has labored consistently to ensure, in effect, that the result in this case becomes the law of the land. A grant of *certiorari* and affirmance constitute the only means at present to bring those efforts to fruition.

1. *The Copyright Office's Efforts To Amend The Copyright Act To Clarify That Star Pagination Is Not An Infringement*

The first attempt by the United States to right the wrong inflicted by *West v. Mead* took place in 1992, when the United States Copyright Office supported a bill to amend the Copyright Act to clarify that citation information is not protected by copyright.[14] The Register of Copyrights explained the Copyright Office's support for the legislation:

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[14] Ironically, the bill was introduced through the efforts of The Thomson Corp., West's current owner, whose representative then testified that the legislation was necessary to "overrule the West [v. Mead] decision and enable Thomson and others to publish . . . primary legal texts." *Hearings* at 91. West attacked the bill as a foreign plot. *See* Prepared Statement of Vance Opperman, *id.* at 159 ("Perhaps more disturbing is the motive of the primary proponent of H.R. 4426, Lord Thomson and his foreign-based Thomson conglomerate. We have all witnessed past efforts by foreign firms, acting under the guise of the U.S. subsidiaries they have

> [The] bill would clarify that public domain elements like case names, numbers, citations, and volume and page numbers are meant to be freely accessible and not subject to proprietary rights that might inhibit commercial copying. The Copyright Office supports the general principle of this bill that copyright should not be available to protect these elements.
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> * * * *
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> The *Mead Data* decision was a substantial departure from existing precedent. The court applied equitable and sweat-of-the-brow considerations and some inherent notions of unfair competition relief to give protection against copying. . . . Even if the eighth circuit's decision were consistent with existing law, *Feist* tolled the death knell for creations based exclusively on sweat-of-the-brow instead of on originality. The Constitution requires an element of originality before copyright protection will kick in.

Hearings at 6. As evidenced by the instant suit, that bill never passed the full Congress.[15]

2. *Antitrust Enforcement Efforts To Force West To Make Star Pagination Available To All*

The United States, together with seven states, filed an antitrust suit challenging The Thomson Corp.'s acquisition of West. The complaint in that case identified West's "scarecrow" copyright claim as an improper barrier to competition:

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bought up, to alter or dismantle fundamental American laws for their own profit and at the expense of American jobs and prosperity.").

[15] Efforts against it were spearheaded by West and Rep. James Ramstad, the Minnesota Congressman who represents the district in which West is headquartered. *See* Testimony of James Ramstad. *Hearings* at 5 ("The legislation being considered today represents an effort by one of the largest and most powerful foreign conglomerates in the world, led by an English lord, to win in the U.S. Congress what it knows it cannot win in the courts.").

> West claims that a copyright is infringed by use of what is commonly referred to as "star pagination," the insertion of symbols in the text of decisions to indicate where internal page breaks are in West's National Reporters System, and the placement nearby of the corresponding West reporter's page number. West has granted few, if any, licenses to employ star pagination to anyone other than Lexis-Nexis. Thus, existing or potential participants in the markets for primary law products cannot offer products with star pagination without the threat of costly infringement litigation. Because citations to the National Reporter System are commonly required or expected by courts, and thus sought by users, West's copyright claim chills potential entry into these markets.

Complaint For Injunctive Relief, *United States v. Thomson Corp.*, No. 96-1415 (PLF) at ¶ 32, available at http://www.usdoj.gov/atr/cases/f0700/7.30.htm; *see also id.* at ¶43 ("Particularly for CD-ROM products, where it is possible to include both primary and secondary law products on the same CD-ROM, the ability to include star pagination is an important competitive factor.").

To settle the case, Thomson and West offered to make available a form license for star pagination. Several aspects of this arrangements troubled the court, not the least of which was that the very fact of including a star pagination "license" in the Final Judgment could be construed "as an endorsement of West's dubious copyright claim." *United States v. Thomson*, 949 F.Supp. 907. To disabuse the public of that notion, the United States added disclaimer language to the Final Judgment. *Id.* at 907 n.19.

The court also found unacceptable that West included in the original form license a provision pursuant to which anyone taking out the license had to agree that it would never challenge West's "scarecrow" copyright in pagination. Only when the court let it be known that no Final Judgment in such an overreaching form would bear its

imprimatur did West accede to the elimination of that Faustian clause. 949 F. Supp. 929 n.20.

Finally, the Court found troubling the fact that West would be able "to profit from its dubious copyright claim while maintaining by court order significant barriers to entry into the relevant markets identified in the complaint by smaller publishers, particularly in the CD-ROM market." *Id.* at 929. Finding that charging license fees for star pagination lay "beyond the reaches of the public interest," *id.* (citation omitted), the court suggested a remedy whereby West would agree to provide "a free license to all who requested one until West's copyright claim is judicially resolved once and for all." *Id.*

In response to the court's ruling, West and Thomson proposed an alternative licensing scheme pursuant to which all fees for star pagination "would be deferred until either a 'final judicial determination' of the merits of West's copyright claim has been made or December 31, 2000, whichever comes first." *United States v. Thomson,* 42 U.S.P.Q.2d 1867, 1869 (D.D.C. 1997). The court, in adopting that proposal, stated that "a final judicial determination is a Supreme Court decision on the merits. A denial of certiorari would not constiute a final determination. Nor would a majority or, even unanimity, in the circuits constitute such a determination." *Id.* at 1870.

Crucially for this Petition, the court ruled that only when the Supreme Court invalidated West's star pagination copyright claim—the very oportunity presented by this case—would the subject license fees be eliminated from the form license that the United States had negotiated with West to protect the public interest. Because the court thought that Supreme Court review of this case was a "likelihood," 949 F.Supp. at 907, and West's claim "dubious," *id.* it deemed deferred fees, that would ultimately be waived, an acceptable compromise.

3. *The United States'* Amicus *Participation In Star Pagination Cases In Favor Of Bender's Position*

It is unusual for the United States to participate as an *amicus curiae* in a copyright dispute between private parties at the appellate stage, much less while the case is still pending before a trial court. However, because the issues in this case are of signal importance to maintaining the proper equilibrium of our nation's intellectual property laws, the United States submitted *amicus* briefs in support of Bender's position before both courts below.[16] As it stated to the Second Circuit,

> The United States, which filed an amicus brief below, has a substantial interest in the resolution of the appeal. It has numerous responsibilities related to the proper administration of the intellectual property laws, as well as primary responsibility for enforcing the antitrust laws, which establish a national policy favoring economic competition. Accordingly, the United States has an interest in properly maintaining the "delicate equilibrium," . . . Congress established through the copyright law between protecting private ownership of expression as an incentive for creativity and enabling the free use of basic building blocks for future creativity.

Brief for Amicus Curiae United States of America in Support of Appellees at 1-2, available at http://www.usdoj.gov/atr/cases/fl100/1191.htm. Granting *certiorari* and summary affirmance present the oportunity to ensure that the United States' goal of maintaining copyright's "delicate equilibrium" will be realized for all. *Cf. generally* David Nimmer, Elliot Brown & Gary N. Frischling, *The Metamorphosis of Contract Into Expand*. 87 Cal. L. Rev. 17 (1999) (critiquing attempts to subvert via con-

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[16] The United States also filed an amicus brief in the appeal of *Oasis* advancing the same arguments as in this case. That brief is available at http://www.usdoj.gov/atr/cases/f0800/0860.htm.

tract the "delicate balance" set by the Supreme Court's copyright jurisprudence).

II. THERE IS NO NEED TO GRANT THE WRIT TO EXPLICATE THE COPYRIGHT ACT'S DEFINITION OF "COPIES" OR TO PROTECT WORKS FIXED IN CD-ROMS

Although this case presents issues of vital importance, West misleads when it suggests that this case poses "one of the most important copyright issues of the information era" and threatens to provide "would-be infringers of copyrighted compilations with complete insulation against liability, so long as they make their copy available digitally." Pet. 4. In truth, this case does not turn on "the nature of CD-ROM technology," Pet. 5, or involve "computer age 'loopholes' for infringers," Pet. 18. Nor does it have special implications for "electronic media," Pet. 4, "[c]omputers and other new telecommunications technologies," *id.* or "the ever-expanding universe of data." *Id.* We may be standing on the "brink of a new millenium," Pet. 4, but West's rhetoric aside, the questions that this case presents arise, and indeed have been litigated since the 19th Century, in the quintesentially low-tech posture of compilations of judicial opinions bound in books. *See Callaghan v. Myers,* 128 U.S. 617, 661-62 (1888) ("the paging of the book may depend simply on the will of the printer, of the reporter, or publisher, or the order in which the cases have been decided, or upon other accidental circumstances. . . . [T]he paging of the volumes is a labor inconsiderable in itself, and I regard it, not as an independent matter") (quoting *Myers v. Callaghan,* 20 F. 441, 442 (C.C.N.D. Ill. 1883);[17] *Banks Law Publ'g Co. v.*

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[17] Earlier in its analysis, the Court adverted in dicta to "the order of arrangement of the cases, the division of the reports into volumes, the numbering and paging of the volumes" as parts of the volume over which protection may potentially subsist. *Id.* at 649, 661. As scholarly commentary has noted, that "fleeting observation"

Lawyers' Co-operative Publ'g Co., 169 F. 386, 391 (2d Cir. 1909), *app. dismissed*, 223 U.S. 738 (1911) ("the arrangement of reported cases in sequence, *their paging* and distribution into volumes, are not features of such importance as to entitle the reporter to copyright protection of such details.") (emphasis added); *Eggers v. Sun Sales Corp.*, 263 F. 373, 375 (2d Cir. 1920) ("identity of pagination" in reprint of preexisting pubic domain materials "is not of sufficient importance to constitute infringement of copyright.").

The centerpiece of West's attempt to posture this case as being about electronic media is its eroneous interpretation and application of the statutory definition of "copies" in 17 U.S.C. § 101. As the Second Circuit noted, West's attempted use of the definition of "copies" is an unprecedented misreading of the language and purpose of that provision, one that ignores the provision's historical genesis. 158 F.3d at 703-4, Pet. App. 24a-26a.

The origin of Section 101's definition of copies is found in *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U.S. 1 (1908), which held that a piano roll did not constitute a "copy" of the musical composition encoded into it, and that therefore the unauthorized manufacture of that piano roll did not infringe on plaintiff's "right to copy." For most of this century, that precedent meant that a work on which a subject composition was not visually perceivable did not infringe. *See* 1 *Nimmer on Copyright* § 2.03[B][1].

In 1976, Congress definitively rejected that case. *Id.* It did so by defining "copies" as "material objects . . . in which a work is fixed by any method now known or later developed, and from which the work can be perceived, re-

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is "contradicted by other aspects of the Court's opinion . . . ." Patterson & Joyce, 36 U.C.L.A. L. Rev. at 744. West's argument that Second Circuit's ruling is in conflict with *Callaghan* is accordingly incorrect.

produced, or otherwise communicated, either directly or with the aid of a machine or device." 17 U.S.C. § 101. Congress thereby repudiated "the artificial and largely unjustified distinctions, derived from such cases as *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U.S. 1 (1908)." S. Rep. No. 94-473, at 51 (1975): H.R. Rep. No. 94-1476, at 52 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5665 (1976).

In a legal universe governed by *White-Smith v. Apollo*, although it would constitute copyright infringement to make a photocopy of the entirety of the bound volumes of West's reporters, making an electronic copy of the entirety of those volumes (on CD-ROMs for example) would be non-actionable. By contrast, the 1976 Act mandates a different result. Under the current law, it is equally forbidden to reproduce the whole of a copyrighted work, whether in visually perceivable form (such as via a photocopy machine) or in machine-readable form (such as on a CD-ROM).[18] Thus, the claim that "West's original arrangements . . . have been denied protection from electronic copying," Pet. 5, is flatly wrong. If a copyrighted work is copied electronically, infringement liability follows. Nothing in the decison below casts the slightest doubt on that construction.[19]

Once the congruence under current law between literary works as embodied in CD-ROMs and as embodied in

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[18] Given the breadth of the definition of "copies" in 17 U.S.C. § 101, all but the most exotic examples of physical embodiment are now actionable under the Copyright Act. *See* 2 *Nimmer on Copyright* § 8.02[B][2] (writing in the sand before the oncoming tide too evanescent to satisfy statutory requirement of being "fixed"); Brandriss, *Writing in Frost on a Window Pane: E-Mail and Chatting on RAM and Copyright Fixation*, 43 J. Copyright Soc'y 237 (1996) (adducing example of writing in the frost that forms on a window pane).

[19] There is, accordingly, no substance to the charge that the Second Circuit failed "to reconcile CD-ROM technology with the 1976 Copyright Act." Pet. 9.

printed books is appreciated, West's attempt to posture this case as raising unprecedented technological issues collapses of its own weight. It is uncontested that the CD-ROMs that Bender produces are material objects that constitute a "copy" no less than do bound volumes. It is uncontested that an arrangement fixed in a CD-ROM could be substantially simlar to, and infringe, an arrangement protected by copyright that has been fixed in a book. But the arrangement that is "fixed" in Bender's New York Product is simply not the arrangement in West's reporters. Bender has no more "programmed [its] CD-ROMs so that a user can readily display all the cases from the West volume in the precise order—case by case, page by page—that they appear in West's bound volumes," Pet. 17, than have purveyors of bound books for the last century that include parallel citations. A customer who purchases a bound volume (*e.g.*, from West) into which the publisher has inserted parallel citations (even without star pagination) can, if so inclined, choose to read therein the cases in the exact order in which they are featured in the rival set referenced by the parallel citations.[20] The ruling below applies as directly to this potential use of books as it does to the potential use of electronic media.

CONCLUSION

Copyright protects works of original expression created by authors. The location of page breaks, and the corresponding page numbers in West reporters, are not original expression created by an author. Indeed, they do not even comprise an element of West's literary works, but

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[20] As noted above, West has long included star pagination and parallel citations to rival sources. *See* n.4 *supra*. Thus, a reader of any volume of *Supreme Court Reporter* could use that volume alone, by accessing its index and flipping its pages, to review all of the opinions contained in a parallel volume of the rival *Lawyer's Edition* compilation of Supreme Court decisions, *in the order in which Lawyer's Edition presented them.*

are instead accidental features of the tangible objects in which West has fixed its compilations. Star pagination references to those page breaks and their corresponding page numbers do not copy any element of West's works, much less an original, copyrighted element.

West has effectively used the *West v. Mead* decision and its progeny as a "scarecrow" to dissuade others from offering judicial opinons with star pagination references. As evidenced by the failed efforts to enact H.R. 4426, this problem is unlikely to be solved by legislation. As is evident from West's settlement of *Oasis*, it is unlikely that West will ever let the Eighth Circuit reexamine *West v. Mead* in light of *Feist*. Based on the United States' antitrust suit against West, a judical finding already exists that the public interest in avoiding onerous license fees for having access to unprotected materials awaits Supreme Court resolution. This case presents the one likely opportunity to create clear, uniform, nationwide law that citation information is not subject to copyright protection. Accordingly, Bender respectfully requests that *certiorari* be granted and that the Second Circuit's ruling be summarily affirmed.

Respectfuly submitted,

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Dated: April 29, 1999

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APR 16 1999

(4)

No. 98-1500

In The
Supreme Court of the United States

October Term, 1998

WEST PUBLISHING CO. and
WEST PUBLISHING CORP.,
Petitioners,

v.

MATTHEW BENDER & COMPANY, INC. and
HYPERLAW, INC.,
Respondents.

ON PETITION FOR WRIT OF *CERTIORARI*
TO THE UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

MOTION FOR PERMISSION TO FILE *AMICUS CURIAE* OPPOSITION TO PETITION FOR *CERTIORARI* and OPPOSITION TO PETITION FOR *CERTIORARI* BY *AMICUS CURIAE* MALLA POLLACK, SUPPORTING RESPONDENTS

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14 pp

MOTION FOR PERMISSION TO FILE *AMICUS* OPPOSITION TO PETITION FOR *CERTIORARI*

Malla Pollack ("Pollack") respectfully moves this Court for permission to file the attached *Opposition to the Petition for Certiorari* in No. 98-1500, *West Publishing Co. and West Publishing Corp. v. Matthew Bender & Company, Inc. and Hyperlaw, Inc.* Pollack supports Respondents, Matthew Bender Company, Inc. and Hyperlaw, Inc. Pollack has received permission to file from Carl J. Hartman, counsel for Hyperlaw, Inc., and from Elliot Brown (Irell & Madella LLP), counsel for Matthew Bender & Company, Inc. James F. Rittinger (Satterlee Stephens Burke & Burke LLP), Counsel for Petitioners, has refused permission on the sole ground that my "request does not identify what relevant matter [my] opposition would bring to the attention of the Court." (Facsimile letter from Rittinger to Pollack of April 8, 1999 at 1).

INTEREST OF THE *AMICUS CURIAE*

Amicus curiae Pollack wishes to submit the attached *Opposition to Petition for Certiorari* solely to help protect the beleaguered public domain. *Cf.* David Lange, *Recognizing the Public Domain*, 44 (No. 4) Law & Contemp. Probs. 147, 176 (1981) (suggesting that in intellectual property cases the courts should "solicit and welcome amicus participation" or appoint *guardians ad litem* for the public domain). Pollack is an Associate Professor of Law who has authored articles on the interaction of the Intellectual Property Clause of the United States Constitution, U.S. Const., Art. I, sec. 8, cl. 8, with other constitutional provisions. *See* Malla Pollack, *The Right to*

Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause, and the First Amendment, 17 Cardozo Arts & Ent. L.J. 47 (1999); Malla Pollack, *Unconstitutional Incontestability? The Intersection of the Intellectual Property and Commerce Clauses of the Constitution: Beyond a Critique of* Shakespeare Co. v. Silstar Corp., 18 Seattle U. L. Rev. 259 (1995).

ARGUMENT
REASONS TO GRANT PERMISSION

Pollack respectfully submits that the attached brief "brings to the attention of the Court relevant material" that is not likely to be addressed fully by the parties. Sup. Ct. R. 37.1.

Petitioners raise only statutory issues. Pollack wishes to alert this Court to the constitutional dimensions of this case.

Petitioners argue the economic importance of the Court's helping business persons in Petitioners' industry. Pollack wishes to alert this Court to Congress' already on-going investigation of Petitioners' economic assertions.

Petitioners and Respondents are all businesses that wish to earn revenue from legal publishing. Pollack volunteers to act as unpaid spokesperson for the general public's interest in its public domain.

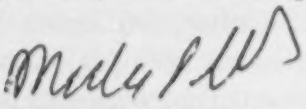
Pollack respectfully claims some slight expertise as she has just published an article concerning the issues not discussed in West Publishing Co. and West Publishing

Corp.'s Petition for Certiorari. *See* Malla Pollack, *The Right to Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause, and the First Amendment*, 17 Cardozo Arts & Ent. L.J. 47 (1999).

CONCLUSION

For all the reasons discussed above, Pollack respectfully requests this Court to allow her to file the attached *pro se Opposition to Petition for Certiorari by Amicus Curiae Malla Pollack*, supporting Respondents.

Respectfully submitted April 16, 1999



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OPPOSITION TO PETITION FOR CERTIORARI

INTEREST OF THE *AMICUS CURIAE*

Amicus curiae Malla Pollack ("Pollack")[1] submits this brief solely to help protect the beleaguered public domain. *Cf.* David Lange, *Recognizing the Public Domain*, 44 (No. 4) Law & Contemp. Probs. 147, 176 (1981) (suggesting that in intellectual property cases the courts should "solicit and welcome amicus participation" or appoint *guardians ad litem* for the public domain). Pollack is an Associate Professor of Law who has authored articles on the interaction of the Intellectual Property Clause of the United States Constitution, U.S. Const., Art. I, sec. 8, cl. 8, with other constitutional provisions. *See* Malla Pollack, *The Right to Know?: Delimiting Database Protection at the Juncture of the Commerce Clause, the Intellectual Property Clause, and the First Amendment*, 17 Cardozo Arts & Ent. L.J. 47 (1999) (hereinafter "*Right to Know*"); Malla Pollack, *Unconstitutional Incontestability? The Intersection of the Intellectual Property and Commerce Clauses of the Constitution: Beyond a Critique of* Shakespeare Co. v. Silstar Corp., 18 Seattle U. L. Rev. 259 (1995).

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1 No part of this brief was authored in whole or in part by counsel for any party. Malla Pollack is paying the cost of preparation, printing, and submission of her *amicus* filings personally and from the Professional Development Fund provided by her employer, Florida Coastal School of Law, 7555 Beach Blvd., Jacksonville, FL 32216.

SUMMARY OF ARGUMENT

The Court should deny the petitions for *certiorari* filed by West Publishing Co. and West Publishing Corp. ("the Petitioners") in both No. 98-1500 and No. 98-1519 (collectively "West's Cases").[2] Petitioners raise only issues under the Copyright Act, 17 U.S.C. §§ 101 *et. seq.*, as construed by *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991). The central issues in both of West's Cases, however, are the interrelationships among the Intellectual Property Clause, U.S. Const. art. I, § 8, cl. 8, the Commerce Clause, U.S. Const. art. I, § 8, cl. 3, and the First Amendment, U.S. Const. amend. I. Petitioners have not, however, posed these constitutional questions in their petitions for *certiorari*. Any Supreme Court opinion in this case, no matter how narrowly drafted, would risk generating further confusion on constitutional matters.

Congress, furthermore, is currently considering both Petitioners' market concerns and the constitutional issues related to Commerce Clause protection of writings. Judicial economy and inter-branch comity counsel waiting for Congress to finish. At the minimum, Congress will clarify the factual background. At the maximum, Congress will render the legal issues obsolete.

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2 Pollack has filed substantively identical *amicus* papers in both cases.

ARGUMENT

A. *Certiorari* Is Inappropriate Because This Case Does Not Proffer For Decision The Central Constitutional Issues Involved

West Publishing Co. and West Publishing Corp. ("Petitioners") pose only questions regarding the Copyright Act, 17 U.S.C. §§ 101 *et. seq.*, as construed since *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340 (1991). *See* West Publishing Co. and West Publishing Corp.'s Petition for Certiorari at i (Questions Presented). *Feist*, however, targeted the constitutional limits imposed upon the Copyright Act by the Intellectual Property Clause of the United States Constitution. U.S. Const. art. I, § 8, cl. 8 ("Congress shall have the power . . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."). *See, e.g., Feist*, 499 U.S. at 344 ("Originality is a constitutional requirement"); *id.* at 351 ("As we have explained, originality is a constitutionally mandated prerequisite for copyright protection."); *id.* at 363 ("As a constitutional matter, copyright protects only those constituent elements of a work that possess more than a *de minimus* quantum of creativity.").

Feist dropped conflicting hints about additional Commerce Clause protection for sweat works (such as the parties' publications).

Additional protection might be supported by *Feist*'s dictum that:

> [p]rotection for the fruits of such [factual] research . . . may in certain circumstances be available under a theory of unfair competition. [Even though] to accord copyright protection on this basis alone distorts basic copyright principles . . . .

Id. at 354. This dictum, however, may be read differently. "[U]nfair competition," *Feist*, 499 U.S. at 354 (O'Connor, J.), is rooted in the "common law of deceit" and concerned only with "protecting consumers from confusion." *See Bonito Boats v. Thundercraft Boats*, 489 U.S. 141, 157 (1989) (O'Connor, J.).

Feist, furthermore, undercuts additional protection by pronouncing that misappropriation, the basis of the Court's decision in *International News Serv. v. Associated Press*, 248 U.S. 215 (1918), is "not relevant" to massive copying from a sweat work. *Feist*, 499 U.S. at 354 n.(unnumbered). *See The Right to Know*, *surpa*, 17 Cardozo Arts & Ent. L.J. at 76-77.

After *Feist*, the important disputed territory lies at the intersection between the Intellectual Property Clause and the Commerce Clause. The Court has never mapped this intersection, but the Court has fenced the similar junction between the Commerce Clause, U.S. Const. art. I, § 8, cl. 3, and the Bankruptcy Clause, U.S. Const. art. I, § 8, cl. 4. ("The Congress shall have power . . . To establish . . . uniform Laws on the subject of Bankruptcies throughout the United States."). The Court restrained Congress from using the Commerce Clause to circumvent the Bankruptcy Clause's uniformity requirement. *See Railway Labor Executives' Ass'n v. Gibbons*, 455 U.S. 457, 471 (1982) (statute intended to help one specific bankrupt railroad is beyond Congress'

power). *Railway Labor* suggests that the Commerce Clause may not be used to bypass textual limits in the Intellectual Property Clause. Commentators, however, differ on the borders of *Railway Labor*. *Compare, e.g., Right to Know, supra*, 17 Cardozo Arts & Ent. L.J. at 61 (after *Railway Labor* and *Feist*, a sweat work "protection act grounded on the Commerce Clause can pass constitutional scrutiny only if the act is carefully limited to situations of market failure.") *with* Jane Ginsberg, *No "Sweat"? Copyright and Other Protection of Works of Information After* Feist v. Rural Telephone, 92 Colum. L. Rev. 338, 370-71 (1992)(After *Railway Labor* and *Feist*, "Congress might have power to enact a misappropriation statute under the Commerce Clause if the statute set forth a scheme of protection quantitatively different from a copyright regime.")

The junction between the Intellectual Property and Commerce Clauses is both sufficiently important and sufficiently dark to warrant Supreme Court illumination in an appropriate case. This, however, is not an appropriate case. Petitioners have not posed constitutional questions.

Because the competing books and CD-ROM products at issue transmit legal opinions to the public, West's Cases carry judicial scrutiny toward an additional constitutional intersection — the crossroads between the Intellectual Property Clause and the First Amendment (Speech, Press, and Petition Clauses). This constitutional junction is also both important and largely unmapped.

Re importance, as James Madison famously pronounced "[k]nowledge will forever govern ignorance" and "[a] popular government without popular information [] or the means of acquiring it is but a prologue to a farce or a

tragedy or perhaps both." Letter from James Madison to W.T. Berry (Aug. 4, 1822), *in* James Madison, *The Complete Madison* 337 (Saul K. Padover ed., 1953).

Re uncertain topography, the First Amendment/Intellectual Property Clause interchange is largely unilluminated. True, this Court pronounced that

> copyright's idea/expression dichotomy strikes a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression.

Harper & Row Publishers, Inc. v. Nation Enters., 471 U.S. 539, 556 (1985). Since the copier in *Harper & Row* lost, however, *id.* at 542, the quoted statement is merely dictum. This Court has never held an intellectual property right unconstitutional on the ground that the First Amendment requires the idea/expression dichotomy. *See Right to Know*, *supra*, 17 Cardozo Arts & Ent. L.J. at 68-69 nn.106-12. The text of the Constitution, furthermore, does not announce a right to know.

Again, the constitutional area is worth this Court's exploration in an appropriate case. Again, this is not an appropriate case. Petitioners have not posed constitutional questions.

If the Court grants *certiorari* to the Petitioners, the Court unnecessarily[3] risks compounding constitutional

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3 As discussed *infra*, Section II, Petitioners have nonjudicial recourse. Congress is considering whether producers of sweat works need increased legal protection. Petitioners

confusion. Petitioners' and Respondents' works are the type of sweat works addressed in *Feist*. Any opinion by this Court, therefore, will be scrutinized for its clarification of the constitutional issues raised, but not resolved, in *Feist*. The Court, however, cannot use Petitioners' cases to properly address these important constitutional issues for the simple reason that Petitioners have not asked the right questions — at trial, on appeal, or in their petitions for *certiorari*.

B. *Certiorari* Is Inappropriate Because Congress Is Already Considering The Economic And Constitutional Issues Central To This Case

Petitioners rely on the alleged economic importance of this case. Petitioners argue that numerous, publicly beneficial sweat works will not be created or marketed absent Court action. *See, e.g.*, West Publishing Co. and West Publishing Corp.'s Petition for Writ of Certiorari at 4, 10, & 15-16. Petitioners should (and already have) addressed their economic arguments to Congress.

Congress is considering whether database protection legislation is warranted to close the alleged "protection gap" created by *Feist*. *See, e.g., Hearings on H.R. 354, "Collections of Information Anti-piracy Act" before the House Judiciary Subcommittee on Courts and Intellectual Property*, 106th Cong. 2 (March 18, 1999)(hereinafter "March 1999 Hearings")(statement of Marybeth Peters, Register of Copyrights) (*Feist* motivated consideration of a database protection statute) <http:// www.house.gov/ judiciary/ 106-pete.htm> (visited March 18, 1999); 145 Cong. Rec. S316 (daily ed. Jan. 19, 1999)(remarks of

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have submitted testimony to Congress. *See infra* at 8-9.

Senator Orrin Hatch)(same); *see also Right to Know, supra*, 17 Cardozo Arts & Ent. L.J. 58 n.62 (collecting references to *Feist* as Congress' motivation for considering database legislation).

Congress has already invested substantial resources in collecting relevant information and opinions. The 104th Congress considered The Database Investment and Intellectual Property Antipiracy Act, H.R. 3531. *See* 143 Cong. Rec. E890-91 (daily ed. May 23, 1996)(introductory statement by Hon. Carlos J. Moorehead). The House of Representatives, 105th Congress, passed two slightly different versions of The Collections of Information Anti-piracy Act. *See* H.R. 2652 (passed May 19, 1998), 144 Cong. Rec. H73398-404 (daily ed. May 19, 1998); H.R. 2652 (passed Aug. 4, 1998), 144 Cong. Rec. H7074-104 (daily ed. Aug. 4, 1998). The Senate, 105th Congress, considered, but did not vote on, a companion bill, S. 2291. *See* 144 Cong. Rec. 7959 (daily ed. July 10, 1998)(bill read twice and referred to the Committee on the Judiciary). Three different database bills have already been suggested to the Senate, 106th Congress. *See* 145 Cong. Rec. S316-26 (daily ed. Jan, 19, 1999)(remarks of Senator Orrin Hatch). The House, 106th Congress, has already held hearings on H.R. 354, The [revised] Collections of Information Anti-piracy Act. <http:// www.house.gov/ judiciary/ 031799.htm> (visited March 18, 1999) (written testimony from March 18, 1999 hearings before House Judiciary Subcomm. on Courts and Intellectual Property).

Petitioners have offered testimony on the currently pending H.R. 354 through two witnesses. *See* March 1999 Hearings, *supra*, (statement of Ms. Marilyn Winokur on behalf of the *ad hoc* Coalition Against Database Piracy,

which includes West's owner, The Thompson Corp., at 4); *id.* (statement of Daniel C. Duncan on behalf of the Software Information Industry Ass'n, which includes West's owner, The Thompson Corp., at 3).

Despite Petitioners' plaint, the economic case for additional protection is not clear. Even the economic expert hired by a pro-protection industry group went no farther than urging Congress to "consider how fast the industry might have grown with statutory protection;" but as she admitted "[t]he database industry has grown rapidly, driven by new technologies. Since 1979, the number of databases on the market has grown nearly 10-fold." *Hearings on the "Collections of Information Antipiracy Act" Before the Subcomm. on Courts and Intellectual Property of the House Comm. on the Judiciary*, 105th Cong. 2 (Oct. 1997) (statement of Laura D'Andrea Tyson and Edward F. Sherry, paid consultants for the Information Industry Ass'n). In the aftermath of *Feist*, between 1991 and 1997, (i) the number of databases increased from 7637 to 10338, i.e. 35%, and (ii) the number of files in databases increased from 4 billion to 11.2 billion, i.e. 180%. *See Hearings on the "Collections of Information Antipiracy Act" Before the Subcomm. on Courts and Intellectual Property of the House Comm. on the Judiciary*, 105th Cong. 4 (Feb. 1998) (statement of Jonathan Band, Online Banking Ass'n, opposing legislation).

Economists are split on whether the absence of legal protection for intellectual property would generate under-production or over-production of information products, such as Petitioners'. *See* James Boyle, *A Politics of Intellectual Property: Environmentalism for the Net?*, 47 Duke L.J. 87, 98 (1997)(collecting economic authorities).

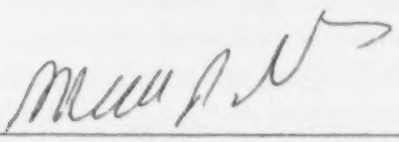
Judicial economy counsels waiting for Congress to finish studying the complexities of information markets. At the minimum, Congress will clarify the factual background. At the maximum, Congress will render the legal issues obsolete.

Judicial comity with a co-equal branch of government also counsels this Court to wait for Congress' views on the constitutional issues before revisiting *Feist*. *See, e.g.*, Ruth Bader Ginsberg, *Speaking In A Judicial Voice*, 67 N.Y.U. L. Rev. 1185, 1198 (1992)(Judges "participate in a dialog with other organs of government, and with the people as well"; "[m]easured motions seem to me right, in the main, for constitutional as well as comon law adjudication. Doctrinal limbs too swiftly shaped, experience teaches, may prove unstable.")(footnotes omitted). Congress is aware of the constitutional dimensions of granting protection to sweat works. *See, e.g.*, March 1999 Hearings ("the Administration's concerns . . . include the concern that the Constitution imposes significant constraints upon Congress' power to enact legislation of this sort.")(statement of Andrew J. Pincus, U.S. Dep't of Commerce, at 3). The congressional inquiry, furthermore, may trigger learned discussion of the constitutional issues; such discussion may ease this Court's path through a later presented and more appropriate case.

CONCLUSION

For all the reasons discussed above, this Court should deny Petitioners' request for *certiorari*.

Respectfully submitted April 16, 1999



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1188

TABLE OF CONTENTS

Page

Table of Cited Authorities ii

Preliminary Statement 1

Argument 2

I. Bender And Hyperlaw Both Ignore Or Obfuscate The Important Questions Of Statutory Construction Raised In This Petition 2

II. Respondents' Briefs Do Not Refute The Split Of Authority Between The Circuits 5

Conclusion 8

TABLE OF CITED AUTHORITIES

Page

Cases:

CCC Information Services, Inc. v. Maclean Hunter Market Reports, Inc., 44 F.3d 61 (2d Cir. 1994), *cert. denied*, 516 U.S. 817 (1995) 7

Oasis Publishing Company v. West Publishing Co., 924 F. Supp. 918 (D. Minn. 1996) 5

Practice Management Information Corp. v. American Medical Ass'n, 121 F.3d 516 (9th Cir.), *cert. denied*, 118 S. Ct. 339 (1997) 7

Wembley, Inc. v. Superba Cravats, Inc., 315 F.2d 87 (2d Cir. 1963) 6

West Publishing Co. v. Mead Data Central, Inc., 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070, 107 S. Ct. 962 (1987) 5, 6

White-Smith Publishing Co. v. Apollo, Co., 209 U.S. 1 (1908) 4

Statute:

17 U.S.C. § 101 4

Rules:

Supreme Court Rule 15(2) 3

Supreme Court Rule 15(6) 1

PRELIMINARY STATEMENT

West Publishing Company and West Publishing Corporation (collectively, "West") respectfully submit this reply brief, pursuant to Supreme Court Rule 15(6), in further support of their petition for certiorari in this case and in response to the briefs filed by respondents Matthew Bender & Company, Inc. ("Bender") and HyperLaw, Inc. ("HyperLaw").

Bender's brief, filed on or about April 29, 1999 ("Bender Br."), does not oppose but, rather, joins in West's request that a writ of certiorari be issued to review the opinion and decision of the United States Court of Appeals for the Second Circuit entered in this case. Bender Br. at 1. It is therefore unnecessary to respond at this time to most of the points raised by Bender, which has taken this opportunity to argue the merits of the case (and to include irrelevant material and meritless attacks on West). HyperLaw's brief ("HyperLaw Br.") was filed on or about April 19, 1999.[1]

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1. HyperLaw, the sole respondent in Case No. 98-1519, has filed no opposition to West's petition in that case, which addresses HyperLaw's copying from West of editorial revisions, additions, and annotations to judicial opinions (in the same CD-ROM product that features a copy of West's original arrangement).

ARGUMENT

I.

BENDER AND HYPERLAW BOTH IGNORE OR OBFUSCATE THE IMPORTANT QUESTIONS OF STATUTORY CONSTRUCTION RAISED IN THIS PETITION

West's petition ("Pet.") amply demonstrates that, as Judge Sweet stated in his Second Circuit dissent, the unique "technological capacity" of CD-ROM technology "presents a new question," and the erroneous answer to that question in the majority opinion "threatens to eviscerate copyright protection for compilations." 158 F.3d at 710, Pet. App. 42a. Bender and HyperLaw would have this Court believe, however, that this case has nothing to do with CD-ROM technology or statutory construction — notwithstanding the fact that the Second Circuit majority opinion devotes fifteen pages (over half of the "Discussion") to an attempt at reconciling CD-ROM technology with the majority's interpretation of the 1976 Copyright Act (Pet. App. 19a-34a).

HyperLaw never even refers to the technological or statutory issues. Bender declares that "this case does not turn on" the nature of CD-ROM technology, and has no special implications for electronic and computer technology (Bender Br. at 26), but offers no basis for these conclusory assertions. Indeed, although West's petition details those particular features of CD-ROM technology, overlooked or misapprehended by the Second Circuit, that raise important questions of statutory interpretation (*see* Pet. at 15-26), Bender does not attempt to refute any of these technological

realities. Thus, Bender effectively admits, for example, that: (i) the physical storage arrangement of CD-ROM data is irrelevant to the issue of perceivable arrangement(s); (ii) no arrangement of data, including a chronological one, is perceivable on a CD-ROM without "manipulation of the data" by the user; and (iii) no CD-ROM user can ever alter the "fixed embedding of the work."[2]

Yet Bender makes no effort to reconcile these realities with the Second Circuit's interpretations of key statutory terms, which are explicitly founded on erroneous presumptions about CD-ROMs. Instead, in circular fashion, Bender's simplistic arguments merely reiterate those presumptions.[3]

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2. Respondents' failure to dispute West's characterization of any of these technological features is especially telling in light of Supreme Court Rule 15(2), which states in part: "Counsel are admonished that they have an obligation to the Court to point out in the brief in opposition, and not later, any perceived misstatement made in the petition." (The Rules do not impose the same requirement on reply briefs, which must be filed within a short time-frame, and this reply therefore addresses only a few of the misstatements made in respondents' briefs.)

3. For example, Bender, echoing the Second Circuit's fundamental misapprehension about CD-ROM technology, asserts that West's arrangement cannot be featured in Bender's product because the product "stores and displays a different arrangement." Bender Br. at 4, n.2. Similarly, although Bender does not deny that user manipulation is required to access any CD-ROM arrangement (*i.e.*, no arrangement is shown simply by plugging in a machine), it reiterates the Second Circuit's definition of a CD-ROM "copy" — which erroneously assumes that the CD-ROM machine itself, rather than a user, "reads" a CD-ROM arrangement. *See* Bender Br. at 28-29.

Indeed, although Bender's brief vainly attempts to suggest that this case is about nothing more than page numbers and jump cites, and conveniently ignores the systematic character of respondents' copying, it succeeds only in highlighting the confusion surrounding the applicability of the 1976 Act to CD-ROM technology, and the need for the Court's guidance in this regard. Bender claims that West's — and Judge Sweet's — interpretation and application of the statutory definition of "copies" in 17 U.S.C. § 101 is "eroneous" [sic]. Bender Br. at 27. Yet, as West has demonstrated (Pet. at 23-26), and Bender does not refute, the Second Circuit's interpretation of "copies" effectively rewrites the statute to require that the work must be perceived *by* a machine, not, as Congress stated, "with the aid of a machine or device."[4] West's interpretation, on the other hand, is completely consistent with the statutory language and, in keeping with legislative intent, can be meaningfully applied to technologies, like CD-ROMs, that were not yet known when the statute was enacted.[5]

4. The Second Circuit would find CD-ROM infringement of a copyrighted arrangement only when the "machine or device that reads" the CD-ROM disc "perceives the embedded material in the copyrighted arrangement or in a substantially similar arrangement." 158 F.3d at 701, Pet. App. 20a. But, as Bender has effectively admitted, no machine "perceives" any arrangement on a CD-ROM; however, "with the aid of a machine or device," a user can readily perceive one or more CD-ROM data arrangements if the manufacturer has made the arrangement accessible by pre-programming.

5. As Judge Sweet observed in his dissent, "[h]ere again it is necessary to reconcile technology with pre-electronic principles of law." 158 F.3d at 710, Pet. App. 42a. Both Bender and the Second Circuit, however, ignore the open-ended, forward-looking language of the statute and would limit its application to situations that are strictly analogous to the piano-roll dilemma raised over 90 years ago by *White-Smith Publishing Co. v. Apollo, Co.*, 209 U.S. 1 (1908). *See* Bender Br. at 27-28.

The resolution of this federal question, which indisputably has far-reaching implications for many sectors of the information industry and the public, is precisely the kind of issue that is appropriate for this Court's consideration.[6]

II.

RESPONDENTS' BRIEFS DO NOT REFUTE THE SPLIT OF AUTHORITY BETWEEN THE CIRCUITS

Bender ultimately concedes, after much hemming and hawing, that "a split of authority now exists as a practical matter" between the Second and Eighth Circuits with regard to whether systematic and comprehensive electronic star pagination constitutes infringement of West's original case arrangements. Bender Br. at 20. Bender acknowledges that the Eighth Circuit's opinion "has continued to enjoy post-*Feist* vitality in the Eighth Circuit," and that the district court in *Oasis Publishing Company v. West Publishing Co.*, 924 F. Supp. 918, 923 (D. Minn. 1996) held that "*Feist* did not overrule" *West Publishing Co. v. Mead Data Central, Inc.*, 799 F.2d 1219 (8th Cir. 1986), *cert. denied*, 479 U.S. 1070, 107 S. Ct. 962 (1987).[7]

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6. Bender's request for a "summary affirmance" of the Second Circuit's ruling is a transparent attempt to avert this Court's analysis of the serious and substantive issues of statutory interpretation raised by digital technology. Indeed, all three judges on the Second Circuit panel in this case recognized the need to address these issues.

7. HyperLaw, by contrast, simply ignores the reasoning and holdings in *Oasis* so that it can pretend that there has been no post-

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However, the suggestion that this split should be resolved to prevent West from using what Bender gratuitously and pejoratively refers to as a "scarecrow" copyright to "dissuade others from offering judicial opinons [sic] with star pagination references" (Bender Br. at 12-17, 21-26, 30) is specious on its face. The validity of the "scarecrow" patent in *Wembley, Inc. v. Superba Cravats, Inc.*, 315 F.2d 87, 89 (2d Cir. 1963), cited by Bender,[8] had never been upheld by any court, or endorsed by any judge, in any jurisdiction; indeed, the Second Circuit defined a "scarecrow" patent as one that, by the patentee's design, never would come before any tribunal for review. In dramatic and complete contrast, West's right to protection from infringement by the systematic and comprehensive copying of arrangement markers has been validated by a decision of the Court of Appeals, two district court rulings (before and after *Feist*), and a vigorous dissent by Judge Sweet in this post-*Feist* case.[9]

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Feist reaffirmation of *West v. Mead*'s analytical approach in the Eighth Circuit. HyperLaw also distorts the facts when it asserts that one of West's attorneys, Arthur R. Miller, is among those scholars who "have determined that West Publishing was overruled by *Feist*." HyperLaw Br. at 7 and n.5. In fact, the article cited by HyperLaw merely states that *Feist* "raises questions" concerning *West v. Mead* and does not suggest how those questions would or should be answered.

8. Bender's citation of 315 F.2d 87, 98 is erroneous.

9. Bender makes misleading references to West's use of star pagination to "rival sources," as if West does what Bender and HyperLaw seek to do — *i.e.*, use the copyrighted arrangements of other publishers without permission. *See, e.g., Bender* Br. at 29, n.20. What Bender neglects to mention, of course, is that public domain arrangements (like that in *U.S. Reports*) can be used by anyone, and that publishers — West and others — frequently license the use of arrangements through star pagination.

Under the circumstances, Bender's characterization of West's claim to copyright protection as "fantastic" (Bender Br. at 21) is an offense to the judges who have ruled or opined otherwise as well as to West and its counsel.[10] The fact that some other judges, scholars, and government attorneys disagree with West's position does not, as Bender arrogantly suggests, somehow deprive West of the right to defend its copyright.[11] Moreover, although Bender attempts to portray West as going to great lengths to avoid further judicial review of its copyright (Bender Br. at 21-26), so as to preserve the "split" between the Circuits, this smear is flatly contradicted by the fact that it was West's choice, and West's alone, to seek this Court's resolution of the issue.[12]

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10. Respondents' reliance on hyperbolic slurs and attacks throughout this litigation is also reflected in HyperLaw's attempt to cast doubt on the integrity of the Justices of this Court (HyperLaw Br. at 9-11), a terror tactic that is unworthy of discussion.

11. Nor is there any authority for Bender's apparent claim (Bender Br. 15-16) that West's copyright should be eviscerated because of the usefulness, popularity, or governmental approval of West's reporters as a citation source. On the contrary, the courts have consistently rejected purported "public benefit" arguments for eliminating copyright protection. *See, e.g., CCC Information Services, Inc. v. Maclean Hunter Market Reports, Inc.*, 44 F.3d 61, 74 (2d Cir. 1994) (noting that dedication of private intellectual property to public could amount to an unconstitutional taking), *cert. denied*, 516 U.S. 817 (1995); *Practice Management Information Corp. v. American Medical Ass'n*, 121 F.3d 516, 518-20 (9th Cir.) (refusing to invalidate copyright of publicly adopted codes), *cert. denied*, 118 S. Ct. 339 (1997).

12. In other respects, too, Bender distorts the record in an apparent attempt to cast aspersions on West and distract from the

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CONCLUSION

For the foregoing reasons, West respectfully requests that a writ of certiorari to the United States Court of Appeals for the Second Circuit be granted.

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important issues involved. For example, although even HyperLaw acknowledges that both lower courts assumed, for purposes of adjudication, that West's reporters feature a "copyrightable arrangement" (HyperLaw Br. at 3), Bender takes the astonishing position that the district court never assumed, even *arguendo*, that West's case arrangement is protectible. Bender Br. at 8, n.6. In fact, this specific assumption is unambiguously reaffirmed throughout the district court record; for example, the court refers to West's "creative activity" as "decid[ing] that a group of cases should be compiled together in a certain order," and states that West's works are copyrightable compilations "[t]o the extent that they [West] made selections of what order in which they are going to put the opinions." Pet. App. 50a, 59a. Similarly, Bender suggests that the district court did not assume that West's arrangement (and protectible portions thereof) can be readily perceived through the pre-programming of respondents' CD-ROM products. Bender Br. at 8, n.6. Again, the record leaves no doubt that all of West's assertions about the capability of the CD-ROM products were, without objection from respondents, assumed to be true for purposes of the summary judgment motion. *See, e.g.*, Pet. App. 55a, 76a-77a.

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